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Examination Guidelines for Patent Applications

Utility Model

This text is an integral part of the Patent Application Examination Guidelines setting out the current understanding of the BRPTO on utility models. Other inherent exam topics are listed and discussed in the general guidelines.

Patent Division - November 7, 2012

FEDERAL CIVIL SERVICE

MINISTRY OF DEVELOPMENT, INDUSTRY AND FOREIGN TRADE

BRAZILIAN PATENT AND TRADEMARK OFFICE

EXAMINATION GUIDELINES FOR PATENT APPLICATIONS

UTILITY MODEL

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1. INTRODUCTION

This text aims to clarify the utility model applications concepts, as well as establish the procedures related to the examination, in order to standardize and streamline the examination.

This Utility Model Patent Examination Guideline forms an integral part of the Patent Application Examination Guidelines, addressing matters related only to this topic. The other topics inherent to the examination are listed and discussed in the Patent of Invention Application Guidelines.

It is stressed that this guideline seeks to guide the procedures in general, with specific and / or exceptional cases being addressed in a coherent manner by the examiner.

2. DIFFERENCES BETWEEN UTILITY MODEL PATENTS AND THE PATENT OF INVENTION

The Brazilian Industrial Property Statute - Brazilian IP Statute - Statute #9,279 on May 14, 1996 defines the Utility Model as: Article 9. An object of practical use, or part thereof, is patentable as a Utility Model, when it is susceptible of industrial application presents a new shape or arrangement and involves an inventive act, that results in a functional improvement in its use or manufacture.

The difference between a Patent of Invention and a Utility Model Patent is of the utmost importance for anyone wishing to protect their creation. In principle, the inventor may request protection through a Utility Model Patent or a Patent of Invention.

However, the inventor must reflect on the best type of protection, and may better identify the kind (Invention or Utility Model) for his creation shape or arrangement introduced into the object for practical use, or part thereof, conferring a functional improvement on an object known at the state of the art, for its use or manufacture.

The utility model is a creation of something resulting from the intellectual capability of its creator, referring to an object for practical use or part thereof. This object must be three-dimensional (such as instruments, utensils and tools), presenting a new shape or arrangement that involves an inventive act and results in a functional improvement in its use or manufacture. It must be susceptible of industrial application. Systems, processes, procedures or methods for obtaining a product are not included in this type of protection.

In turn, the Invention is a creation of something resulting from the intellectual capability of its creator, representing a new solution to an existing problem in a specific technological area, endowed with inventive step. Inventions may be related to industrial products (compounds, compositions, objects, equipment, devices, etc.) and to industrial activities (processes, methods, etc).

Patents of Invention are intended to protect technical creations that solve problems in a specific technological area. While Utility Model Patents are objects that do not pursue a specific technical effect (in which case they would constitute an invention per se), they are intended to enhance the use of the object and may result in greater efficiency or convenience in the use thereof.

We may have creations of shape or arrangements classified as a Patent of Invention or a Utility Model. What determines the correct definition of the correct kind is an assessment of whether we are looking at an enhanced

effect or functionality which would be protected as a Utility Model Patent – or a new technical functional effect – which would be protected by a Patent of Invention.

3. UTILITY MODEL APPLICATION CONTENT

The Utility Model Application Patent must Contain:

- a. Title
- b. Specification
- c. Claim Chart
- d. Summary

Only the Utility Model Patent Claim Chart presents differences compared to the Patent of Invention. Remarks on the title specification, drawings and summary are set forth in the Patent of Invention Examination Guidelines. However, it must be stressed that drawings are essential for Utility Model Patent Applications, in order to ensure a perfect understanding of the claimed object.

3.1 FORMULATION OF CLAIMS

A claim must be formulated in the following manner:

- initial part, corresponding to the title;
- when necessary, a preamble containing the characteristics already comprised by the state of the art;
- necessarily, the expression “characterized by”, followed by a descriptive part containing the new
- shape or arrangement introduced, with all the elements that constitute it, as well as their positions and interconnections in terms of the entire set.

This separation between known and new elements is designed to facilitate this distinction, as it does not alter the range or scope of the claim, which shall always be determined on the basis of the sum of the characteristics set forth in the preamble and in the descriptive part.

Each claim must define in a clear, precise and in a positive manner, the technical characteristics to be protected thereby, avoiding expressions that result in a lack of definition for the claim.

The condition that the claims must be clear is applicable to individual claims as well as the Claim Chart as a whole. The clarity of the claims is of vital importance, as they define the object matter of protection. Thus, the meaning of the terms used in the claims must be clear to a person skilled in the art based on the wording of the claim, and grounded on the specification and drawings.

3.2 INDEPENDENT CLAIMS

Each application must contain a single, independent claim that describes the Model fully defining all the characteristics of shape or arrangement introduced that are essential for achieving the functional improvement.

3.3 DEPENDENT CLAIMS

Dependent claims shall be accepted only when:

- they refer to a complementary element for optional use that does not alter or modify the use and functioning conditions of the object;
- they refer to a variation in the shape or detail related to the elements constituting the components of the Model, defined in the first claim, and that do not alter the Model unit (technical, functional and corporeal unit of the object) and its functioning;
- they refer to the object in its three-dimensional shape in cases where the final configuration is secondary and derives from the assembly of a planned initial structure characterized in the first claim.

4. PROCEDURES RELATED TO THE EXAMINATION OF UTILITY MODEL PATENT APPLICATIONS

4.1 CLASSIFICATION

The rules for classifying Utility Model Patents are the same as those applicable to Patents of Invention, as set forth in the Strasbourg Agreement. Utility Models shall be classified according to their functions and applications, should the specification indicate a particular application for the claimed object.

In Utility Models, we have two clear concepts that should not be confused. One of these concepts addresses the function of the object, its functionality which is what the law refers to when addressing a functional improvement; the other concept is its use or application.

For example, we might have a box for packaging products. This is its function (described through verbs) “pack”.

However, we may have several applications or assorted technical fields, ranging from packing oranges to cans of paint. The two concepts are not to be confused.

4.2 SEARCH

For the Utility Model, the search for prior art document must always take into account the classification of the claimed object. It is important to state that the search for prior art document for a Utility Model Patent Application must always be conducted among objects with the same function. However, the examiner must set up the search field in compliance with the function and application of the object, as objects may be found in both of them with the same functionality as the proposal in the application under examination.

For example, a request object designed for packaging liquid products. During the search, an identical type of packaging was found for packing paste and / or granulated products. This prior art document must be taken into consideration in the analysis, as both objects have an identical function (packaging), regardless of their contents.

4.3 ANALYSIS OF PATENTABILITY REQUIREMENTS

4.3.1 INDUSTRIAL APPLICATION

Article 15. The Invention and the Utility Model are deemed to be susceptible of industrial application when they can be used or produced by any type of industry.

Article 15 is quite clear when specifying that the Utility Model is deemed to be susceptible of industrial application

when its object is liable or able to be manufactured or used by any type/kind of industry, including agricultural, extract and extractivist industries, as well as natural or manufactured products.

4.3.2 NEW SHAPE OR ARRANGEMENT (NOVELTY)

Article 11. The Invention and the Utility Model are deemed to be new when they are not included in the state of the art.

¶1 The state of the art consists of everything accessible to the public prior to the Patent Application filing date, through written or spoken description, use or any other means, in Brazil or elsewhere in the world, except for the provisions set forth in Articles 12, 16 and 17.

¶2 In order to ascertain novelty, the complete content of the application filed in Brazil and not yet published shall be deemed to constitute the state of the art as from the filing date thereof, or the claimed priority filing date, provided that it is published, even if subsequently.

¶3 The provisions set forth in the previous ¶ shall be valid for an international Patent Application filed under a treaty or convention in effect in Brazil, provided that this can be processed locally.

The new shape or arrangement, meaning the novelty, lies in the technical structural characteristics of the object that are not yet found in the state of the art, regardless of its function or field of application. The state of the art consists of all information available to the public prior to filing the Patent Application.

In conceptual terms, the novelty of the Utility Model is the same as that of an Invention, and must be ascertained through the sole document principle. The sole document principle refers to the fact that for any prior art document to be inhibitive, it must present in full all the elements of the technical solution for which novelty is claimed.

4.3.3 INVENTIVE ACT

Article 14. The Utility Model shall be taken to involve an inventive act when it does not derive in a common or usual manner from the state of the art, for a person skilled in.

The new shape or arrangement is the outcome of the inventive act. For an object already found at the state of the art, the inventive act characterizes an uncommon or not ordinary difference between these two objects, that is proposed by the application and that is anticipated by the state of the art. In other words, the difference must not be routine, habitual, normal, trivial or ordinary, for a person skilled in the art.

The definition of a person skilled in the art is comprehensive. A person skilled in the art might be someone with a fair knowledge of the state of the art at the time the application was filed, at the technical scientific level, and / or someone with practical operating knowledge of the object. It is considered that such persons have the means and ability to work and to execute routine experimentation, which is usual in the technical field in question.

When assessing the inventive act, a single prior art document shall preferably be used. In some situations in which the construction details of the object are found in a supplementary manner in some other prior art document, this may be used against the inventive act addressed by the application under examination, provided that this document presents construction details of the object.

Example: A Utility Model Patent Application was filed for a PET bottle cap, with weakening points (A), internal threads and a ring linked to the upper part of the cap by the weakening points, as shown in figure 1. The searches

found a document presenting a cap for liquids that had weakening lines (B), internal threads and a ring slightly larger than the PET bottle cap ring. In this case, the PET bottle cap is not identical to the cap found at the state of the art. However, weakening line B has the same function as weakening points (A), meaning that it separates the upper part of the cap from the ring and they both have the function of indicating any tampering with the receptacle (opened), which suggests the absence of an inventive act for the cap shown in Figure 1.

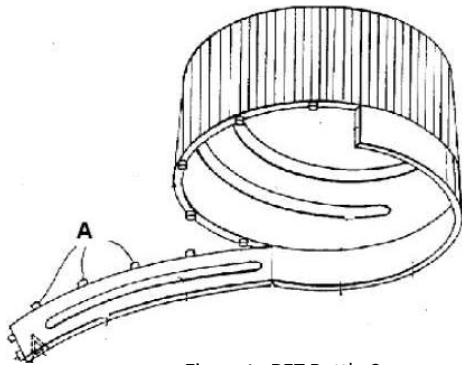


Figure 1 - PET Bottle Cap

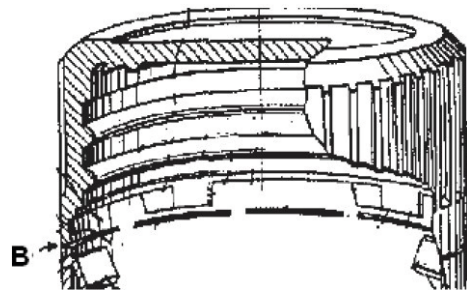


Figure 2 - Liquid Receptacle Cap

4.3.4 FUNCTIONAL IMPROVEMENT

The term “functional enhancement” appears in Article 9 of the Brazilian IP Statute:

Article 9. An object for practical use or part thereof is patentable as a Utility Model when susceptible of industrial application and presents a new shape or arrangement, involving an inventive act that results in a functional improvement for its use or manufacture.

Even if endowed with an inventive act, a new object is not patentable if it not encompass a functional improvement. Functional enhancement is related to the use of the object in a more practical, convenient and/or efficient manner for the use and/or manufacture thereof. Consequently, the functional enhancement must be declared by the applicant.

Article 9 of the Brazilian IP Statute requires the Utility Model Patent to be endowed with an inventive act that results in the functional enhancement of the use or manufacture of the object. Thus, in addition to this functional enhancement, the presence of a minimum level of inventiveness is also necessary, the inventive act. If we assume that inventive act and functional enhancement have the same meaning, this would imply that patents could be awarded for outcomes, as a functional enhancement of an object might be deemed to be common or ordinary for a person skilled in the art.

In other words, we must understand that the concepts of functional enhancement and inventive act are related but distinct concepts, whereby a trivial or ordinary variation that introduces a functional enhancement would not be protected by Utility Model due to the lack of an inventive act, thus not protecting the outcome.

4.3.5 DISTINCT, ADDITIONAL ELEMENTS AND CONSTRUCTIVE OR CONFIGURATIVE VARIANTS

The terms “constructive variant” and “additional and distinct elements” appear in the Brazilian IP Statute in the following Article:

Article 23. The Utility Model Patent Application must refer to a single main model which may include a plurality of distinct, additional elements or structural or configurative elements, provided that the technical, functional and corporeal unity of the object is maintained.

A constructive variant of a patentable object as a Utility Model is a modification to the part of the object that performs the main function of the object, meaning that it is a variation in the core element in question, although without altering the technical and functional unit.

Example: *Figure 3 presents a screwdriver with a square tip and Figure 4 shows a screwdriver with a domed tip. The domed tip of the screwdriver is a constructive variant of this object. The main element of the screwdriver, its tip, is altered in its shape, but its technical and functional unity is maintained, which is to turn a screw.*



Figure 3 - Screwdriver



Figure 4 - Larger screwdriver
with domed tip

The additional complementary element is another object that is secondary to the main object. For the above-mentioned screwdriver, a cover for the tip that is designed to protect it, or a clip on the handle for holding the screwdriver in a pocket are examples of additional complementary elements.

Both constructive variant and complementary elements, provided that they do not modify the conditions for the use and functioning of the object, are characteristics that must be addressed in dependent claims presented in the same application.

An example of modification to the technical functional unit of the above screwdriver is, for example, an alteration to its handle in order to prevent it from slipping out of the hands. This new characteristic was not addressed by the first model, and must consequently form the subject of another application.



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