

**Amended proposal for a European Parliament and Council Directive approximating the legal arrangements for the protection of inventions by utility model <sup>(1)</sup>**

(2000/C 248 E/03)

COM(1999) 309 final — 97/0356(COD)

*(Submitted by the Commission pursuant to Article 250(2) of the EC Treaty on 28 June 1999)*

<sup>(1)</sup> OJ C 36, 3.2.1998, p. 13.

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INITIAL PROPOSAL

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THE EUROPEAN PARLIAMENT AND THE  
COUNCIL OF THE EUROPEAN UNION,

Having regard to the Treaty establishing the European Community and in particular Article 95 thereof,

Having regard to the proposal from the Commission,

Having regard to the opinion of the Economic and Social Committee <sup>(1)</sup>,

Acting in accordance with the procedure laid down in Article 251 of the Treaty <sup>(2)</sup>,

Whereas the Treaty commits the Community and Member States to creating the conditions for Community industry to be competitive and to promoting a better exploitation of the industrial potential of innovation, research and technological development policies;

Whereas technical inventions play an important role in that they make available improved, better quality products which are particularly effective in terms of, for example, ease of application or use, or which confer a practical or industrial advantage compared with the state of the art;

Whereas, because of differences between Member States' utility model laws, an invention may not be protected throughout the Community, at least not in the same way or for the same length of time, a state of affairs which is incompatible with a transparent, obstacle-free single market; whereas it is therefore necessary, with a view to the establishment and proper functioning of the single market, to approximate Member States' laws in this area;

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(1) Whereas the Treaty commits the Community and Member States to creating the conditions for Community industry to be competitive and to promoting a better exploitation of the industrial potential of innovation, research and technological development policies;

(2) Whereas technical inventions play an important role in that they make available improved, better quality products which are particularly effective in terms of, for example, ease of application or use, or which confer a practical or industrial advantage compared with the state of the art;

(3) Whereas, because of differences between Member States' utility model laws, an invention may not be protected throughout the Community, at least not in the same way or for the same length of time, a state of affairs which is incompatible with a transparent, obstacle-free single market; whereas it is therefore necessary, with a view to the establishment and proper functioning of the single market, to approximate Member States' laws in this area;

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<sup>(1)</sup> OJ C 235 of 27.7.98, p. 26.

<sup>(2)</sup> European Parliament Opinion of 12 March 1999.

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Whereas it is important in this context to employ every possible means of increasing the competitiveness of Community industry in the field of research and development;

Whereas small and medium-sized firms play a strategic role in relation to innovation and rapid response to market requirements;

Whereas there is a need for placing at the disposal of firms, and in particular small and medium-sized firms and researchers, an instrument which is cheap, rapid and easy to evaluate and apply;

Whereas utility model protection is better suited than patent protection to technical inventions involving a specific level of inventiveness;

Whereas technical inventions should be suitably protected throughout the Community;

Whereas, in accordance with the principle of proportionality, the approximation may be limited to those national provisions which have the most direct impact on the functioning of the single market;

Whereas, if the objectives of the approximation are to be attained, the conditions for obtaining and retaining the rights conferred by a registered utility model should in principle be the same in all Member States; whereas to that end an exhaustive list of the requirements which a technical invention must satisfy if it is to be protected by a utility model must be drawn up;

Whereas these requirements are for the most part the same as those for patent protection; whereas the level of inventiveness required must nevertheless be different to allow for the specific nature of technical inventions protectable by utility model;

Whereas utility model protection must be available both to products and to processes;

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(4) Whereas it is important in this context to employ every possible means of increasing the competitiveness of Community industry in the field of research and development;

(5) Whereas small and medium-sized firms play a strategic role in relation to innovation and rapid response to market requirements;

(6) Whereas there is a need for placing at the disposal of firms, and in particular small and medium-sized firms and researchers, an instrument which is cheap, rapid and easy to evaluate and apply; whereas the fees should therefore be as reasonable as possible for small firms, individual inventors and universities;

(7) Whereas utility model protection is better suited than patent protection to technical inventions involving a specific level of inventiveness;

(8) Whereas technical inventions should be suitably protected throughout the Community;

(9) Whereas, in accordance with the principle of proportionality, the approximation may be limited to those national provisions which have the most direct impact on the functioning of the single market;

(10) Whereas, if the objectives of the approximation are to be attained, the conditions for obtaining and retaining the rights conferred by a registered utility model should in principle be the same in all Member States; whereas to that end an exhaustive list of the requirements which a technical invention must satisfy if it is to be protected by a utility model must be drawn up;

(11) Whereas these requirements are for the most part the same as those for patent protection; whereas the level of inventiveness required must nevertheless be different to allow for the specific nature of technical inventions protectable by utility model;

(12) Whereas utility model protection must be available both to products and to processes;

(13) Whereas it is necessary to exclude from utility model protection not only those inventions which are normally excluded from patentability but also, in order to meet the needs of the industries concerned, inventions relating to chemical or pharmaceutical substances or processes;

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Whereas it is essential, in order to safeguard the proper functioning of the single market and ensure that competition is not distorted, that registered utility models should henceforth confer upon their proprietor the same protection in all Member States and that the period of protection should be identical; whereas this period may not exceed 10 years;

Whereas the nature and scope of the rights conferred by a utility model must be spelled out; whereas the principle of Community exhaustion of rights must apply in accordance with the case-law of the Court of Justice of the European Communities, but the principle of international exhaustion must be expressly excluded;

Whereas rules must also be laid down on dual protection by patent and by utility model, and on the lapse and revocation of utility models;

Whereas all Member States of the Community are bound by the Paris Convention for the Protection of Industrial Property; whereas the Community and all Member States are bound by the Agreement on Trade-related Aspects of Intellectual Property Rights concluded under the auspices of the World Trade Organisation; whereas the provisions of this Directive must be in complete harmony with those of the Paris Convention and of the above-mentioned Agreement; whereas Member States' other obligations stemming from the Convention and the Agreement are not affected by this Directive;

(14) Whereas a utility model application must satisfy requirements similar to those for patents; whereas, however, a utility model application gives rise only to a check to ensure that the formal conditions for protectability are satisfied without any preliminary examination to establish novelty or inventive step; whereas it may form the subject-matter of a search report on the state of the art only at the request of the applicant or any other interested party;

(15) Whereas it is essential, in order to safeguard the proper functioning of the single market and ensure that competition is not distorted, that registered utility models should henceforth confer upon their proprietor the same protection in all Member States and that the period of protection should be identical; whereas this period may not exceed 10 years;

(16) Whereas the nature and scope of the rights conferred by a utility model must be spelled out; whereas the principle of Community exhaustion of rights must apply in accordance with the case-law of the Court of Justice of the European Communities, but the principle of international exhaustion must be expressly excluded;

(17) Whereas rules must also be laid down on dual protection by patent and by utility model, and on the lapse and revocation of utility models;

(18) Whereas all Member States of the Community are bound by the Paris Convention for the Protection of Industrial Property; whereas the Community and all Member States are bound by the Agreement on Trade-related Aspects of Intellectual Property Rights concluded under the auspices of the World Trade Organisation; whereas the provisions of this Directive must be in complete harmony with those of the Paris Convention and of the above-mentioned Agreement; whereas Member States' other obligations stemming from the Convention and the Agreement are not affected by this Directive;

(19) Whereas the application of this Directive should be monitored and it should be adapted in order to safeguard, in the context of utility models, the proper functioning of the internal market and innovation by Community enterprises; whereas the Commission should propose the measures necessary for this purpose, which should include specific steps to facilitate and reduce the cost of registering utility models in more than one Member State,

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HAVE ADOPTED THIS DIRECTIVE:

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## CHAPTER ONE

## GENERAL PROVISIONS

*Article 1***Definition**

1. In accordance with the provisions of this Directive, utility model protection shall cover new inventions involving products or processes that involve an inventive step and are suitable for industrial application.

2. The following names are used in the Member States:

Belgium:	Brevet de courte durée/Octrooi van korte duur
Denmark:	Brugsmodel
Germany:	Gebrauchsmuster
Greece:	Πιστοποιητικό υποδείγματος χρησιμότητας
Spain:	Modelo de utilidad
France:	Certificat d'utilité
Ireland:	Short-term patent
Italy:	Brevetto per modelli di utilità
Netherlands:	Zesjarig octrooi
Austria:	Gebrauchsmuster
Portugal:	Modelo de utilidade
Finland:	Nyttighetsmodellagen

*Article 2*

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**Subject**

This Directive seeks to approximate Member States' laws, regulations and administrative provisions on the protection of inventions by utility model.

## CHAPTER II

## SCOPE OF THE UTILITY MODEL

*Article 3***Exceptions to protection**

1. The following in particular shall not be regarded as inventions that are eligible for utility model protection:

(a) discoveries, scientific theories and mathematical methods;

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(b) aesthetic creations;

(c) schemes, rules and methods for performing mental acts or doing business;

(d) presentations of information.

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2. The items referred to in paragraph 1, shall be excluded from utility model protection only the application for utility model protection relates to those items as such.

## Article 4

## Article 4

**Non-protectable inventions**

Utility models shall not be granted in respect of:

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(a) inventions the exploitation of which would be contrary to public policy or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all Member States;

(b) inventions relating to biological material;

(c) inventions relating to chemical or pharmaceutical substances or processes;

## Article 5

**Novelty**

1. An invention shall be considered to be new if it does not form part of the state of the art.

2. The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the utility model application.

3. Additionally, the content of utility model and patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

## Article 6

**Inventive step**

## Article 6

**Inventive step**

1. For the purposes of this Directive, an invention shall be considered as involving an inventive step if, compared with the state of the art, it presents an advantage and is not very obvious to an expert in the field.

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*Article 7***Industrial application**

1. An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

2. Surgical or therapeutic treatment procedures applicable to the human body or to the bodies of animals and diagnostic procedures which are carried out on the human body or the bodies of animals shall not be considered to be inventions susceptible of industrial application within the meaning of paragraph 1.

## CHAPTER III

**UTILITY MODEL APPLICATION***Article 8***Requirements of the application**

- (a) a request for the grant of a utility model;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract.

2. A utility model application shall be subject to the payment of a filing fee and, where appropriate, a search fee.

*Article 9***Date of filing**

The date of filing of a utility model application shall be the date on which documents filed by the applicant contain:

- (a) an indication that a utility model is sought;
- (b) information identifying the applicant;
- (c) a description and one or more claims.

2. The advantage referred to in the previous paragraph must be a practical or technical advantage for the use or manufacture of the product or process in question, or another benefit to the user, such as an educational advantage or an entertainment value.

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1. A utility model application shall contain only:

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*Article 10***Designation of the inventor**

The utility model application shall designate the inventor. If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the utility model.

*Article 11***Unity of invention**

The utility model application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

*Article 12***Disclosure of the invention**

The utility model application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

*Article 13***Claims**

The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

*Article 14***The abstract**

The abstract shall merely serve for use as technical information. It may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of the protection sought nor for the purpose of applying Article 5(3).

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*Article 15***Examination as to formal requirements**

1. The competent authority with which a utility model application has been lodged shall examine whether the application satisfies the formal requirements of Articles 8 and 10 and shall check whether it contains a description and an abstract.

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2. If a date of filing cannot be accorded, the competent authority shall give the applicant an opportunity to correct the deficiencies in accordance with such conditions and within such period as it may fix. If the deficiencies are not remedied in due time, the application shall not be dealt with as a utility model application.

3. The competent authority referred to in paragraph 1 shall not carry out any examination to establish whether the requirements of Articles 5, 6 and 7 have been met.

*Article 16***Search report**

2. The competent authority with which the application has been lodged may entrust the task of drawing up the search report to any authority which it considers competent to do so.

3. Immediately after it has been drawn up, the search report shall be transmitted to the applicant together with copies of any cited documents.

*Article 17***Priority right**

1. Any person who has duly filed an application for a utility model or a patent in or for one of the Member States, such State being a party to the Paris Convention for the Protection of Industrial Property, or his successors in title, shall enjoy, for the purpose of filing a utility model application in respect of the same invention in one or more other Member States a right of priority during a period of twelve months from the date of filing of the first application.

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1. If a utility model application has been accorded a date of filing and is not deemed to have been withdrawn, the competent authority with which the application has been lodged shall, at the request of the applicant or any other interested party and at their own cost, draw up on the basis of the claims a search report covering the relevant state of the art, with due regard to the description and any drawings.

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3. Immediately after it has been drawn up, the search report shall be transmitted to the applicant together with copies of any cited documents. The search report shall be made available to the public as part of the documentation accompanying the granting of the utility model.

4. In the provisions which they adopt in order to comply with this Directive, Member States shall provide that a search report is compulsory in the event of legal proceedings being brought to enforce the rights conferred by the utility model, unless it has already been the subject of a previous search report.

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2. Any filing that is equivalent to a regular national filing under the domestic law of the Member State where it was made or under bilateral or multilateral agreements shall be recognised as giving rise to a right of priority.

3. By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed in the Member State concerned, whatever may be the outcome of the application.

## Article 18

**Internal priority and transformation**

1. Any person who has duly filed a patent application shall enjoy a right of priority during a period of twelve months for the purpose of filing a utility model application or changing his patent application into an application for a utility model in respect of the same invention, unless priority has already been claimed for the patent application.

2. The provisions of Article 17(2) and (3) shall apply *mutatis mutandis*.

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## CHAPTER IV

**EFFECTS OF THE UTILITY MODEL**

## Article 19

**Duration of protection**

1. The duration of the utility model shall be six years from the date of filing of the application.

2. Six months before the period indicated in paragraph 1 elapses, the right-holder may submit to the competent authority an application for renewal of the utility model for a period of two years.

2. Six months before the period indicated in paragraph 1 elapses, the right-holder may submit to the competent authority an application for renewal of the utility model for a period of two years. This renewal shall not be granted unless an application for a search report has been made in respect of the invention concerned.

3. Six months before the period indicated in paragraph 2 elapses, the right-holder may submit a second and last application for renewal for a maximum period of two years.

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4. In no circumstances may utility model protection last for more than ten years from the date of filing of the application.

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*Article 20***Rights conferred**

3. The rights conferred by a utility model in accordance with paragraphs 1 and 2 shall not extend to:

- (a) acts done privately and for non-commercial purposes;
- (b) acts done for experimental purposes relating to the subject-matter of the protected invention.

5. Member States may provide limited exceptions to the exclusive rights conferred by a utility model, provided that such exceptions do not unreasonably conflict with a normal exploitation of the utility model and do not unreasonably prejudice the legitimate interests of the proprietor of the utility model, taking account of the interests of third parties.

6. Where the law of a Member State allows for use of the subject-matter of a utility model other than that allowed under paragraph 5 without the authorisation of the right-holder, including use by the government or third parties authorised by the government, the provisions applicable to patents for similar use shall be complied with.

1. Where the subject-matter of a utility model is a product, the utility model shall confer on its proprietor the right to prevent third parties not having his consent from making, using, offering for sale, selling, or importing for these purposes that product.

2. Where the subject-matter of a utility model is a process, the utility model shall confer on its proprietor the right to prevent third parties not having his consent from using the process and from using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.

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4. The proprietor of or applicant for a utility model shall have the right to assign, or transfer, the utility model by any legally recognised means and to conclude licensing agreements.

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7. The right conferred by the utility model shall take full effect at the time when the protection is published.

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*Article 21***Community exhaustion of rights**

1. The rights conferred by a utility model shall not extend to acts concerning a product covered by that utility model which are done after that product has been put on the market in the Community by the right-holder or with his consent.

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2. The rights conferred by a utility model shall, however, extend to acts concerning a product covered by that utility model which are done after that product has been put on the market outside the Community by the right-holder or with his consent.

## CHAPTER V

**DUAL PROTECTION, LAPSE AND REVOCATION***Article 23***Dual protection**

1. The same invention may form the subject-matter, simultaneously or successively, of a patent application and a utility model application.

*Article 24***Lapse**

A utility model shall lapse:

- (a) at the end of the period laid down in Article 19;
- (b) if its proprietor surrenders it;
- (c) if the fees referred to in Article 8(2) have not been paid in due time.

*Article 25***Revocation**

1. An application for revocation of a utility model may be filed only on the grounds that:

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*Article 22***Relationship with other forms of protection**

The provisions of this Directive shall be without prejudice to any provisions of Community law or of the law of the Member State concerned relating to design rights, trade marks or other distinctive signs, patents, typefaces, topography of semiconductor products, civil liability or unfair competition.

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2. A utility model which has been granted shall be deemed to be ineffective where a patent relating to the same invention has been granted and published.

3. Member States shall take appropriate measures to prevent the proprietor, in the event of his rights being infringed, from instituting successive proceedings under both sets of protection arrangements.

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- (b) the utility model does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (c) the subject-matter of the utility model extends beyond the content of the utility model application as filed;
- (d) the protection conferred by the utility model has been extended.

2. If the grounds for revocation affect the utility model only partially, revocation shall be pronounced in the form of a corresponding limitation of the utility model.

- (a) the subject-matter of the utility model is not protectable pursuant to Articles 1(1) and 3 to 7 of this Directive;

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2. If the grounds for revocation affect the utility model only partially, revocation shall be pronounced in the form of a corresponding limitation of the utility model. If the national law permits, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.

## Article 26

**Secondary application**

In the absence of specific provisions applicable to utility models, these shall be governed, *mutatis mutandis*, by the provisions laid down for patents for invention provided they are not incompatible with the specific characteristics of utility models.

## CHAPTER VI

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**FINAL PROVISIONS**

## Article 27

**Transposal**

When Member States adopt these provisions, these shall contain a reference to this Directive or shall be accompanied by such reference at the time of their official publication. The procedure for such reference shall be adopted by the Member States.

1. Member States shall bring into force the laws, regulations and administrative provisions necessary to comply with this Directive not later than two years after the date of its publication in the Official Journal of the European Communities. They shall immediately inform the Commission thereof.

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2. Member States shall inform the Commission of the main provisions of national law which they adopt in the field governed by this Directive.

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*Article 28***Monitoring of the Directive**

Within three years of the deadline for transposal laid down in Article 27, the Commission shall inform the European Parliament and the Council of the results of its application and whether it should be adapted in order to safeguard, in the context of utility models, the proper functioning of the internal market and innovation by Community undertakings. It shall also propose any measures it deems necessary to improve it.

*Article 29***Entry into force**

This Directive shall enter into force on the twentieth day following that of its publication in the *Official Journal of the European Communities*.

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*Article 30***Addressees**

This Directive is addressed to the Member States.

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