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Utility Models – A Useful Alternative to Patents

April 2008

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In many countries the time required to secure patent protection often exceeds two years. For technologies in which change occurs rapidly, a delay of more than two years from filing to grant can significantly weaken, and in some cases eliminate, the value of patent protection. By the time a patent issues, the protected technology may be obsolete and the marketplace may have moved on to a new and different technology.

Fortunately, several countries provide a quick and effective solution to this problem in the form of “utility model” protection, enabling IP owners to secure protection in a matter of months rather than years. Like a patent, a utility model is a registered right to protect a technical innovation. Like a patent, a utility model entitles its owner to prevent others from making, using, or selling the innovation. Most inventions that can be protected by a patent can also be protected by a utility model.

In contrast to a patent, a utility model is typically obtained by using a pure “registration” procedure. Under a registration procedure, the patent office in the jurisdiction granting protection will review a utility model application to ensure compliance with basic formal requirements. The patent office will generally not, however, substantively examine the invention and will not determine whether the invention is sufficiently different from the prior art to merit protection. Since substantive examination of the invention is not required, the utility model can be issued in a matter of months after filing, as compared to the multi-year process required for issuance of most patents. The utility model applicant can therefore write and file the application, secure issuance of the utility model, and have an effective tool to use against an infringer within months of first discovering infringement. The elimination of a substantive examination also means that a utility model can be secured less expensively than a patent.

The application process for utility models and for patents may be similar in other respects. In some jurisdictions, alterations and amendments to the utility model application are permissible and time limits can be extended on request. Some jurisdictions allow patent applications to be converted into utility model applications and vice versa. Moreover, some jurisdictions permit applicants to simultaneously obtain patent and utility model protection for the same invention, while other jurisdictions require applicants to choose only one type of protection.

Once issued, the utility model generally provides the same rights as a patent. For example, the utility model can be used in legal proceedings to enjoin infringement and to obtain damages from infringers. In addition, post-grant challenges to the validity of the utility model may be heard by the patent office or in the courts. Typically though, the maximum lifetime of a utility model is several years shorter than the maximum lifetime of a patent.

Although utility models can provide significant advantages in some situations, there are several reasons why patent protection may be desirable or necessary. Perhaps most significantly, utility model protection is not available for all technical innovations; for instance, utility models typically cannot be obtained for method or process inventions. Utility model protection is not available in every country, and is most notably unavailable in the United States. A number of countries provide some form of utility model protection, including China, Germany, Japan, Korea, Taiwan, France, and Australia.

The issuance and enforcement of utility models is determined on a country-by-country basis, and the laws governing utility model issuance and enforcement can vary significantly from country to country. It is important to consult with counsel knowledgeable about utility models in each jurisdiction in which utility model protection and enforcement is sought. Where available, utility model protection can provide a relatively fast and effective tool for market protection at a reasonable cost.