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Utility Models in Germany and Switzerland

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6.1 GENERAL OVERVIEW

In Germany, the utility model is a type of intellectual property right that provides protection for novel and useful inventions. It is governed by the German Utility Model Act (*Gebrauchsmustergesetz* – GebrMG) which was enacted in 1891, making it the oldest still-existing utility model system in the world.[1] Utility models grant the right holder exclusive control over the use and commercialization of an invention for a period of ten years from the date of filing, subject to the payment of annual renewal fees. In a way, the utility model is the "little sister" of a full-fledged patent (also called a "petty patent"), protecting the same type of subject matter (technical inventions) with a more limited scope (discussed in more detail below).

The origins of the German utility model date back to the late nineteenth century, a period of rapid industrialization in which industry endorsed strong legal protection for its innovations. After the introduction of the first German patent law in 1877, it was soon recognized that patent law might not be suitable for all types of inventions and that an additional protection regime for inventions with less stringent protection requirements was desirable.[2] Unsurprisingly, demand for utility models was high from the outset. Just about two weeks after the German Utility Model Act entered into force on 1 October 1891, sixty-eight utility models had already been applied for in different technical categories.[3] Today, approximately 10,000 utility models are issued in Germany each year,[4] predominantly in the construction sector (mechanical engineering and machinery), followed by transport, furniture, games, electric

[1] Heikkilä and Lorenz 2018, 8. The Act was amended by Decree of 28 August 1986; last amended on 10 August 2021. We recognize, of course, the older utility design system established in the UK in 1843, but which is no longer in existence (see Chapter 3).

[2] Suthersanen 2016, 15.

[3] DPMA 2024a.

[4] DPMA 2024b.

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machines and devices, and medical technology.[5] All registered utility models are accessible in a searchable database administered by the German Patent and Trademark Office ("*Deutsches Patent- und Markenamt*"; DPMA).[6] After a peak of utility model grants in the late 1990s, a general downward trend in applications can be observed which seemingly corresponds to a downward trend in the filing of patent applications.[7] Some scholars propose far-reaching adjustments to the utility model protection system.[8] Others wonder whether the use of utility models will intensify, for example, for the protection of standard-essential technology that tries to escape patent and competition law's stricter FRAND licensing guardrails.[9] So far, however, German utility model law and use have proven rather stable.

6.2 PROTECTION AND GRANTING REQUIREMENTS

According to § 1 (1) Utility Model Act, utility model protection requires an invention that is new, industrially applicable, and embodying an inventive step.

6.2.1 *New Invention*

Just as patents, utility models protect only inventions of a technical nature and not, for instance, aesthetic creations of form, works of art, scientific theories, mathematical methods, or software (§ 1(2) GebrMG). In contrast to patent law, neither processes (§ 2(3) GebrMG) nor biotechnological inventions (§ 1(2) GebrMG) can be protected by utility models.

The invention is considered "new" if it does not belong to the state of the art at the priority date (§ 3(1) GebrMG). Prior art for a German utility model is only what has been made available, prior to the filing or priority date, to the public either by written description or by prior use in Germany (§ 3 (1) GebrMG). This is narrower than German patent law which considers prior art whatever is known to the public worldwide through written or oral description, use, or in any other manner (§ 3 PatG).

6.2.2 *Inventive Step and Industrial Applicability*

In particular because the historical legislature intended the utility model to protect smaller inventions and technical designs, the traditional interpretation, which still prevails in the legal literature, considered "inventive step" to require a lesser degree

[5] DPMA 2024b.
[6] The database can be accessed online: https://register.dpma.de/DPMAregister/pat/basis
[7] Boschert 2014, 144; Heikkilä and Lorenz 2018, 10.
[8] Takenaka 2021c (suggesting inter alia abolition of the written description requirement and removal of owner exclusivity in favor of statutory licensing rights).
[9] See Chapter 16 (Standard-Essential Utility Models).

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of inventive performance than the "inventive activity" stipulated in § 1(1) German Patent Act.[10] Generally speaking, this interpretation considers it sufficient if the person having ordinary skill in the art (PHOSITA) – this concept is largely the same as in German patent law[11] – makes the invention by reflecting on the prior art beyond a routine employment of his skills and prior art.[12]

Since 2006, however, the German Federal Court of Justice (*Bundesgerichtshof* – BGH), the highest first-instance court in utility model matters, has held that the inventiveness threshold is the same for patent and utility model law.[13] The BGH points out,[14] in particular, that a threshold even lower than the one currently applied in patent law would risk permitting an excessive monopolization of trivial achievements. The rather limited differences in the level of protection between patents and utility models would not justify such extensive utility model protection. The legislative intent of easier access to utility model protection is sufficiently observed by the narrower concept of prior art, which prevents the grant of a utility model for truly nonnovel inventions. As reflected by the BGH's decision, "inventive step" is a matter of law, albeit one that strongly depends on the factual circumstances of the case, and high instance courts can, thus, review it on appeal.[15]

Industrial applicability is assumed if the invention can be made or used in any area of commerce or agriculture (§ 3(2) GebrMG).

6.2.3 *Limited Pre-grant Examination*

In the application procedure for a utility model, the German Patent and Trademark Office (*Deutsches Patent- und Markenamt*; DPMA) does not assess novelty, inventive step, or industrial applicability of the invention (§ 8(1) GebrMG). If the application complies with the formal requirements of §§ 4, 4a, 4b GebrMG, the utility model is granted as an "unexamined IP right",[16] entered in the Utility Model Register, and published in the Patent Gazette (§ 8 Section 1 GebrMG). Because of this limited pre-grant examination, the registration procedure to obtain a utility model is (as of 2021) completed after 4.2 months on average.[17] This is much faster than the patent granting procedure which is usually completed after approx. 2.5–3 years.[18]

[10] Mes 2013, 140.
[11] BpatG GRUR 2008, 689 – *Scharnierkonstruktion*.
[12] BPatG GRUR 2006, 489 – *Schlagwerkzeug*; 2004, 852 – *Materialstreifenpackung*.
[13] BGH GRUR 2006, 843 – *Demonstrationsschrank*.
[14] See, from the lead decision, BGH GRUR 2006, 843 para. 18 seq. – *Demonstrationsschrank*.
[15] BGH GRUR 2012, 378 Rn. 16 – *Installiereinrichtung II*.
[16] DPMA 2017, 4.
[17] DPMA 2024c. See also Heikkilä and Lorenz 2018, 10.
[18] DPMA 2024d.

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6.3 APPLICATION PROCESS AND ASSOCIATED COSTS

According to § 4, 4a GebrMG the application for a utility model is filed with the DPMA. The DPMA provides an application form for the registration of a utility model on its website.[19] The application must be accompanied by a description of the known prior art and the structure and advantages of the applicant's invention. The description may be supplemented by one or more technical drawings. The application must contain claims which delineate the essential features of the invention and determine the scope of protection (§ 4(3) GebrMG). There also is a novelty grace period pursuant to § 3(1)(3) GebrMG that caters to the need, for example, of individual inventors or R&D companies, to disclose inventions early on, prior to filing.[20] Due to the grace period, protection is still available if an inventor applies for a utility model registration within six months after the publication of the invention.[21]

In principle, anyone can file a utility model application without the need to involve an attorney. However, applicants not domiciled in Germany must be represented by a duly authorized attorney.

6.3.1 *Branching-Off*

A utility model cannot be turned into a patent, by application or otherwise, and vice versa. However, an important statutory mechanism for combining patent and utility model protection is known as "branching-off" (*Abzweigung*) applications under § 5 GebrMG. Such applications allow an applicant to claim the filing and, if applicable, priority date of a previously submitted patent application also for a subsequent utility model application provided the latter application concerns the same invention. Technically, the applicant provides a written declaration together with the utility model application referring to a previously submitted patent application with effect for the Federal Republic of Germany.[22]

However, there is controversy on the interpretation of what is considered the "same" invention. According to a narrower interpretation, the invention is considered the "same" if there is a literal correspondence and content identity between the submitted documents describing the invention for, respectively, the patent and the utility model application.[23] According to another opinion, the invention is the "same" if the subject matter of the branched-off utility model application is readily

[19] DPMA 2024e.

[20] German Bundestag, Drucksache 14/2879, 10 March 2000, 13.

[21] § 4a (1) GebrMG.

[22] The procedure in which the patent is sought is irrelevant for that matter. For example, the previous patent application could have been requested via a national application according to the German Patent Law, a European application according to the European Patent Convention [EPC], or an international application according to the Patent Cooperation Treaty [PCT].

[23] I.e. identity of documents (*Unterlagenidentität*); see also Schennen GRUR 1987, 22, 226/227; Mes 2020.

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recognizable, to a person skilled in the art, in the related patent application.[24] The different views can have implications, for instance, regarding foreign language patent applications – literal conformity of the application documents cannot be achieved in such settings. This somewhat formalistic outcome suggests, in view also of the branching-off mechanism's rationale to facilitate parallel patent/utility model protection (cf. also below V.), the broader concept of the "same" invention as the more convincing one.[25]

The Federal Court of Justice has held[26] that even a utility model application the subject matter of which goes beyond that of the referenced patent application can claim the priority date of said patent application to the extent the two applications overlap. This, as it were, extensive reading of the branching-off concept does not consider the overlapping utility patent application to be invalid, as previous practice[27] would have.

6.3.2 *Costs*

For a utility model application, a filing fee of EUR 40 is due within three months from filing the application. In the case of an electronic application, the filing fee is EUR 30. Fees for maintenance[28] of the utility model are due after three, six, and eight years. If the respective maintenance fee is paid not at all, not in time, or not in full, the utility model lapses.[29]

6.4 CHALLENGING VALIDITY

According to § 15(1) GebrMG anyone can challenge a registered utility model and request its cancellation[30] either (a) if the subject matter of the utility model is not eligible for protection according §§ 1 to 3 GebrMG; (b) if the subject matter of the utility model has already been protected on the basis of an earlier patent or utility model application; or (c) if the subject-matter of the utility model goes beyond the content of the application in the version in which it was originally filed. If the grounds for cancellation concern only part of the utility model, the cancellation takes effect only to that extent. If the subject matter of the utility model is challenged for lack of eligibility, the court evaluates the substantive criteria of novelty, inventive

[24] BPatGE 35, 1 = GRUR 1995, 486; see also BPatGE 39, 10; BPatG Mitt. 1996, 211, 213; Mes 2020.
[25] See also Kraßer, GRUR 1993, 223, 226, 227; Goebel, GRUR 200, 477, 428 f.
[26] BGH GRUR 2003, 867.
[27] BPatGE 34, 14 = GRUR 1993, 963; Mes 2020.
[28] DPMA 2024f.
[29] DPMA 2024c.
[30] A request for cancellation of the utility model must be filed with the German Patent and Trademark Office, in writing, and contain a statement of the facts on which it is based (§16 GebrMG).

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step and industrial applicability during the procedure. This ex post review thus steps in for a full-fledged ex ante examination of the utility model.

The utility model division of the German Patent and Trademark Office decides validity challenges by way of a formal decision (§17(3) GebrMG). This decision can be appealed to the Federal Patent Court and, ultimately, to the Federal Court of Justice (§ 18 GebrMG).

The relatively low threshold for a validity challenge, especially broad standing, renders utility models considerably less resilient than patents and has, for this reason, attracted some criticism.[31] On the other hand, the easier assailability of utility models may counterbalance the lower requirements for obtaining a utility model, especially the lack of a full-fledged ex ante examination.

6.5 ENFORCING UTILITY MODELS

A utility model can be enforced against an infringer in court according to §§ 24 seq. GebrMG. Any person who, without the consent of the proprietor of the utility model, manufactures, offers for sale, puts on the market, uses, imports, or possesses a product which is covered by the subject matter of the utility model may be sued by the proprietor for an injunction if there is a risk of repeated infringement (§ 24(1)(1) GebrMG). The right to injunctive relief already exists if there is a substantiated threat of a first offence (§ 24(1)(2) GebrMG). Neither the motives of the (possible future) infringer[32] nor fault on its part[33] matter. However, the right to injunctive relief is limited by the proportionality defense (§24(1)(3) GebrMG): Insofar as the claim would, due to the special circumstances of the individual case and the requirements of good faith (*Gebote von Treu und Glauben*), lead to a disproportionate hardship for the infringer or third parties that cannot be justified by the exclusive right of the rightsholder, the rightsholder is to receive only an appropriate financial compensation (*angemessener Ausgleich in Geld*). The claim for damages, however, remains unaffected (*unberührt*) by the proportionality defense (§24 (1)(5) GebrMG). This provision was introduced in utility model law together with an equivalent provision in German patent law in August 2021,[34] thereby transposing existing, but still developing, case law[35] regarding a proportionality defense into statutory law.[36]

In case of fault, the infringer of a utility model is also liable for damages (§ 24(2) GebrMG). When assessing damages, courts may also consider the infringer's infringement profit (§ 24(2)(2) GebrMG). According to § 24 (2)(3) GebrMG, the

[31] Boschert 2014, 144; Brack 2009, 11.
[32] Mes 2020, § 24 GebrMG, Rn. 41 et seq.
[33] Judgment of the German Federal Court of Justice (BGH) of 6 July 1954, I ZR 38/53, BGHZ 14, 163 (170).
[34] Entwurf eines Zweiten Gesetzes zur Vereinfachung und Modernisierung des Patentrechts.
[35] BGH, 10 May 2016, X ZR 114/13 – Wärmetauscher ("Air Scarf").
[36] On the discussions around this revision, see, e.g., Picht and Karczewski 2022, 159 et seq. with further references.

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claim for damages may also be calculated based on the amount that the infringer would have had to pay as reasonable remuneration if it had obtained permission to use the invention ("license analogy").

Furthermore, the rightsholder may demand the destruction of infringing products (§ 24a(1) GebrMG), as well as their recall and definitive removal from the channels of distribution (§ 24a(2) GebrMG). These claims are equally subject to a proportionality requirement which takes the legitimate interests of third parties into consideration (§24a(3) GebrMG).

The holder of a utility model can also require the infringer to provide information on the origin and the distribution channels of the infringing products (§24b(1) GebrMG). Further claims go to the production of specific documents or to inspections (§24c(1)(1), (2) GebrMG). If there is a legitimate interest, the court may grant the winning party permission to publish the judgment at the expense of the losing party (§ 24e GebrMG).

Intentional infringement – including the exercise of rights conveyed by a granted patent which results in the infringement of a previously granted utility model – can, upon request by the rightsholder or in case of sufficient public interest, be punished under criminal law with up to three years of imprisonment or a fine (§25(1) GebrMG), for commercial activity up to five years imprisonment (§ 25(2) GebrMG). The attempt is punishable as well (§25(3) GebrMG).

6.6 COEXISTENCE OF UTILITY MODELS AND PATENTS

Both utility models and patents protect technical inventions, and they share protection requirements, such as novelty, inventive step/activity, and industrial applicability. The German legal framework allows for the usage of both patents and utility models in a combined or complementary fashion.[37] This "two-tiered patent system"[38] can be used better to coordinate the protection of inventions, for example, by using a joint priority date (c.f. § 5 GebrMG).

As outlined above, utility models, unlike patents, do not require a substantive ex ante examination of novelty, inventive step, or commercial applicability to be granted, making the application process much simpler, faster, and cheaper. On the other hand, they provide a much less reliable legal position as challenges have a higher likelihood of success.[39] Self-assessment costs regarding a utility model's validity (e.g., in preparation for a potential infringement litigation) may even reduce or remove the utility model's cost advantages over a full-fledged patent that issues only after full examination.[40] Against this background, utility models are in practice often used by rightsholders that eventually want to obtain a patent but

[37] Boschert 2014, 139.
[38] Heikkilä and Lorenz 2018; Liesegang 1992, 3.
[39] Heikkilä and Lorenz 2018; Radauer et al. 2015; Suthersanen 2006.
[40] Mes 2020, § 49 GebrMG, Rn. 3.

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need to quickly secure rights during the period between the patent application and the grant of the patent.[41] Holding a utility model for the same invention can also prove advantageous in litigation if the patent applicant wishes to fight an infringement during the patent application procedure.[42]

6.7 UTILITY MODELS IN SWITZERLAND?

Under Swiss law there does not exist a utility model. Swiss patents are, essentially, subject to the same protection requirements as German patents.[43] However, the protection requirements of novelty, inventive step ("non-proximity"; *Nicht-Naheliegen*), and industrial application are not examined prior to the grant of a Swiss patent.[44] In this regard, the Swiss patent is similar to the German utility model. Hence, to obtain greater legal certainty, many Swiss inventors do not file for a Swiss (national) patent but instead seek a – fully examined – European patent, granted under the European Patent Convention and whose scope of protection they opt to extend to Switzerland.

To make the Swiss patent more attractive to users and to better comply with international standards, a revision of Swiss patent law is currently under way, with a view to introducing a patent (alternative) that will have a substantive examination system covering novelty and inventive step. Early in the legislative process, the introduction of an unexamined utility model complementing the patent was on the table as well. During the consultation process, however, the idea was dropped because stakeholders preferred the stronger protection offered by the current patent without full-fledged ex ante examination.[45] Instead of introducing two separate intellectual property rights, the draft now favors a flexible design[46] of the new patent right: Upon filing an application, the IPI will conduct obligatory research on the state of the art and publish its finding in a report.[47] During the application process the applicant will have the option to request a full-fledged examination of the patentability requirements, including novelty, inventive step, and commercial applicability.[48]

In January 2023 the Swiss Parliament began deliberations on the revision of the Patent Law. As of this writing, the outcome and timeline seem open.[49]

[41] Boschert 2014, 143.
[42] Brack 2009, 6.
[43] Articles 1, 14 Swiss Patent Act.
[44] Article 59(4) Swiss Patent Act.
[45] Botschaft zur Änderung des Patentgesetzes vom 16. November 2022, BBl 2023 7, 10.
[46] Recitals on the amendment of the Patent Act, 19.
[47] nArticle 57a Swiss Patent Act.
[48] nArticle 58b (4) revSwiss Patent Act.
[49] www.parlament.ch/de/ratsbetrieb/suche-curia-vista/geschaeft?AffairId=20220078.

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