

NATIONAL FILING

DURATION OF THE UTILITY MODEL – LEGISLATION – WHAT IS A UTILITY MODEL? – PROCEDURES (FILING AND CONCESSION) – PROTECTION

Duration

A patent for a utility model lasts for 10 years from the date on which the application was filed, and is subject to an application and grant tax, payable at the time of filing and covering the first five years, and to a renewal of the tax to cover the second five-year period.

Back to top

Legislation

This type of protection is at present subject to the Code of Industrial Property Rights approved by decree No. 30 of February 10, 2005 in force on March 19, 2005. Section V (Articles 82-86) of Decree No. 30 on utility models corrects and abrogates the preceding regulations in force under the Models Law approved by Royal Decree No. 1411 of August 25 1940 that established protection by individual patenting of utility models and ornamental models (now designs and models).

Back to top

What is a utility models?

The following description is given in Article 82 of Decree No.30, 2005: a patent for a utility model can be granted to the new models characterized by their particular efficiency or convenience in use or in their application to machinery or to its parts, to instruments, tools and objects generally such as the new models presenting particular conformations, dispositions, configurations or combinations of parts.

Back to top



Procedures (filing and grant)

The patent application for a utility model is sent to the Italian Patent and Trademark Office or to a Chamber of Commerce competent to deal with it.

Back to top

Protection

The patent for a utility model confers a monopoly of exploitation taking concrete shape in a sole right to manufacture and sale (import included) throughout the country. This right is assured by law to prevent counterfeit and to refund the owner from any harm suffered, including urgent measures such as prohibition, confiscation, description. The monopoly ceases when the invention is first put onto the market by the owner or licensee

Duration is still for a period of ten years but here the comparison with the present “designs and models” ceases since these latter are subjected to registration only. It is therefore possible to accumulate forms of protection on a single product; for example, by patenting the form of the product as a utility model and at the same time registering its distinctive form as a “design or model”. It is of course not possible to add this to the potentially unlimited protection provided by registering the form as a trademark.

In evaluating the type of patent the problem arises of choosing between one for an industrial invention (lasting twenty years) and one for a utility model (ten years). Comparing the two it is clear that the originality of the former essentially concerns the form of the product in its function of solving a certain technical problem, while the originality of the model lies in the form that confers efficacy in use. The distinction between the two is not easily made and might give rise to misunderstandings. Fortunately, the law envisages the possibility of alternative filing and of conversion of patent rights. The following is specifically stated: “anyone seeking to patent an industrial invention, in accordance with this present code, can simultaneously present an application to patent a utility model to become valid if the first is not granted or only partially granted”. Further if a patent for an industrial invention is not granted, the owner can request the judicial authority to ascertain the presence of requisites for granting a patent for a utility model and, if this is secured, arrange conversion of the first patent to the second.

Back to top

