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Comparison of "Dual Application of Invention and Utility Model" in Different Countries

I. Introduction

In Taiwan Patent Act, "patent" is classified into three categories: invention patent, utility model patent, and design patent. "Invention" means the creation of technical ideas, utilizing the laws of nature. "Utility model" means the creation of technical ideas relating to the shape or structure of an article or combination of articles, utilizing the laws of nature. "Design" means the creation made in respect of the shape, pattern, color, or any combination thereof, of an article as a whole or in part by visual appeal.

The subject matters eligible for invention patent and for utility model patent are not all the same. The subject matters eligible for invention patent includes composition of matter (object without definite shape), article (object with definite shape), and process; however, the subject matters eligible for utility model patent only include the shape or structure of an article or combination of articles (see table I). Regarding articles, applicants can choose to protect them by invention patents or utility model patents.

		Invention	Utility Model
Object	Composition of Matter	Yes	No
	Article	Yes	Yes
Process		Yes	No

Table I

Besides, "invention" patent can be granted for patent right after substantive examination based on patentability, while "utility model" patent can be quickly granted after completion of the formality examination without substantive examination. Therefore, the patent right of the utility model is unstable and uncertain.

Since the advantages and disadvantages of the invention patent and utility model patent are different, applicants are often confused about which one is better for them to protect their creations. This article will introduce the "dual application of invention and utility model", based on the amended Taiwan Patent Act which is promulgated on Dec. 21, 2011 and come into force as of Jan. 1, 2013

as well as the partially amended Taiwan Patent Act which is amended on May 31, 2013 and come into force as of Jun. 13, 2013, and compare the related regulations and practice in different countries.

II. "Dual Application of Invention and Utility Model" in Different Countries

A. Taiwan

Under Taiwan patent practice, Applicant can file an invention patent application and a utility model patent application for the same creation on the same date ("Dual Application of Invention and Utility Model").

According to Paragraph I, Article 32 of Taiwan Patent Act in the immediate prior amendment, where an applicant files an invention patent application and a utility model patent application for the same creation on the same date, if the utility model patent application has been granted before a decision of admission is issued on the invention patent application, Taiwan Intellectual Property Office (TIPO) shall notify the applicant to select one patent application within a specified time limit. The invention patent application shall not be granted if the applicant fails to make the election within the specified time limit.

That is, where an applicant files an invention patent application and a utility model patent application for the same creation on the same date, when the TIPO determines the invention patent is allowable, it will notify the applicant to select one patent within a specified time limit if the utility model patent application has been granted. Since Applicant can file an invention patent application and a utility model patent application for the same creation on the same date, Applicant can obtain the patent protection first by the granted utility model patent if the utility model patent application passes the formality examination, and then obtain the patent protection by the granted invention patent if the invention patent application passes the substantive examination accompanying with giving up the utility model patent right.

Furthermore, according to Paragraph II, Article 32 of the Taiwan Patent Act in the immediate prior amendment, where the applicant selects the invention patent application according to the provision set forth in the preceding paragraph, the utility model patent right shall be deemed non-existent ab initio.

That is to say, when the applicant selects the invention patent, the utility model patent shall be deemed non-existent ab initio in the immediate prior amendment. However, this provision has been modified in the partially amended Taiwan Patent Act.

According to the Paragraph I, Article 32 of the Taiwan Patent Act in the current partially amendment, where an applicant files an invention patent application and a utility model patent application for the same creation on the same date, the applicant should state the fact respectively upon filing the applications; if the utility model patent application has been granted before a decision of admission is issued on the invention patent application, TIPO shall notify the applicant to select one patent application

within a specified time limit. The invention patent application shall not be granted if the applicant fails to state the fact respectively upon filing the applications or make the selection within the specified time limit

According to Paragraph II, Article 32 of the Taiwan Patent Act in the current partially amendment, where the applicant selects the invention patent application according to the provision set forth in the preceding paragraph, the utility model patent right ceases from the date of the announcement of grant of the patent for invention.

Article 32 of the Taiwan Patent Act in the current partially amendment avoids the potential problems of the provision set forth in the immediate prior amendment that the utility model patent shall be deemed non-existent ab initio when the applicant selects the invention patent described above. It gives Applicant a continuous protection of patent right because the utility model patent right ceases only from the date of the announcement of grant of the patent for invention (not to be deemed non-existent ab initio) when the applicant selects the invention patent application. It will highly protect the benefit of Applicants regarding their creations and avoid potential problems if the utility model patent right is deemed non-existent ab initio.

B. China

According to Article 9, Paragraph 1 of the Patent Law and Rule 41, Paragraph 2 of the Implementing Regulations thereof, where an applicant files on the same day applications for both patent for utility model and patent for invention relating to the identical creation, if the patent for utility model has been granted and does not terminate, and the applicant has stated the fact respectively upon filing the applications, double patenting may be avoided by amending the invention application, or alternately by abandoning the patent for utility model. Therefore, during the examination of the invention application mentioned above, if the invention application has met all the other conditions for patentability, the applicant shall be notified to make a choice or make amendments. Where the applicant chooses to abandon the patent for utility model which has been granted, he shall submit a written declaration to abandon the patent for utility model at the time of making response to the Office Action. In this case, the examiner shall issue Notification to Grant Patent Right regarding the invention application which has met all the conditions for patentability but has not been granted yet, and transfer the written declaration of abandoning the patent for utility model mentioned above to the relevant examination departments for registration and announcement by the Patent Office. In the announcement, it shall be indicated that the patent right for utility model mentioned above ceases from the date of the announcement of grant of the patent for invention.

That is, under China patent practice, Applicant can also file an invention patent and a utility model patent relating to the same creation on the same day. The applicant should state the fact of dual filing upon filing an invention patent application and a utility model patent application. If the applicant

chooses the invention application, the patent right for utility model ceases from the date of the announcement of grant of the patent for invention.

C. Japan

According to Paragraph 4, Article 39 of Japan Patent Law, where an invention and a device claimed in applications for a patent and a utility model registration are identical (excluding the case where an invention claimed in a patent application based on a utility model registration under Article 46-2(1) (including a patent application that is deemed to have been filed at the time of filing of the said patent application under Article 44(2) (including its mutatis mutandis application under Article 46(5)) and a device relating to the said utility model registration are identical) and the applications for a patent and a utility model registration are filed on the same date, only one of the applicants, selected by consultations between the applicants, shall be entitled to obtain a patent or a utility model registration. Where no agreement is reached by consultations or no consultations are able to be held, the applicant for a patent shall not be entitled to obtain a patent for the invention claimed therein.

Regarding dual application of invention and utility model by the same applicant on the same day, Applicant has to choose one of them. If Applicant does not choose one of them, the invention patent will be rejected since the utility model has been registered.

D. German

According to Paragraph 1, Article 5 of German Utility Model Act, where an applicant has already sought, at an earlier date, a patent with effect in the Federal Republic of Germany for the same invention, he may file together with the utility model application a declaration claiming the date of filing relevant for the patent application. Any priority right claimed in respect of the patent application shall also apply to the utility model application.

According to Paragraph 1, Article 40 of German Patent Act, within a period of 12 months from the filing date of an earlier patent or utility model application filed with the Patent Office, the applicant is entitled to a priority right with respect to the application for the same invention unless a domestic or foreign priority was already claimed for the earlier application.

It can be understood from the above description, for the same creation, Applicant can file an invention patent application and a utility model patent application at the same time or at different time. If the invention patent application is filed earlier, the utility model patent application can claim the priority of the invention patent application. Therefore, under German patent practice, Applicant can file both invention patent application and utility model patent for the same creation on the same or different day and can own the invention patent and the utility model patent at the same time. However, the patentee can only exercise the patent right of the invention patent or the utility model patent.

E. United States and United Kingdom

United States and United Kingdom do not

have the system of utility model patent, therefore, it is not allowed for dual application of invention and utility model in United States and United Kingdom.

III. Comparison

The practice of "dual application of invention and utility model" are different from country to country. In Taiwan and China, dual application of invention and utility model is allowed, and the utility model patent right is ceased after the invention patent application is chosen and granted. In Japan, Applicant has to choose one of invention patent application and utility model patent application. In German, the invention patent and the utility model patent can exist together.

Through "dual application of invention and utility model", Applicant can file an invention patent application and a utility model patent application for the same creation on the same date, to obtain the utility model patent right quickly to protect their creation as soon as possible, and then obtain the stable and certain right of the invention patent to protect their creation. Considering the differences on regulation and practice of the "dual application of invention and utility model" among different counties may be helpful in the strategy of worldwide patent protection.