Utility Models in Denmark

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A utility model is sometimes referred to as "the small patent", but what is this "small" IP right and what can an inventor use it for? In the following we will try to take a closer look at this.

It is far from all countries that have this possibility at all. Some countries have a kind of IP protection aimed at protecting simple invention, but most systems are not used very much. The idea behind a utility model protection is to provide a possibility for a small inventor having made a simple invention to get a quick and inexpensive protection. In Denmark we got the first Consolidated Utility Model Act in 1991. This act was modeled over the German Utility Model Act (Gebruchsmustergesetz). But as always, differences appear as time goes by.

As it should be apparent from the explanations below, the utility models are very much related to the patents both in the application procedure and the interpretation and protection conferred. Accordingly, the Danish Consolidated Utility Model Act contains many references or similar wordings as in the Danish Consolidated Patent Act.

What can be protected?

Despite the general idea behind the concept of utility model protection explained above, there is actually no requirement in the Consolidated Utility Model Act demanding the creation to be a simple invention despite the term "creation" is used in the wording of the utility Model Act. This saves of course a lengthy discussion of when something is "simple" or if there is a difference between "creations" and "inventions". But practice shows that not only simple mechanical creations, such as a gardening tool or a kitchen utensil, can be registered as a utility model but also more complex systems, such as a computer software system or a chemical compound or a pharmaceutical composition, which all can be protected by utility models.

In order for a utility model to be valid it must possess novelty and inventive step. This sounds like the same requirements as the requirements for patents but here in Denmark, it is not so. In Germany, the Supreme Court a few years ago ruled that the level of inventive step is in fact the same for utility models and patents in Germany. But recent court decisions here in Denmark clearly confirm that the level is lower for utility models. This was also the idea when the Utility Model Act was in the making. This difference is also apparent when comparing wordings of the relevant paragraphs of the patent act and for the utility model act.

The Consolidate Patents Act

2.-(1) Patents shall be granted only for inventions, which are new in relation to the state of the art at the date of filing of the patent application and which, moreover, differ essentially therefrom.

The Consolidate Utility Models Act

5.-(1) To be registrable a creation shall be new in relation to the state of the art at the date of filing of the application, and it shall differ distinctly therefrom.

Table 1: Source: http://www.dkpto.org/media/157697/consolidate_patents_act.pdf and http://www.dkpto.org/media/2836253/consolidate%20act%20no.%20106%20of%2024.%20january%202012.pdf

As it becomes apparent from the wording of the relevant paragraphs compared in the table 1 above, the requirement for a creation (i.e. an invention) to be registered as a utility model the creation merely has to be distinctly different.

There are some exemptions though. Besides the same as for patents concerning discoveries, aesthetic creations, presentation of information, etc., it is also specifically spelled out that creations concerning methods and war material cannot be registered as a utility model. A full list of creations exempted from utility model protection can be found in paragraphs 2 to 4 of the Consolidated Utility Model Act.

How to obtain utility model protection?

An application for a utility model must contain a description, claims and drawings (if applicable). The

application is filed with the Danish Patent and Trademark Office (DKPTO). The application documents can be filed in Danish as well as English. The utility model application may be filed directly either with or without a claim to priority from an earlier patent or utility model application.

It is also possible to enter the national phase of a PCT application in Denmark as a utility model application – and actually either as an alternative or in addition to a national patent application or a European patent application designating Denmark. There are no prohibitions against double protection (or double patenting) in Denmark.
A utility model application can also be branched off from a patent application. This patent application can be a national Danish patent application or a European patent application designating Denmark. This branching off is very similar to the filing of divisional applications within the patent prosecution world and it can be done until 2 months after the patent application has been refused or has been deemed withdrawn or until the date of grant of the patent application.

When filing a utility model application a filing fee of DKK 2000 must be paid. The DKPTO will then perform a formality examination, checking for instance that the application does not contain method claims and that there is unity of invention. When the DKPTO is satisfied that the formal conditions are met, the utility model application will be registered without examination. This registration procedure usually takes about 1-2 months. The utility model application or the registered utility model is published 15 months from the (earliest) date of priority or date of filing.

Examination must be requested separately. This can be done either before or after registration. Such request for examination involves payment of a fee of DKK 4000. Importantly, it should be noted that also third party can request examination.

An applicant having filed a utility model can later on use this filing and claim priority from the utility model application when filing a patent application in another country (or in Denmark).

Protection conferred

A utility model gives 10 years protection counting from the date of filing. However, the utility model must be renewed twice, once after 3 years and again after 6 years.

Claims in utility models are interpreted in the same way as patents. There are quite some case laws on this from the courts. Therefore, although the initial idea behind the utility models were to provide an inexpensive way to protect an invention, the claims and the description must be written with the same great care as is the case in the field of patents. This would also seem fair since third party must be ensured clarity with regard to what is protected and what is not.

Since 1 July 2010 the Consolidated Utility Model Act has also been in force in Greenland extending the utility model protection of a Danish utility model to Greenland.

What to use a utility model for?

A utility model gives only 10 years of protection. Methods cannot be protected so why bother? Why not consider a patent protection instead? In most situations this strategy makes good sense, but there are a few scenarios where it would make sense to file for a utility model:

The registration procedure is relatively quick and although it is an unexamined right, this means that a proprietor can obtain a registered and thereby enforceable right relatively quickly. So in case of a potential infringer, the filing of a utility model branched off from a pending patent application could make good sense in order to pursue a preliminary injunction to stop the infringement quickly rather than having to wait for the grant of the patent application.

As mentioned above there is no requirement against double protection. This means that since the level of inventive step is lower, one could speculate in branching off a utility model as an extra precautionary measure so that protection is maintained even though a co-pending patent might be successfully challenged in opposition for lacking inventive step.

These more strategic uses of utility models suggested above come at a cost and may be not favour the small inventor as presumably intended by the utility model act.

So with substantially no difference in complexity in order to ensure a solid protection and since the work going into the drafting of a utility model should be carried out with the same great care as is the case in the field of patents, why bother to file utility models? Apart from the few strategic advantages mentioned

above, it does not seem worth the effort to just file for a utility model when patent protection is available. This is also reflected in the use of the utility model system. The filing numbers are limited and declining, cf. *http://www.dkpto.dk/media/34671/brugsmodel%202012.pdf*

Nevertheless the possibility of utility model protection exists in Denmark and therefore we should not overlook this extra tool in the IP toolbox that we have compared to many other countries.

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