SUB-PATENT INNOVATION RIGHTS

This ground-breaking work delves into the world of sub-patent intellectual property rights, exploring utility model and similar protection offered by over 100 countries worldwide. Drawing on the expertise of leading scholars from around the globe, this volume provides a comprehensive analysis of sub-patent protection systems, comparing and contrasting statutory frameworks, registration requirements, corporate strategies, and litigation tactics. The book also highlights current policy debates surrounding these systems, including their potential to promote local innovation and economic development, proposals for cross-border harmonization, and their interaction with increasingly integrated litigation systems. This book is an invaluable resource for scholars, attorneys, historians, economists, and anyone dealing with complex international intellectual property matters. This title is also available as Open Access on Cambridge Core.

Jorge L. Contreras, the James T. Jensen Endowed Professor for Transactional Law at the University of Utah S.J. Quinney College of Law, is an internationally recognized expert on intellectual property law and practice. He is the author or editor of twelve prior books and more than 150 scholarly book chapters and articles. Before entering academia, he was a partner at a major international law firm where he practiced transactional intellectual property law in Boston, Washington, DC, and London.

Sub-patent Innovation Rights

UTILITY MODELS, PETTY PATENTS AND INNOVATION PATENTS AROUND THE WORLD

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Contents

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Foreword

Utility models, also known as petty patents, innovation patents and by various other names, are a long-established form of intellectual property right. Thus some national regimes date from as long ago as the late nineteenth or early twentieth century. They are also an increasingly widespread form of protection, now to be found in over a hundred countries. They are also an internationally recognized form of protection, notably by the Paris Convention for the Protection of Industrial Property since the Washington Act of 1911. As was first recognized in Uma Suthersanen's pioneering study for UNCTAD in 2006, utility models are a form of protection which may be particularly suitable for developing economies. In developed economies, it is common for there to be cyclical debates as to the advantages and disadvantages of such rights, and in particular whether, as some supporters claim, they foster innovation by small and medium-sized enterprises. For example, Australia introduced petty patents in 1979, reformed and re-named them innovation patents in 2001, but abandoned the system in 2021. Finally, utility models can interact with other rights, as was recently highlighted by the decision of the Grand Chamber of the Court of Justice of the European Union in Case C–382/21 P *European Union Intellectual Property Office* v. *KaiKai Company Jaeger Wichmann GbR* [EU:C:2024:172] (holding that an application for a Community-registered design could claim priority from a design right or utility model filed in another Contracting State of the Paris Convention in the preceding six months, but not from a patent).

Despite the ubiquity and significance of utility models, they have until now attracted very little attention from scholars. Jorge Contreras is therefore to be congratulated in taking the initiative of editing this volume. He has assembled an international team of distinguished scholars who, between them, have gone a long way to remedy the previous neglect of this important topic. There are chapters by national experts which explore the present or past laws of fifteen countries. In addition, there are cross-jurisdictional contributions which provide an overview of such systems, prospects for harmonisation at least within the European Union,

interaction with other aspects of the intellectual property system and their economic impact. As such, the book can be whole-heartedly recommended to anyone with an interest in this corner of intellectual property law.

Richard Arnold
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Preface

Patents are important tools for innovation policy. They incentivize creation and dissemination of new technical solutions and help to disclose their working to the public in exchange for limited exclusivity. But in addition to patents, more than one hundred countries around the world offer a "lesser" form of protection for innovations known variously as utility models, technical designs, petty patents, innovation patents, short-term patents, which this volume refers to collectively as "utility models."

Utility models have been contemplated alongside patents by the Paris Convention for the Protection of Industrial Property since 1911. Yet neither the Paris Convention nor any other major international agreement explicitly delineates the scope of utility model protection, which is left largely to the discretion of national and regional jurisdictions. The result of this lack of formal treaty guidance is a diverse set of utility model rules that lack significant harmonization across countries and regions and which have ebbed and flowed over time.

Despite their long history and widespread adoption, utility models remain, as Professor Mark Janis observed more than two decades ago, "a backwater of intellectual property." Compared to the large body of scholarly literature in other areas of intellectual property law, there is scant literature concerning utility models, and only a handful of empirical studies that focus on them.

This volume represents the first book-length study of utility models and other forms of sub-patent innovation protection around the world. It compares, contrasts, and critically analyzes these forms of protection in a range of jurisdictions while shedding light on the manner in which utility models are utilized by innovators and industry.

The international collaboration of scholars and legal practitioners that resulted in this volume began in February 2022. It involved several online workshops during the summer and fall of 2022, as well as a workshop hosted by the London School of Economics and Political Science in February 2023. Preliminary results of this

collaboration were presented at the European Policy for Intellectual Property (EPIP) conference held Krakow, Poland, in October 2023, as well as other conferences and symposia around the world.

Several chapters of this volume include empirical analyses of filing, assignment, and litigation data available from national patent offices, the World Intellectual Property Organization (WIPO), and IPLytics, a private patent analytics firm with which we have collaborated. Other chapters present statutory and regulatory analysis of local filing rules, case histories, and the experience of practitioners in this area. On the basis of these comparisons, we present conclusions, or at least offer hypotheses, regarding the relative effectiveness of utility model systems in achieving their purported goals, and the degree to which such systems can or should be harmonized to a greater degree.

We hope that this volume will become a definitive resource for intellectual property attorneys, patent offices, regulators, policymakers, academics, and judges who are confronted with these enigmatic and ever-changing forms of legal protection.

We are grateful to Matt Galway, Jadyn Fauconier-Herry, Balamuthukumaran Pasupathy, and the rest of the production and editorial staff at Cambridge University Press for helping bring this volume to fruition.