

E U R O P E A N   E C O N O M I C   A R E A

S T A N D I N G   C O M M I T T E E  
O F   T H E   E F T A   S T A T E S

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13 October 1998  
Brussels

**WORKING GROUP ON INTELLECTUAL PROPERTY**

**Comments by the EFTA Working Group on the Proposal for a European Parliament and Council Directive approximating the legal arrangements for the protection of inventions by utility model (COM(97) 691 final)**

**I     General Comments**

1.     The EFTA States have with great interest taken note of the Commission's proposal for a European Parliament and Council Directive approximating the legal arrangements for the protection of inventions by utility model.
2.     None of the EFTA States have utility model protection. The EFTA States are of the opinion that there could be a need for harmonizing the utility model regimes within the EEA. The EFTA States would, however, like to propose some amendments to the Commission's proposal.
3.     The EFTA States would like to question the lack of rules in the proposal concerning the classification, registration and publication procedure of utility models. We find that common rules in this field would serve the interest of the whole Community.

*General comments concerning the lack of opposition rules*

4.     Iceland and Norway find the possibility of opposition, at Patent Office level, against the registration of a utility model of great importance. Third parties' possibility to contest rights granted in a cheap and rapid way depends on rules concerning publication and opposition. Opposition rules will also give the proprietor better security regarding rights granted and reduce the chances that there will be granted protection for inventions which do not meet the requirements of the Directive. The disadvantages obtained by having opposition rules, such as longer time lapse from filing to a final grant of protection, in those registrations which are subject to opposition [possibly few], are considered to be outweighed by the public interest in granting protection only to inventions which meet the requirements of the Directive. It should be kept in mind that utility models which are given protection, while not actually meeting these requirements, represent obstacles to trade. In this light, Iceland and Norway, will advocate the need for opposition rules and indicate that such rules will be considered in possible future national legislation on utility models.

*Costs*

5. The EFTA States would like to question the “low cost” - side to utility models. The fees which the Patent Offices charge are not significant in the total expense in seeking patent protection nor utility model protection. Additional costs arise from the assistance of experts. The applicants for a utility model protection will have to use patent experts to a large extent, for example in formulating the claims and interpreting the extent of the granted protection. Translation costs will also be high, although the text will most often be shorter than for patents. In the opinion of the EFTA States, the cost concerned is not the predominant reason for adopting utility model protection.

**II Specific Comments***Comments concerning Article 5 (Novelty).*

6. The EFTA States welcome the requirement of absolute novelty. Paragraph three should however include, in addition to the content of utility model applications, the content of patent applications.

*Comments concerning Article 6 (Inventive step)*

7. The EFTA States feel that it might be appropriate to consider another wording regarding “inventive step” in this article. It is quite clear that the Article contains different requirements as to “inventive step” compared to patents, and this should be precisely indicated. The current wording says: “For the purposes of this Directive, an invention shall be considered as involving an inventive step if”.. We find that another legal term should be found describing the conditions in this article, for example “level of inventiveness”, which clearly differs from “inventive step”. The term “inventive step” should be reserved for patents. In any case, clear criteria with regard to the difference between patents and utility models in that respect should be elaborated on.

*Comments concerning Article 7 (Industrial application)*

8. The EFTA States would like to propose deleting the term “including agriculture” in paragraph one. The traditionally wide definition of “industry” in industrial property right law comprises agriculture.

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