

List of Contributors

## Contents

	reword	XV
by Richard Arnold Preface		xvii
1	Utility Models and Other Forms of Sub-patent Protection	1
	Jorge L. Contreras, Martin Husovec, and Matthew Rimmer	
	1.1 Adoption of Utility Model Protection around the World	2
	1.2 Utility Models under International Agreements	3
	1.3 Characteristics of Utility Model Protection	6
	1.4 Assessing Utility Model Systems	11
	1.5 Contents of This Volume	17
2	Overview of Worldwide Utility Model Filings, Litigation	
	and Activity	19
	Daniel R. Čahoy, Jorge L. Contreras and Lynda J. Oswald	,
	2.1 Representation of Utility Model Systems across the World	19
	2.2 Descriptive Statistics on Utility Models	21
	PART I UTILITY MODEL LAWS AND PRACTICES AROUND	
	THE WORLD	
3	The Rise and Fall of the United Kingdom's Forgotten Utility	
	Model: The Utility Designs Act 1843	31
	Lionel Bently and Brad Sherman	
	3.1 The Background to the Utility Designs Act	32
	3.2 Reception of the Utility Designs Act	35
	3.3 Judicial and Administrative Responses	50
	1	

þage xi



Vl	Contents

	The Device of the Hullin Device Ask	
	<ul><li>3.4 The Demise of the Utility Design Act</li><li>3.5 Forgetting the Utility Designs Act 1843</li></ul>	70
	3.5 Polycumy die Ounty Designs Act 1043	77
4	Utility Models in Danish Law	86
	Tine Sommer, Timo Minssen and Jens Schovsbo	
	4.1 The Regulation of Utility Models in Denmark: Background	86
	4.2 Protectable Subject Matter and Substantive Criteria	88
	4.3 Utility Model Statistics	89
	4.4 Granting Procedure	92
	4.5 Fees, DKPTO	95
	4.6 The Administrative Appeal Procedure and Revocation by a	
	Court Decision	95
	4.7 Utility Model Infringement, Damages and Injunctions	96
	4.8 Branching-Off from a Patent Application or Patent	
	under Opposition	97
5	Utility Models in French Law	99
,	Thibault Gisclard	99
	5.1 Historical Background 5.2 Application Procedure	99
	5.2 Practical Use of Utility Certificates	100
	5.4 Publication of Utility Certificates	102
	5.5 Effectiveness of Utility Certificates	103
	5.6 Enforcement of Utility Certificates against Infringers	103
	5.7 Conversion between Utility Certificates and Full Patents	104 106
	5.8 Practical Use of Utility Certificates	
	3.0 Fractical Osc of Other Scrinicates	107
6	Utility Models in Germany and Switzerland	109
	Peter Georg Picht and Marian Weber	
	6.1 General Overview	109
	6.2 Protection and Granting Requirements	110
	6.3 Application Process and Associated Costs	112
	6.4 Challenging Validity	113
	6.5 Enforcing Utility Models	114
	6.6 Coexistence of Utility Models and Patents	115
	6.7 Utility Models in Switzerland?	116
7	Utility Models in Italy	117
	Alessandro Cogo and Marco Ricolfi	
	7.1 Sources of Law and Historical Development	117
	7.2 Subject Matter	118
	7.3 Requirements for Protection	118



	Contents	vii
	7.4 Relationship to Patents	119
	7.5 Conclusion	128
8	Utility Model Protection in Poland: In Search of a Regulatory	
	Framework Capable of Incentivizing Innovation Rafał Sikorski	129
	<ul><li>8.1 Historical Perspective</li><li>8.2 Relative Success of Utility Model Protection in</li></ul>	130
	Polish IP Law	133
	<ul><li>8.3 Rationale for Utility Model Protection</li><li>8.4 Current State of Utility Model Protection in Poland and the</li></ul>	136
	Planned Reform	139
	8.5 Conclusions	142
0	Voy Porformance Indicators for Utility Model Systems	
9	Key Performance Indicators for Utility Model Systems: An Application to Finland Jussi T. S. Heikkilä	144
	<ul><li>9.1 Key Performance Indicators for Utility Model Systems</li><li>9.2 Empirical Analysis of the Finnish Utility</li></ul>	145
	Model System	147
	9.3 Conclusions	167
10	Reinventing the Wheel: The Rise and Fall of the Australian	
	Innovation Patent	171
	Matthew Rimmer	
	10.1 The Petty Patent System 10.2 Innovation Patent	174
	10.3 Filing and Registration Data on Innovation Patents	179 182
	10.4 Litigation over Innovation Patents	183
	10.5 The Advisory Council on Intellectual Property	189
	10.6 The Productivity Commission	191
	10.7 IP Australia	194
	10.8 Abolition of the Innovation Patent	195
	10.9 Breakthrough Patents	198
	10.10 Conclusion	199
11	China's Utility Model Patent Legal System: Past, Present,	
	and Future	200
	Yu Yang	
	11.1 Foundation and Formation of China's Utility Model	
	Patent System 11.2 Main Features of Existing Chinese Utility Model Patent	201
	Legal System	207



viii Contents

	11.3 Deficiencies and Development Trends of Chinese Utility Model	
	Patent Legal System	210
	11.4 Conclusion	215
12	Utility Models in Japan	217
	Masabumi Suzuki	
	12.1 Outline of the Current Utility Model System in Japan	217
	12.2 Historical Development of Japanese Intellectual Property Law	,
	and the Utility Model Act	223
	12.3 Status and Use of the Utility Model System	229
	12.4 Recent Discussions on the System	231
13	Utility Models in Korea	232
	Sang Jo Jong	
	13.1 History of Utility Model Protection in Korea	232
	13.2 Statutory Rationale	233
	13.3 Subject Matter	233
	13.4 Substantive Requirements	<sup>2</sup> 34
	13.5 Procedure	234
	13.6 Registration	236
	13.7 Invalidation	237
	13.8 Infringement	238
14	Utility Models in Brazil	240
	Luca Schirru and Maikon Oliveira	
	14.1 The Brazilian Legal Framework on Utility Models	240
	14.2 Patents on Invention and Utility Models	243
	14.3 Administrative Procedure before the INPI	246
	14.4 Enforcing Utility Models in Brazil	249
15	Utility Models in Kenya	255
	Isaac Rutenberg	
	15.1 Contextualizing the Kenyan UMC	255
	15.2 Notable Aspects of the Legal Framework for UMCs in Kenya	257
	15.3 Trends in the Acquisition and Use of Kenyan UMCs	258
	15.4 Trends in the Acquisition of UMCs at ARIPO	260
	15.5 Conclusion	261
16	The Debate over Second-Tier Patent Protection in the	
	United States	262
	Jorge L. Contreras and Mark D. Janis	
	16.1 Current Forms of Invention Protection in the US	262



	Contents	ix
	<ul><li>16.2 The Debate over Sub-patent Protection in the US</li><li>16.3 Reflections on the Future of Utility Models under</li></ul>	266
	US Law	270
	16.4 Conclusion	277
	PART II UTILITY MODELS IN ACTION	
17	The Unitary Patent System and Utility Models	281
	Lisa van Dongen, Timo Minssen and Tine Sommer	
	17.1 The EU, the EPC and the UPCA	283
	17.2 Protecting UMs in (Some) EU Member States and the Tentative	
	Beginning of the UPC Arrangement	286
	17.3 Division of Judicial Competences Post-UPC	290
	17.4 The Relationship between Domestic Courts and	
	UPC Divisions	293
	17.5 Converting, Double Patenting and Branching	
	Off (BOUM)	298
	17.6 Discussion of Findings and Stakeholder	
	Choices	304
	17.7 Concluding Remarks and Open Questions	306
18	Treatment of Utility Models as Standards-Essential	
	Patents	308
	Jorge L. Contreras and Magnus Buggenhagen	
	18.1 Standards-Essential Patents and Utility Models	308
	18.2 Findings: Standards-Essential Utility Models	311
	18.3 Discussion	322
	18.4 Conclusion	328
19	Navigating Incomplete Harmonization: Businesses and the Utility	
	Model Environment	329
	Daniel R. Cahoy and Lynda J. Oswald	
	19.1 Global IP Strategy and the Challenge of Utility	
	Model Disharmony	330
	19.2 Evidence of Firm Utility Model Use and Strategy	332
	19.3 A New View on Utility Models: The Zone of	
	Appropriability Preference	334
	19.4 Business Strategy and Motivations for Utility	
	Model Filings: A Study of U.S. Patent-to-Utility	
	Model Pathways	338
	19.5 Insights on Navigating Utility Model Disharmony	339
	19.6 Conclusion	343



Contents

## PART III THE FUTURE OF SUB-PATENT INNOVATION RIGHTS

20	Utility Models and the European Union: A Fresh Look at the Need	
	for Harmonisation	347
	Martin Stierle	
	20.1 The Surprising Lack of Harmonisation	347
	20.2 Failed Attempts of the EC	349
	20.3 Two Reasons for the Harmonisation of UM Law	351
	20.4 General Reasons for UM Protection	355
	20.5 The Policy Options	359
	20.6 A New Conceptional Starting Point	367
	20.7 Conclusion	371
21	Heterogeneities in Utility Model Accessibility: Quantitative	
	and Qualitative Insights	373
	Dan Prud'homme	
	21.1 Accessibility of Utility Model Regimes	374
	21.2 Quantitative Analysis of Impact of Utility Model Regime	
	Accessibility on Utility Model Usage	376
	21.3 Qualitative Analysis of Impact of Utility Model Regime	
	Accessibility on Utility Model Quality	379
	21.4 Conclusions	386
22	Utility Models and Innovation in Low-Income Economies	387
	Uma Suthersanen	
	22.1 The Uneasy Discourse: Patents, Hybrids and Innovation	388
	22.2 Mapping a Sui Generis UM System	392
	22.3 Valuing "Real Innovation" in Developing Countries:	
	SDGs and the "Diverse Economies" Paradigm	396
Bib	liography	403
Inde	Index	