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Should national utility model registrations always be independent of their corresponding european patents?

Anders Valentin (Bugge Valentin) · Tuesday, June 7th, 2011

In Denmark, a patentee may opt to apply for a utility model registration in addition to a patent, provided that the conditions for the grant of both rights are fulfilled. One of the strategic advantages of applying for both rights in Denmark is that the utility model registration is not subject to as thorough a prosecution of the underlying application as is the case for a patent application as the utility model prosecution only concerns formal requirements (as opposed to material requirements) and so the utility model registration may be obtained more swiftly and the right may be enforced even while the patent application is still being prosecuted.

In some cases a patentee may therefore use a priority application as a basis for obtaining both a patent and a utility model and enforce the utility model while the patent is being prosecuted. Once the patent is granted, the strategic importance of the utility model will normally disappear. If, however, an interlocutory injunction is obtained on the basis of the utility model and the patent application is never granted (or the granted patent revoked) the question arises of whether an interlocutory injunction based on the utility model may be upheld?

To the extent that the patent application is not granted for lack of inventive step, there need not be an issue in relation to the validity of the utility model registration as the inventive step test for a Danish utility model is less strict than that applicable to a patent, ie. the utility model need only fulfil a requirement of “creative step” as opposed to “inventive step”.

There appears, however, to be no formal legal basis for distinguishing between the novelty requirement in respect of patents and utility models under Danish law. Therefore, the question arises of whether a Danish (or other European) utility model may (should) be upheld in the event that its sister patent is invalidated at the EPO? And what should apply in the event that the sister patent is ultimately revoked due to e.g. inadmissible amendments pursuant to EPC 123(2)?

While there is certainly a case to be made for distinguishing between the inventive/creative step tests with respect to patents and utility models, respectively, it is perhaps more difficult to see why it should be possible to obtain an exclusive industrial right such as a utility model in an EPC state if it is not possible to obtain a European patent because of e.g. lack of novelty?

It would be interesting to learn the views on this from jurisdictions that also allow double protection in the form of utility models and European patents.

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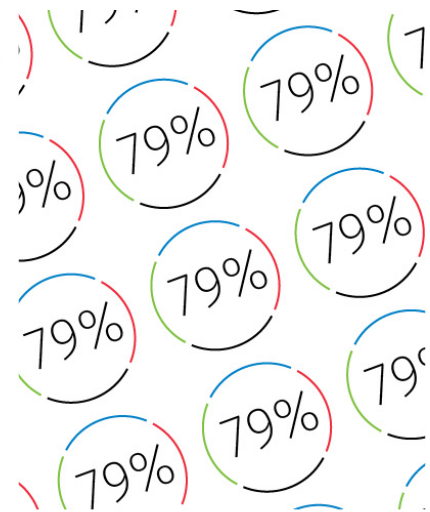
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