

Utility Models in Italy

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Utility models fall within the definition of “Industrial Property” provided for by Art. 2 of the Industrial Property Code (IPC) enacted by legislative decree 30/2005. Accordingly, their protection follows the general rules established by the Code for all industrial property rights (Art. 1–6; Art. 117 ff.), the provisions specifically dedicated to utility models (Art. 82–86), as well as the rules governing patents to the extent they are compatible with the specificities of utility models. Of limited relevance appear Articles 2592 and 2594 of the Civil Code, which offer a summary of the basic rules governing this intellectual property right.

7.1 SOURCES OF LAW AND HISTORICAL DEVELOPMENT

The first law protecting designs and models dates back to 1868.¹ It granted a two-year exclusive reproduction right to the “inventors” of “new industrial designs and models” upon deposit and subject to revocation in case of failure to work the design or model within the first year from grant. Absent a definition of “designs and models”, it remains disputed whether the law referred to ornamental creations only, or to functional ones too.

Over the first three decades of the twentieth century, considerable efforts were made to reform the laws protecting intellectual property.² The outcome was Royal Decree 1602/1934, which separately addressed utility models, on one hand, and ornamental designs and models, on the other, in its Titles III and IV, respectively.

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¹ Law 4578/1868.

² See Jannoni Sebastianini 1936, 1 ff. For information on the preparatory works specifically regarding utility models see Vanzetti 2008, 189 ff.

Although it never entered into force,³ the Royal Decree of 1934 substantially influenced the next generation of laws aimed at establishing a comprehensive and coherent system of protection for industrial property. Industrial designs and models became the subject matter of a separate law, namely Royal Decree 1411/1940, which replicated with minor amendments the rules on utility models and ornamental designs and models of the law of 1934.

Royal Decree 1411/1940 remained in force until the enactment of the IPC, which regulates utility models today. During its life, the Royal Decree underwent three major reforms. First, the law 265/1977 extended the term of protection from four to ten years in the case of utility models, and fifteen years for ornamental designs and models. Second, the law 60/1987 reshaped the relationship between utility models and patents with the introduction of the possibility of transformation of applications for patents into applications for utility models, and vice versa, and conversion of invalid patents into utility models, and vice versa. Third, the Legislative Decree 95/2001, by implementing Directive 98/71/EC on the legal protection of designs, reformed entirely the rules applicable to ornamental designs and models. The nineteenth-century legislative scheme, in which new utilitarian and ornamental features of industrial products faded into a blurred and indistinct legal concept, got finally, and completely, overhauled.

7.2 SUBJECT MATTER

According to Article 82 IPC, utility model protection can be issued for new designs that confer particular efficacy or convenience of application or use to machines, or parts thereof, instruments, tools, or any other object, such as new designs which consist of particular shapes, arrangements, configurations, or combinations of parts. It follows from this definition that utility models cannot protect methods⁴ and are of little to no relevance for products whose formal configuration does not impact functionality.⁵ Indeed their relevance is fundamentally restricted to the field of mechanics and excludes chemical, biological, and similar innovations.

7.3 REQUIREMENTS FOR PROTECTION

Utility models must be “new”, as required by Art. 82 IPC. Despite the silence of the law, it is generally accepted that novelty should be understood in absolute terms.⁶

³ In fact, entry into force required the approval of a regulation which was never adopted.

⁴ See, e.g., *Franzosi* 2008, 159; *Di Cataldo* 2012, 288. Product-by-process claims are nonetheless admitted: cf. *Bosch v Candy* (Cass. 8510/2008).

⁵ Cf. *Vanzetti* 2008, 197, who considers not protectable by utility models chemical, biotechnological, electronic inventions, as well as second use inventions.

⁶ See *Fazzini* 2019, 583 f.

This follows from the reference made by Art. 86 IPC⁷ to provisions dealing with patents, which are also applicable to utility models, so long as the provisions are compatible. The compatibility of these provisions seems to be fulfilled in the case of novelty, considering that Art. 82 IPC mentions it without providing a definition.

According to a view adopted early on in the jurisprudence and never abandoned, utility models also need to show some sort of originality. Again, this follows from the reference made by Art. 86 IPC to provisions regarding patents, among which is the requirement of inventiveness regulated by Art. 48 IPC. However, this requirement must be adapted to the specific subject matter of utility models, which – following the definition provided by Art. 82 IPC – consists in a configuration of a known product conferring particular efficacy or convenience of application to it. In the courts' view, the matter here is not to evaluate the nonobviousness of an invention because, by definition, a utility model is not an invention, that is, the solution of a technical problem, which entails the creation of new scientific knowledge through discovery of a cause–effect relationship that translates into a new product. What utility models protect is an innovative concept which relates to the configuration of a known product and enhances its efficacy or convenience of application. Therefore, the question to be answered is whether such new configuration originates from the application of elementary technical rules or from a banal combination of preexisting inventions or models. Some degree of inventiveness and the overcoming of technical difficulties are required.⁸

7.4 RELATIONSHIP TO PATENTS

As already mentioned, utility models cannot protect methods. In this respect, any potential overlap between utility models and patents is avoided.⁹ In the remaining cases, it has always proven difficult to master the relationship between these two kinds of intellectual property rights. Hurdles have emerged over the years, though.

7.4.1 *Patents and Utility Models under the Law of 1934*

In 1934, utility models were meant to provide cheap, easy-to-obtain, quickly granted, and short-lasting protection to “little inventions”, within a context in which it was envisaged that patent applications were gradually to become subject to substantive examination and opposition procedures. The idea was to follow the example of Germany,¹⁰ whose extraordinary industrial development had been helped, in the view of contemporary literature, by a well-functioning patent system, which offered

⁷ See above, Section 7.1.

⁸ See *Gipron v Masters* (Cass. 19688/2009).

⁹ Di Cataldo 2012, 288.

¹⁰ See Chapter 6 (Germany and Switzerland).

utility models as a convenient alternative to full patent protection. Utility models were seen as an innovation of the German Patent Office, which effectively limited its backlog in the examination of patent applications by channeling lesser innovations to the simpler registration system provided for utility models.

Following an approach that continues today, utility models were regulated by reference to the law on patents, absent specific rules and subject to a compatibility requirement.¹¹ However, the fact that patents and utility models shared the same rules did not mean that overlap was necessarily allowed. On the contrary, the introduction of utility models as a separate intellectual property right, distinct from both patents and ornamental designs and models, was seen as an improvement made possible by a greater understanding of the specific characteristics that make such innovations different in kind.¹²

Early on, the idea took ground that utility models and ornamental designs protected new formal configurations of existing goods impacting their functionality or aesthetics, while patents covered inventive ideas giving birth to new products¹³ – an approach that forecloses overlap between utility models and patents.

This view seemed to be confirmed by a rule that allowed the simultaneous filing of a patent application and a utility model application, which would be considered only if the Patent Office refused to grant, entirely or partially, the patent.¹⁴ Indeed, such a rule – allowing so-called “alternative applications” or *Hilfsanmeldungen* as labeled under the German system – seemed to imply that the same innovation could not be double patented, that is, protected by both a patent and a utility model. Such a rule would have made little sense if patents and utility models could have had the same subject matter: considering that utility models conferred shorter and narrower protection compared to patents, what difference would it make if someone decided to pay more fees to get this protection in addition to a patent? The only convincing reason that could justify the impossibility (at least in theory: see *infra*) of prosecuting two applications for the same innovation was therefore the existence of a “qualitative difference” regarding the subject-matter of patents and utility models, one that could justify the conclusion that a certain innovation can only fall in one category or the other.

Moreover, a transitional provision stated that patent applications filed (but not yet accepted) before the entering into force of the new law would yield the grant of a utility model, instead of a patent, if their “subject-matter had the characteristics of a utility model”.¹⁵ This appears to be another sign that there is a qualitative difference

¹¹ Cf. Art. 65 R.D.1602/1934.

¹² Cf. Jannoni Sebastianini 1936, 60.

¹³ This approach is represented even in the literature preceding the 1934 reform: see, e.g., Ghiron 1929, 90 and 118–119.

¹⁴ Cf. Art. 60 R.D. 1602/1934.

¹⁵ Art. 138 R.D. 1602/1934.

between inventions and models, leading to the necessity of putting each kind of innovation in the proper “box”.

From a broader perspective, one additional element can help explain the immediate success of this approach. It should not be forgotten that patent law, at that time, did not mention “inventiveness” among the requirements for protection and that this omission continued until quite recently, when it was reformed in connection with the making of the European Patent system. In 1934, the law made it clear not only that examination and opposition proceedings were limited to novelty, but also that the Patent Office acted under an explicit prohibition against evaluating the technical or economic value of the invention.¹⁶ Against this backdrop, drawing the distinction between inventions and utility models with regard to their higher or lower degree of originality seemed to be out of question, notwithstanding a common understanding that utility models were meant to cover minor innovations.

7.4.2 *Patents and Utility Models under the Law of 1940*

Implementing substantive examination and opposition procedures proved so difficult that, in a matter of years, the legislature decided to abandon the reform of 1934. The new law on patents of 1939 confirmed the authority of the Italian IP Office to examine patent applications with regards to their substance¹⁷ but, at the same time, abolished the prior art search, which was needed to make substantive examination more than just a fiction. Additionally, it entirely displaced the Italian IP Office opposition proceeding and left third party challenges entirely in the hands of the judiciary.

When, in 1940, the legislature also reformed the law on utility models, it did not engage with the problem of governing their intersection with patents, which was left to the rule on alternative applications and to a transitional provision identical to the one already discussed with reference to the law of 1934.¹⁸

Not surprisingly, the theory affirming the existence of a qualitative difference between inventions and models continued to prevail.¹⁹ The idea that models could be conceived as “smaller inventions” was considered, even by the case law, to be

¹⁶ Cf. Art. 27 R.D. 1602/1934. Cf. Jannoni Sebastianini 1936, 27 ff. and 35 ff., who repeatedly stresses the prohibition to extend the pre-grant examination or opposition to the technical or economic value of the invention.

¹⁷ Ubertazzi 1988, 558; contra Spolidoro 1981, 1088 ff.

¹⁸ Art. 14 law 1411/1940, which repeats verbatim Art. 138 R.D. 1602/1934.

¹⁹ Many consider the shift from the idea that utility models protect “petty inventions”, i.e., innovations showing a lesser degree of originality than patentable inventions, to the conception of utility models as protecting a different kind of innovation in comparison to patents as a consequence of the abolition of the substantive examination of patents. See, e.g., Floridia 2000, 353.

equivocal or spurious²⁰ and was seldom followed by courts.²¹ This stands to reason. On one hand, the *de facto* abolition of substantive examination for patent applications made the explanation of utility models as a cheaper alternative to patents untenable.²² On the other hand, the rule on alternative applications and the transitional provision allowing transformation of patent applications into utility model applications continued to offer a relatively solid argument in favor of a subject matter–based distinction.

This, in turn, prompted additional efforts to draw a sufficiently clear distinction between the subject matter of patents and, respectively, of utility models. Early on, such distinction was found, essentially, in contrasting the invention of something new, on one hand, and the refinement of something already known, on the other hand. Then, in order to combine this view with the long-established patentability of inventions consisting of improvements to existing products, additional efforts were made to distinguish improvements that do not alter the nature of the goods, which were to be protected under the utility models regime, and improvements that are so substantial as to make the product a “new product”, which would be entitled to a patent.²³

In spite of these efforts, reliable criteria were badly needed, as inventors remained exposed to the risk of losing any protection theoretically available if they failed to select the appropriate right for their innovations at the time of the filing. Once granted, a patent could be invalidated if it claimed something that qualified as a utility model, and vice versa. It was a serious risk. Indeed, alleged infringers often relied on this argument to defend themselves, sometimes successfully. Not even filing alternative applications offered a safe harbor: the fact that the choice of the wrong “box” was due to a mistake by the examiner in selecting which application to prosecute had no relevance; judicial invalidation would follow all the same.²⁴

To minimize risks,²⁵ patentees sometimes adopted the expedient of filing simultaneous independent applications (i.e., without qualifying them as “alternative”). However, this practice was opposed by the Patent Office, which considered it *contra legem*, and eventually disqualified by the Supreme Court in the early 1980s.²⁶

7.4.3 The 1987 Reform

A major reform of the patent system occurred at the end of the 1970s, prompted by the obligations arising under the Strasbourg Convention, the European Patent

²⁰ This wording may be found in *Successori v Sergio Verdini* (App. Bologna 1972). In a similar vein see *A.C.F.A. v Ruggiero Olivieri* (App. Milano February 1972)

²¹ For a rare example see *Rivest Polival v ditta Piero Brambilla* (App. Milano 1971).

²² Cf. Vanzetti 2008, 191.

²³ See Greco and Vercellone 1968, 389 ff. A similar reasoning may arguably be applied to dependent (or derivative) inventions.

²⁴ Cf. Floridia 2000, 354.

²⁵ Including risks of professional liability for patent attorneys.

²⁶ See *Bello v Ministero Industria* (Cass. 7398/1983).

Convention (EPC), and the Patent Cooperation Treaty. At that time, Italy decided not to abolish utility models, even though they did not have an equivalent within the system established by the EPC. Under the EPC, only the rules on conversion of European patents/patent applications into national patents/patent applications, as well as the rules on priority and simultaneous protection, extended to utility models if provided for by national law.²⁷ The decision to maintain utility models in Italy was followed by a reform of their legal regime, which occurred in 1987 (by Law 60).

Generally, the reform bridged some of the gaps created by the lack of coordination between patent and utility models protection described above.

In 1979, the legislature had already taken advantage of Art. 140 EPC to introduce the possibility of transforming an application for a European patent refused by the EPO into an application for an Italian utility model.²⁸ With the 1987 reform, a specific provision was introduced to deal with national applications in a similar, although not identical way. As already mentioned, applicants were allowed under the 1940 law to simultaneously file a patent and a utility model application for the same innovation, which would be considered as alternatives by the Italian IP Office. However, if applicants missed this opportunity, they were not allowed to transform their original application to overcome a refusal of grant by the receiving office based on failure by the applicant to select the right “box” for their innovation. The 1987 reform changed this by entrusting the Italian IP Office with the task of inviting the applicant to modify its request, without impact on the filing date, if it wrongly claimed patent protection for a utility model or utility model protection for an invention.²⁹

Additionally, the 1987 reform introduced the possibility of converting a revoked European patent³⁰ or an invalid Italian patent³¹ into a utility model. Again, the rule had to be differentiated. With regards to European patents, conversion could only go in one direction: from a revoked European patent to an Italian utility model. Not so with regards to Italian grants. In their case, conversion of an invalid utility model into a patent was also provided for, although licensees or third parties who made investments to use the utility model after the lapse of its term of protection had the right to obtain a nonexclusive, free-of-charge, compulsory license for the extra years of exclusivity deriving from the longer term of protection applicable to patents.³²

All in all, these rules appear more consistent with the idea that patents and utility models are distinguishable on the basis of their specific subject matter rather than the degree of originality that they require. Indeed, it may be argued that there is no

²⁷ Art. 140 EPC.

²⁸ Art. 6.2 DPR 32/1979.

²⁹ Art. 9.1 law 60/1987.

³⁰ Art. 6.2 DPR 32/1979 was amended to include the case of European patents targeted by a successful post-grant opposition.

³¹ Art. 59 R.D. 1127/1939, as amended by Art. 7 law 60/1987.

³² Art. 7 law 60/1987.

other reasonable explanation for allowing conversion of an invalid utility model into a patent, if not for the case, which appears rather theoretical, of a utility model wrongly granted for a method. The Italian Supreme Court has consistently upheld this approach.³³

7.4.4 Latest Developments

Since their introduction, utility models have never attracted great attention from users of the patent system. As already mentioned, their allure as a cheap and easy-to-obtain protection tool in comparison to patents disappeared once it became clear, back in the 1930s, how difficult it was to establish substantive examination for full-fledged inventions as originally envisaged. Since then, utility models have been more a problem than a solution for applicants, considering the risks stemming from the unclear distinction between inventions and utility models. Once these risks were addressed by the transformation of applications and conversion of granted rights, utility models regained some of their attractiveness as a safety net for patentees who faced invalidity challenges from alleged infringers. This, in turn, prompted a revival of discussions regarding the distinction between utility models and patents.

Meanwhile, the abolition of utility models has regularly been discussed in Italy. At the end of the 1970s, when the last major reform of patent law occurred, utility models survived due to a lack of legislative authority of the government, which had been authorized by the Parliament to legislate only to the extent necessary to fulfill international obligations related to patents. Twenty-five years later, when the Industrial Property Code was enacted, history repeated itself. This time, doubts regarding the scope of legislative authority delegated to the government were coupled with uncertainties regarding potential developments at the EU level. Indeed, it appeared reasonable not to discontinue utility models while European institutions were discussing a harmonization directive that emphasized the relevance of this IP right for small and medium sized enterprises.

The project of EU harmonization faded away one year after the adoption of the IPC.³⁴ Nonetheless, interest in utility models was revitalized by a decree of the Ministry of economic development of October 3, 2007, giving effect to Art. 170.1 IPC, which outsourced to EPO's examining divisions the provision of search reports to be used by the Italian patent office to examine national patent applications. This measure was meant to support extension through the EPC of national applications more than to enhance the capacity of the Italian patent office to filter out inventions lacking novelty or inventiveness. Nonetheless, it had some impact on the number of

³³ See *Inoxa v Compagnucci* (Cass. 7110/2020); *Tecnosystem v Vecam-Co.* (Cass. 16949/2016); *Bosch v Candy* (Cass. 8510/2008). Also the lower courts follow the approach: see *Combustion and Energy v Sirena* (Trib. Torino 2022).

³⁴ See Chapter 20 (European attempts at harmonization of utility models).

applications for utility models, which were left untouched by this development and, therefore, continued to be examined only on the basis of information disclosed in the application itself or generally known. However, it soon became clear that negative search reports issued by EPO's examiners did not lead to refusals to grant when applicants provided reasonable counterarguments against such findings. This might be one of the reasons that the number of applications for utility models, which had been modestly rising in the second half of the 2000s, again turned downward a few years later.³⁵

In view of the entry into force of the Agreement establishing the Unified Patent Court, legislative decree no. 18/2019 included applications for European patents with unitary effects which have been refused or withdrawn, as well as European patents with unitary effect that have been revoked, in the list of patent applications that can be transformed into applications for utility models.³⁶ Interestingly, the same decree left untouched Art. 76.3 IPC, which deals with conversion of invalid patents into utility models. Therefore, this provision continues to provide for the conversion of invalid patents into utility models generally, without making it explicit whether conversion can also apply to invalid Italian portions of European patents and to the effects in Italy of invalid European patents with unitary effect. The ability to convert invalid Italian portions of European patents into Italian utility models seems straightforward. However, one could ask if and how this could happen if the validity of the European patent is challenged before the Unified Patent Court. This question appears even more relevant during the transitional period established by Art. 83 UPCA, considering the concurrent competence of national courts and, therefore, the risk that different regimes will apply depending on where invalidity claims are raised – that is, before an Italian court or the UPC. Similarly, one could question the rationale of denying conversion if exclusivity with effect in Italy had been obtained through a European patent with, or without, unitary effect.

From a practical point of view, these questions lose some of their relevance if the patentee takes advantage of the abolition in 2023 (law 102) of a rule that was meant to avoid the cumulation of Italian and European patents for the same invention.³⁷ The

³⁵ In 2023, 1,850 applications for utility models were filed; they were 2,464 in 2010 and 3,132 in 2000. Applications for patents have been stable: 9,453 in 2023, 9,663 in 2010, and 9,426 in 2000. Deposits of translations of granted EU patents have been increasing over the years: 23,568 in 2023 (but with a peak of over 40,000 in 2021), 26,089 in 2010, 17,966 in 2000. Statistics are available at <https://statistiche.uibm.gov.it/>; granted utility models can be accessed at www.uibm.gov.it/bancadati/Advanced_search/type_url?type=ut&cl=1.

³⁶ Art. 58.2 IPC. Revocation, in this context, refers to EPO decisions upholding post-grant oppositions.

³⁷ Before its reform, Art. 59 IPC provided for a supremacy rule in favour of European patents in the event of cumulative protection. In particular, it established that

1. If an Italian patent and a European patent or a European patent with unitary effect valid in Italy have been granted for the same invention to the same inventor or successor in title with the same date of filing and priority date, the Italian patent, to the extent it

new text of Art. 59 IPC establishes that an Italian patent coexists with a European patent with unitary effect, or a European patent having effect in Italy, which has been granted for the same invention to the same patentee with the same date of filing or priority. Moreover, Art. 59.2 IPC declares that invalidation or revocation of the European patent does not affect the Italian patent.³⁸ These provisions make double patenting attractive. First, coexistence means that the patentee can pursue an infringement claim in Italy relying on the national patent to avoid the competence of the UPC. Second, the patentee can bring an infringement claim before an Italian court and, within the same proceeding, convert the patent into a utility model, notwithstanding the fact that the corresponding European patent with unitary effect or Italian portion of a European patent may have already been revoked or invalidated. Likely, many Italian inventors will take advantage of this opportunity, which comes at no cost when – as is often the case – their patenting strategy begins with the filing of a national application.

Going back to the questions whether European patents, with or without unitary effect, can be converted into Italian utility models and if the Unified Patent Court can do it, it might be observed that the EPC allows conversion of rejected European patent applications and European patents which have been successfully opposed into national utility models, if the applicable national law so provides.³⁹ Considering that the attribution of unitary effect presupposes that a European patent has already been granted, it follows that a refusal by the examination division leads to the same consequences irrespective of whether the applicant requested a traditional European patent or a European patent with unitary effect. In the case of revocation due to a successful opposition, on the contrary, the unitary effect has already been granted.⁴⁰ However, the lack of specific rules suggests that the regime is the same for all European patents: the patentee can file a request for conversion with the EPO, which, in turn, will forward it to the Italian IP office.⁴¹ More complicated is the case of conversion of granted patents in other scenarios, that is, through an administrative

protects the same invention as the European patent, or the European patent with unitary effect, shall cease to have effect as of the date on which: a) the deadline for opposing the European patent or the European patent with unitary effect has lapsed without any opposition being filed; b) the opposition proceeding has definitively ended with the maintenance in effect of the European patent or of the European patent with unitary effect; c) the Italian patent has been issued, if that date is later than the date in letters a) or b). 2. The provisions of paragraph 1 remain valid even if the European patent or the European patent with unitary effect is subsequently cancelled or revoked. 3. As of the expiration of the deadlines indicated in paragraph 1, a person who has brought an action to protect an Italian patent may request a conversion of the same into a corresponding action to protect a European patent, or the European patent with unitary effect, without prejudice to the rights that result from the Italian patent for the earlier period.

³⁸ *Gemata v Bergi* (Cass. 2019/22984) reached the same conclusion based on the previous text of Art. 59 IPC. See Calabrese 2020, 576 ff., on implications of the entering into force of the UPC.

³⁹ Art. 140 EPC.

⁴⁰ Art. 4 EU Reg. 1257/2012.

⁴¹ Art. 135–137 EPC and rule 155 of the Implementing Regulations.

or judiciary decision prompted by the patentee. Neither the EPC nor the UPCA deal with conversion of granted (and unrevoked) patents, leaving the matter to national laws. In the case of Italy, the IPC does provide for conversion of invalid patents generally, that is, without making distinctions between national or European patents, but in a specific setting: within judiciary proceedings in which validity of the patent has been challenged by the alleged infringer and through a decision having a negative content, where it affirms the invalidity of the patent, and a positive one, where it ascertains the fulfilment of the requirements for protection as a utility model.⁴² Consequently, there seem to be no doubts that Italian portions of European patents can be converted by Italian courts, as already mentioned. However, it seems unlikely that the UPC could do the same, as it lacks competence to make a positive assessment concerning protection of the non-patentable invention as utility model and, in that case, to issue remedies against the infringer.⁴³ This leaves open to question whether the patentee could obtain conversion otherwise. A positive answer follows from the theory maintaining that – despite the wording of Art. 76 IPC – conversion happens *ipso jure*, in consequence of invalidation of a patent that refers to an innovation protectable as utility model.⁴⁴

Lastly, it should be noted that law 102/2023 provides that, if an applicant files simultaneously with the Italian IP Office a patent application and a utility model application, to be considered alternatively, the (totally or partially negative) search report issued by the EPO concerning the main application must also be taken into account by the Italian IP Office when examining the auxiliary one. The legislative report indicates that this rule was not prompted by a desire to approximate further the regime of patents and utility models, but by the fact that the Office cannot avoid considering documents on the record. Be that as it may, the same reasoning seems to apply when the applicant files only for a patent and, after having received a negative search report from the EPO, decides to convert the application into a utility model. If this assumption is correct, then utility models can work as an easier-to-obtain IP right⁴⁵ in comparison to patents only if the applicant abstains from trying to obtain full patent protection to begin with.⁴⁶

⁴² See Floridaia 2000, 355.

⁴³ See Art. 35 UPCA.

⁴⁴ Cf. Ubertaini 1988, 575.

⁴⁵ But not quicker than patents: in both cases, grant follows within 180 days from publication of the application, which takes place after 18 months from filing (Art. 53 IPC). Utility models are also nowadays not substantially cheaper than patents. In case of e-filing, the filing fee is identical. Maintenance fees are due for patents from the fifth year on, on a yearly basis, while for utility models are due after five years and consist of a lump sum for the subsequent five years of protection. However, the total amount to be paid is not substantially different.

⁴⁶ As opposition procedures are not available for (patents and) utility models, validity can be challenged by third parties only in court.

7.5 CONCLUSION

Despite repeated legislative interventions aimed at coordinating the Italian national patent system with the UPCA, a conundrum still exists.

So far, Italian courts have refused to base the distinction between patents and utility models on the degree of originality of innovations that can be protected under each regime. Their preferred “qualitative” approach implies that a patent can be invalidated if it claims protection for a utility model, and vice versa. However, neither the EPC nor the UPCA or other rules governing European patents with or without unitary effect provide for a similar ground of invalidation. Therefore, the UPC will not be in a position to invalidate a European patent on this basis, either with effect limited to the Italian portion of a traditional European patent or for all countries participating in the “unitary patent package”. During the transition period, this might in turn lead to unintended consequences, such as differentiating the regime applicable to the same traditional European patent depending on the court that judges its validity, or to differentiate the regime applicable to European patents which have, or do not have, unitary effect. Also, as observed above, the execution of UPC decisions affirming the validity of European patents that protect – according to the “qualitative approach” – a utility model might raise difficult legal issues.⁴⁷

Solutions to these issues are not easy to identify. At the end of the day, insistence of the Italian courts on the qualitative approach seems more to express a concern about granting protection to utility models devoid of any substantial merit than an attempt to restrict access to full patent protection for inventions impacting the configuration of a known object. However, translating this concern into practical rules that do not deprive utility models of any relevance, while being both compatible with the regime of European patents and consistent with domestic legislative texts, as they emerged over a century of not well-coordinated interventions, appears at the moment to be a problem without an entirely convincing solution.⁴⁸

⁴⁷ See comment to *Tecosystemi s.p.a. v Vecam-Co* (Cass. 16949/2016).

⁴⁸ Recent attempts include, at the extremes, protection for obvious utility models (Franzosi 2008, 165 ff.) and application to patents and utility models of the same requirements (Romandini 2011, 220 ff.); in between, a revival of the “quantitative” approach (Vanzetti 2008, 200 ff.).