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ATTORNEYS

Examination Guidelines for Utility Model Patents

BRPTO/PR Rule #85

April 9, 2013

v. 1.0 - November 13, 2024

THE PRESIDENT OF THE BRAZILIAN PATENT AND TRADEMARK OFFICE and the PATENT DIRECTOR, in the exercise of their powers, and

WHEREAS it is necessary to standardize criteria for the examination of utility model patent applications,

WHEREAS it is necessary to improve patent application processing procedures to enhance efficiency and ensure quality;

WHEREAS, finally, the Specialized Attorney's Office of this Office has evaluated and considered the "Examination Guidelines for Utility Model Patent", attached to this Rule, fully compliant with Law #9,279/96.

HEREBY DECREES:

Article 1. To standardize the examination of utility model patents in accordance with the "Examination Guidelines for Utility Model Patent", attached to this Rule, making it a mandatory reference in the examination of utility model patent applications submitted to the BRPTO.

Article 2. BRPTO/PR's Rule #298, of November 7, 2012, is hereby repealed.

Article 3. The aforementioned "Examination Guidelines for Utility Model Patent" shall be published in BRPTO's Official Gazette, as well as on the BRPTO's internet portal.

/signature/
Júlio César Castelo Branco Reis Moreira
Patent Director

/signature/
Jorge de Paula Costa Ávila
President

SUMMARY

1. Introduction

This text aims to clarify the concepts related to Utility Model Patent applications and to establish the procedures for their examination, with the aim of standardizing and streamlining the application review process. This examination guideline for Utility Model Patents is an integral part of the broader examination guidelines for patent applications, focusing on topics specific to this nature. The other inherent examination topics are listed and discussed in the examination guidelines for utility patent applications. It should be noted that this guideline seeks to guide the procedures in general, and that special and/or exceptional cases will be addressed consistently by the examiner.

2. Differences between Utility Model Patent and Utility Patent.2.1 Unit of invention

The Brazilian Patent Statute – Law #9,279, of 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 to industrial application, presents a new shape or arrangement, and is non-obvious, resulting in a functional improvement in its use or manufacture.

The differentiation between Utility Patent and Utility Model Patent is of the utmost importance for those who wish to protect their creation. Firstly, the inventor may apply for protection as a Utility Model Patent or Utility Patent.

However, they must consider the best form of protection. The inventor will be able to better identify the nature (Invention or Utility Model) of their creation based on prior knowledge of the related state of the art, since Utility Model Patents refer to the protection of technical-functional creations related to shape or arrangement introduced into an object of practical use, or part thereof, giving the object known from the state of the art a functional improvement in its use or manufacture.

The Utility Model is the creation of something resulting from the intellectual capacity of its author, referring to an object of practical use or part thereof. This object must be three-dimensional (such as instruments, utensils, and tools), present a new shape or arrangement, which is non-obvious, and result in a functional improvement in its use or manufacture. It must be susceptible to industrial application. Systems, processes, procedures, or methods for obtaining a product are not included in this type of protection.

The Invention, in turn, is the creation of something resulting from the intellectual capacity of its author and that represents a new solution to an existing problem, in a certain technological area, and is non-obvious. Inventions may relate to industrial products (compounds, compositions, objects, apparatus, devices, etc.) and industrial activities (processes, methods, etc.).

Utility Patents aim to protect creations of a technical nature, to solve problems in a specific technological area. On the other hand, Utility Model Patents are objects that, without aiming at a peculiar technical effect (in which case they would constitute a Utility itself) are intended to improve the use of the object, which may lead to greater efficiency or convenience in its use.

There may be creations of shape or arrangement classified as Utility Patent or Utility Model. What will determine the definition of the correct nature will be to assess whether we are facing an improvement of effect or functionality – case of protection as a Utility Model Patent, or facing a new technical-functional effect – case of protection as an Utility Patent.

3. Contents of the Utility Model Application

The Utility Model Patent application must contain:

a) Title

b) Specification

c) Set of Claims

d) Drawings

e) Abstract

Only the set of claims of the Utility Model Patent presents differences compared to the Utility Patent. Considerations on title, specification, drawings, and abstract are contained in the examination guidelines for Utility Patents. However, it should be noted that in a Utility Model Patent application, drawings are essential to ensure a perfect understanding of the claimed object.2.2.1 Deposit of biological material

[11] Should biological material be essential for the practical implementation of the object of the application, which cannot be described in compliance with article 24 and when not accessible to the public, the specification shall be supplemented by filing the material at an institution authorized by the BRPTO or indicated under an international agreement in force in the country, or in any of the international deposit authorities recognized by the Budapest Treaty1 (see item 2.18 of the Examination Guidelines for Patent Applications, Block I), as per the sole paragraph of said article. Thus, it is considered that "biological material", in this context of the deposit, can refer to any material containing genetic information and capable of exercising direct or indirect self- replication. Representative examples include bacteria, archaea, protozoa, viruses, fungus, algae, seeds, animal and plant cell lines, hybridomas, artificial chromosomes and other vectors; in some of these cases and depending on the requirements of the selected filing center, the host cell containing these biological materials may be filed.

3.1 - Formulation of the claims

A claim must be formulated as follows:

- initial part, which corresponds to the title;
- when necessary, a preamble containing the features already comprised by the state of the art;
- the expression "characterized in that" is mandatory, followed by a characterizing part containing the newly introduced shape or arrangement, containing all the elements that constitute it, as well as their positions and interconnections in relation to the whole set.

This separation between known elements and new elements is intended to facilitate this distinction, as it does not alter the the claim's range or scope, which will always be determined based on the overall features presented in the preamble and the characterizing portion.

Each claim must clearly, precisely, and positively define all technical features to be protected, avoiding expressions that lead to uncertainty in a claim.

The clarity condition of claims applies to individual claims and to the set of claims as a whole. The clarity of the claims is of the utmost importance, as they define the subject matter for which protection is sought. Thus, the meaning of terms contained in the claims must be clear to one skilled in the art based on the wording of the claim and 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 introduced features of shape or arrangement, essential to obtain the functional improvement.

3.3 - Dependent Claims

Dependent claims will only be accepted when:

- referring to a complementary element of optional use that does not change or modify the

conditions of use and operation of the object;

- referring to the variation in shape or detail related to component elements of the model, defined in the first claim, and which do not alter the unity of the model (technical-functional and body unity of the object) and its functioning;

- referring to the object in its three-dimensional shape in cases where the final configuration is secondary and results from the assembly of an initial planned structure characterized in the first claim.

4. Procedures for the examination of Utility Model Patent applications

4.1 - Classification

The classification rules for Utility Model Patents are the same as those applicable to Utility Patents, according to the Strasbourg Agreement. Utility Models will be classified according to their function and application, in case the specification indicates a specific application for the claimed object.

There are two clear concepts in Utility Models, which should not be confused. One concept concerns the function of the object, functionality, which how the law addresses functional improvement; the other concept is that of use, application. For example, there can be a box to store products. Its function (described in terms of verbs) is to "store". However, there may be several applications, or several technical fields, from storing oranges to paint containers. The two concepts should not be confused.

4.2 - Search

In the case of a Utility Model, the search for prior art must always take into account the classification of the claimed object. It is important to note that the search for prior arts of a Utility Model application must always be carried out between objects with the same function. However, the examiner must set up the search field according to the function and application of the object, as in both cases objects with the same functionality as the proposal of the application under examination may be found.

For example, a required object is a package intended to store liquid products. The search found identical packages intended for storing pasty and/or granulated products. This prior art will be taken into account in the analysis, since both objects have the same function (storing), regardless of the content.

4.3 - Analysis of patentability requirements:

4.3.1 - Industrial Application

Article 15 – Inventions and utility models are considered susceptible to industrial application when they can be made or used in any kind of industry.

Article 15 is quite clear when specifying that the Utility Model is considered susceptible of industrial application when the object is liable to or capable of being manufactured or used in any type/genre of industry, including the agricultural, extractive, and manufactured or natural products industries.

4.3.2 - New shape or arrangement (novelty)

Article 11 – Inventions and utility models are considered novel when they are not already part of the state of the art.

Paragraph 1 – The state of the art comprises everything made accessible to the public before the filing date of

the patent application, by written or oral description, by use or any other mean, in Brazil or abroad, without prejudice to the provision of Articles. 12, 16, and 17.

Paragraph 2 – For the purpose of determining novelty, the whole contents of the application filed in Brazil, but not yet published, will be considered state of the art from the filing date, or from the claimed priority, provided that it is published, even if subsequently.

Paragraph 3 – The provisions of the previous Paragraph will be published to international patent applications filed in accordance with a treaty or convention in force in Brazil, provided that there is national processing.

The new shape or arrangement, that is, the novelty, resides in the technical-structural features of the object 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 the information that has become accessible to the public prior to the filing of the Patent application.

The novelty of a Utility Model is conceptually the same as that of a Utility and must be verified by the principle of the single document. The principle of the single document refers to the fact that it is necessary for any impeding prior art to fully present all the elements of the technical solution for which the novelty is intended.

4.3.3 - Non-obviousness

Article 14 – An utility model shall be considered as non-obvious when, for a person skilled in the art, it does not derive in a common or usual manner from the state of the art.

The new shape or arrangement is the result of non-obviousness. For an object already existing in the state of the art, non-obviousness characterizes the unusual or non-ordinary difference between these two objects, the one proposed by the application and the one anticipated by the state of the art. In other words, the difference must not be commonplace, habitual, normal, trivial, or ordinary for a person skilled in the art.

The definition of “a person skilled in the art” is broad. A person skilled in the art may be someone with average knowledge on the art in question at the time the application was filed, at a technical-scientific level, and/or with practical operational knowledge of the subject. It is considered that they had the means and the capacity for routine work and experimentation, which are usual in the technical field in question.

In the assessment of obviousness, a single document of prior art should be preferably used. In some situations where construction details of the object are found in a complementary manner in another prior art document, this may undermine the obviousness of the application under examination, provided that such document includes construction details of the object.

Example: A Utility Model Patent application was filed for a PET bottle cap containing weakening points (A), internal threads and a ring connected to the top of the cap by the weakening points, as shown in Figure 1. During searches, a document was found containing a cap for liquids that has weakening lines (B), internal threads and a ring slightly larger than the ring on the PET bottle cap. In this case, the PET bottle cap is not identical to the cap found in the state of the art, however the weakening line (B) has the same function as the weakening points (A), that is, separating the upper part of the cap from the ring, and both have the function of showing the tampering (opening) of the container, which suggests that the cap of figure 1 is obvious.

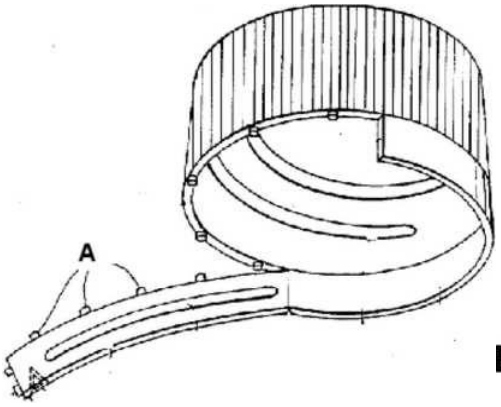

Figure 1 – PET bottle cap

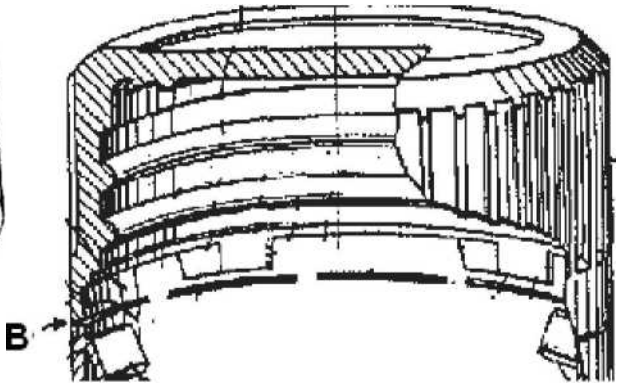

Figure 2 – Lid for liquid containers

4.3.4 - Functional Improvement

The term “functional improvement” appears in Article 9 the Brazilian Patent Statute:

Article 9 – An object of practical use, or part thereof, is patentable as a utility model when it is susceptible to industrial application, presents a new shape or arrangement, and is non-obvious, resulting in a functional improvement in its use or manufacture.

A new object, even if non-obvious, is not patentable if it lacks a functional improvement. Functional improvement is related to the use of the object, whether in a more practical, comfortable and/or efficient way in its use and/or manufacture. Therefore, the applicant must declare the functional improvement.

The Brazilian Patent Statute, in Article 9, requires that the Utility Model Patent be non-obvious, resulting in a functional improvement in the use or manufacture of the object. Therefore, in addition to the aforementioned functional improvement, the presence of a minimum contribution of inventiveness, i.e. non-obviousness, is required. If we were to equate non-obviousness and functional improvement as having the same meaning, this would imply granting a Patent for a result, as a functional improvement in an object may be considered common or vulgar for a person skilled in the art.

In other words, the concepts of functional improvement and non-obviousness must be considered as related, but distinct concepts, so that a trivial or vulgar variation, which brings functional improvement, is not protected by the Utility Model due to obviousness, as well as the result thereof.

4.3.5 - Distinct, Additional Elements and Constructive or Configurative Variant

The terms “constructive variant” and “distinct, additional elements” appear in the Brazilian Patent Statute #9,279 in the following Article:

Article 23-0 – The Utility Model Patent application must refer to a single main Model, which may include a plurality of distinct, additional elements or constructive or configurative variants, as long as the technical-functional and bodily unity of the object is maintained.

A constructive variant of an object Patentable as a Utility Model is a modification in the part of the object that performs the main function of the object, that is, a variation of the main element in question, but without changing the technical-functional unit.

For example, Figure 3 shows a screwdriver with a rectangular tip and Figure 4 shows a screwdriver with a rounded tip. The bulge at the tip of the tool is a constructive variant of this object. The main element of the screwdriver, the tip, is changed in terms of its shape, but the technical-functional unit is maintained, that is, operating a screw.

Figure 3 – Screwdriver

Figure 4 – Larger screwdriver with rounded tips

The additional complementary element is another object, secondary to the main object. For the aforementioned screwdriver, a cover for the tip of the tool, in order to protect it, or a clip on the handle, to hold the screwdriver in a pocket, are examples of complementary, additional elements.

Both the constructive variant and the complementary element, as long as they do not modify the conditions of use and functioning of the object, are features that must be claimed in dependent claims in the same application.

An example of modification of the technical-functional unit of the above screwdriver is, for example, a change in the handle in order for the screwdriver not to slip out of the hands. The first Model did not foresee this new technical feature, and therefore must be the subject of another application.

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