

TRADE MARK PROTECTION LAW

Chapter I General Provisions

Section 1

A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Section 2

(1) Obtaining a trade mark right shall be subject to the entering of the trade mark in the trade mark register.

(2) This Federal Act shall apply mutatis mutandis to trade mark rights obtained for the territory of Austria on the basis of intergovernmental agreements. Such trade marks shall also be examined for compliance with the law (Section 20).

(3) Trade mark rights obtained on the basis of the Regulation (EC) No 40/94 on the Community trade mark, OJ. No L 11, January 14, 1994, page 1, as amended by the Regulation (EC) No 3288/94 for the implementation of the agreements concluded in the framework of the Uruguay-Round, OJ No L 349, December 31, 1994, page 83, shall be considered equal to trade mark rights obtained in accordance with this Federal Act, except as otherwise provided for in the Community Law specifications in respect of trade mark matters. In addition the provisions of Chapter VIII shall be applied.

Section 3 (repealed; Federal Law Gazette I No 111/1999)

Section 4

(1) Excluded from registration shall be signs which

1. exclusively consist
 - a) of state coats of arms, national flags or other national emblems or of the coats of arms of Austrian provincial or local authorities,
 - b) of official test or guarantee signs which are used in Austria or - pursuant to an announcement published in the Federal Law Gazette (Section 6 par 2) - in a foreign state, for the same goods or services the trade mark is intended for, or for similar goods or services,
 - c) of signs of international organizations to which a member state of the Paris Union for the Protection of Industrial Property belongs, provided the signs have been promulgated in the Federal Law Gazette. The last sentence of Section 6 par 2 shall apply to such promulgation;
2. cannot constitute a trade mark in accordance with Section 1;
3. are devoid of any distinctive character;
4. consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical

origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

5. consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade for the designation of the goods or service;
6. consist exclusively of the shape which results from the nature of the goods themselves, or of the shape of the goods which is necessary to obtain a technical result, or of the shape which gives substantial value to the goods;
7. are contrary to public policy or to accepted principles of morality;
8. are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;
9. contain or consist of a geographical indication identifying wines and intended for wines which do not have that origin, or identifying spirits and intended for spirits which do not have that origin.

(2) Registration shall, however, be admissible in the cases of par 1 subpars 3, 4 and 5 if the sign in Austria has acquired a distinctive character in the trade concerned in consequence of the use which has been made of it prior to the application.

Section 5

Trade marks containing a distinction or one of the signs as referred to in Section 4 par 1 subpar 1 as components shall, in so far as the use is subject to legal restrictions, be registered only after evidence has been furnished of the right to use that distinction or sign.

Section 6

(1) The state coat of arms, the national flag or any other national emblem or the coat of arms of an Austrian provincial or local authority shall not be used in trade without authorisation for the designation of goods and services or as a component of such a designation, nor shall the signs referred to in Section 4 par 1 subpar 1 lit. c be used without the consent of the entitled party. Accordingly, test or guarantee signs shall not be used without the approval of the authority issuing such test or guarantee signs for the designation, or as a component of the designation, of goods or services for which the sign has been introduced, or for similar goods or services.

(2) To foreign national emblems and official test and guarantee signs par 1 shall apply only if an intergovernmental agreement or reciprocity exists and if that foreign sign has been promulgated in the Federal Law Gazette. Where the notice does not include a reproduction of the official presentation of the sign it shall have to be stated where such reproduction is publicly accessible.

(3) Persons infringing the prohibition (par 1) shall be punished by the district administrative authority by a fine of up to € 218 or arrest of up to one month. In case of aggravating circumstances both penalties may be imposed concurrently.

Section 7

Section 4 par 1 subpar 1 and Sections 5 and 6 shall also apply to representations which are similar to the official presentation of the distinction or sign. Approved distinctions and signs of the kind referred to in Section 4 par 1 subpar 1 may, however, even where they are similar to other such distinctions or signs, constitute

components of trade marks (Section 5) and may be used for the designation of goods or services (Section 6).

Section 8 (repealed; Federal Law Gazette 1977/350)

Section 9

The Federal Minister of Economic Affairs may where required to facilitate identification of the origin of goods of a specific type in view of their characteristics, in particular, their dangerous nature, or for economic reasons, order that such goods may only be put on the market after a registered mark has been affixed to them in a manner to be determined by ordinance.

Section 10

(1) Subject to the preservation of prior rights the registered trade mark shall confer on the proprietor the exclusive right to prevent all third parties not having his consent from using in the course of trade

1. any sign identical with the trade mark in relation to goods or services (Section 10a) which are identical with those for which the trade mark is registered;
2. any sign identical with, or similar to, the trade mark used for identical or similar goods or services (Section 10a) if there exists a likelihood of confusion on the part of the public which includes the likelihood of association between the sign and the trade mark.

(2) The proprietor of a registered trade mark shall also be entitled to prevent all third parties not having his consent from using in the course of trade any sign identical with, or similar to, the trade mark in relation to goods or services (Section 10a) which are not similar to those for which the trade mark is registered, where the latter has a reputation in Austria and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark. The reputation of the trade mark filed earlier shall be required to have existed at the latest on the day of the application for registration of the subsequent trade mark, or the date of priority or seniority claimed for the registration of the subsequent trade mark or at the time of creation of the other sign.

(3) The registered trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade,

1. his own name or address,
 2. indications concerning the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of goods or of rendering of the service, or other characteristics of goods or services,
 3. the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,
- provided he uses them in accordance with honest practices in industrial or commercial matters.

Section 10a

As use of a sign for the identification of goods or services shall, in particular, be considered:

1. affixing the sign to the goods, to the packaging thereof, or to objects in respect of which the service is rendered or is to be rendered,
2. offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services there under;
3. importing or exporting the goods under the sign;
4. using the sign on business papers, in announcements or in advertising.

Section 10b

(1) The trade mark shall not entitle the proprietor to prohibit a third party from using the trade mark in relation to goods which have been put on the market in the EEA under that trade mark by the proprietor or with his consent.

(2) Par 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisations of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

Section 11

(1) Separately from any change of ownership of the enterprise the trade mark may be transferred in respect of all or some of the goods or services for which it is registered. Where the trade mark right is the property of an enterprise, the trade mark right together with the licence rights if any shall be conferred to the new proprietor in case of a change of ownership of the whole of the enterprise except there is agreement to the contrary.

(2) Where it is obvious from the request for transfer or the respective documents submitted that because of the transfer the trade mark is likely to mislead the public, in particular as regards the nature, the quality or the geographical origin of the goods or services, the request for registration of the transfer shall be refused, unless the successor in title agrees to a limitation of the list of goods and services in order to eliminate the likelihood of a deception.

(3) As long as the transfer of the trade mark has not been recorded the rights arising from the registration may not be asserted before the Patent Office and all communication concerning the trade mark served on the registered proprietor of the trade mark shall have effect with regard to the successor in title of the trade mark.

Section 12

No one shall be permitted, without the consent of the person authorized, to use the name, the firm name or the special designation of the undertaking of another person for designating goods or services .

Section 13

(1) If the reproduction of a registered trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the trade mark, have to ensure that the reproduction of the trade mark at the latest in a new edition of the publication is accompanied by an indication that it is a registered trade mark.

(2) Par 1 shall also apply to reference works stored electronically and available to the public via electronic networks. In that case any essential alteration of the contents of the reference work shall be considered a new edition.

Section 14

(1) A trade mark may be the subject of exclusive or non-exclusive licences for all, or some of the goods and services for which it is registered, and for the whole federal territory or part thereof.

(2) The proprietor of a trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract with regard to

1. the duration of the licence,
2. the form covered by the registration in which the trade mark may be used,
3. the kind of goods or services for which the licence is granted,
4. the territory in which the trade mark may be used, or
5. the quality of the goods manufactured or of the services provided by the licensee.

Section 15 (Repealed; Federal Law Gazette 1977/350)

Chapter II

Registration, transfer and cancellation of trade marks

1. Registration

Section 16

(1) The trade mark register shall be kept by the Patent Office.

(2) For the registration of a trade mark a written application must be filed with the Patent Office. Where a trade mark does not consist exclusively of figures, letters or words having no pictorial design and claiming no specific form of writing, a reproduction of the trade mark shall be submitted, in case of a sound mark an acoustic presentation of the mark in a musical notation or by means of a sonogram together with a tonal presentation of the trade mark on a data carrier. The number of reproductions of the trade mark to be submitted, their characteristics and dimensions as well as the data carriers to be used and details for the acoustic presentation, such as formats, sampling frequency, resolution and playing time shall be determined by ordinance.

(3) The application shall indicate the goods and services for which the trade mark is intended (list of goods and services); the detailed requirements in respect of the list of goods and services and the number of pieces to be submitted shall be determined by ordinance.

(4) In the ordinances to be issued by the President of the Patent Office in accordance with par 2 and 3 consideration shall be given to the requirements of the registration procedure and of the registration, printing and publication of the trade mark.

Section 17

(1) To be entered into the trade mark register upon registration are:

1. the trade mark,
2. the registration number,
3. the date of filing and the priority claimed, if any,
4. the proprietor of the trade mark and his representative, if any,
5. the goods and services for which the trade mark is intended, arranged according to the International Classification (Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, Federal Law Gazette No 401/1973) as amended),
6. the beginning of the period of protection,
7. if appropriate, a note that the trade mark has been registered on the basis of evidence of acquired distinctiveness.

(2) Where a registration is effected on the basis of a request for conversion, due reference shall be made in the register. Furthermore the following provisions shall apply:

1. Where the registration is based on a request for conversion in accordance with Art 108 of Regulation (EC) No 40/94 the date of filing of the Community trade mark in the meaning of Art 27 of this Regulation shall be considered the date of filing mentioned in par 1 subpar 3. If appropriate, the seniority claimed in accordance with Art 34 or 35 of the Regulation shall be entered into the register too.
2. Where the registration is based on a request for conversion in accordance with Art 9^{quinquies} of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, Federal Law Gazette III, No 32/1999, the date of filing in the meaning of par 1 subpar 3 shall be the date of the international registration in the meaning of Art 3 par 4, or the date of the registration of the territorial extension in the meaning of Art 3^{ter} par 2 of the Protocol. If appropriate, the time precedence the trade mark enjoys according to Art 4^{bis} of the Protocol shall be entered into the register too.

(3) Trade marks consisting exclusively of figures, letters or words having no pictorial design or claiming no special writing, shall be entered in capital letters or Arabic figures.

(4) The proprietor of the trade mark shall receive official confirmation of the entries in the register made in accordance with par 1.

(5) The trade mark shall be published after registration.

(6) The Trade mark register and the catalogues to be prepared on its contents shall be open to public inspection. A certified copy of the entries shall be issued upon request.

Section 18

(1) When registration of a trade mark is applied for, an application fee of 69 € including a search fee (Section 21) to the amount of 29 €, shall be payable together with a class fee. The class fee amounts to 15 € provided the list of goods and services does not comprise more than three classes; for each additional class the fee shall be increased by 21 €.

(2) Before a trade mark is registered a fee of 145 € covering the period of protection shall be payable upon request together with a contribution to the cost of printing for the publication (Section 17 par 5) (Section 72 par 1).

(3) Fees already paid in accordance with par 2 shall be reimbursed if the application does not lead to registration. The same shall apply to the contribution to the cost of printing (par 2).

(4) Applications for international registration of a trade mark under the Madrid Agreement Concerning the International Registration of Marks, Federal Law Gazette No 400/1973, and under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, Federal Law Gazette III, No 32/1999, both as amended, shall be subject to a national fee of 87 € in addition to the fee to be paid to the International Bureau. If the international registration is applied for under both agreements, the Madrid Agreement Concerning the International Registration of Marks as well as the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, only one national fee shall be payable though.

Section 19

(1) The right to a trade mark shall commence on the day of entry in the trade mark register (registration). The period of protection shall expire ten years after the end of the month in which the trade mark has been registered. It may be extended for further periods of ten years provided that renewal of registration is applied for in due time (pars 2 and 3). The new period of protection shall be calculated from the end of the preceding period, irrespective of the day of renewal.

(2) Registration shall be renewed by the payment of a renewal fee amounting to 363 €.

(3) The renewal fee (par 2) may be paid not earlier than one year before the end of the period of protection and not later than six months after the end of the period. For all payments after the end of the period of protection a 20 % surcharge shall be payable in addition.

Section 20

(1) All applications for registration of a trade mark shall be examined for their compliance with the law.

(2) If this examination reveals objections to the admissibility of the registration of the trade mark the applicant shall be required to comment on them within a set period. If, after timely receipt of the response or expiry of the time limit, registration is found not to be admissible, the application shall be refused by a final decision. Where there is no obstacle to registration the trade mark shall be registered after an examination for similarity (Section 21) and payment of the fees prescribed in Section 18, par 2, and of the contribution to the cost of publication.

(3) Where there are objections to the admissibility of the registration in view of Section 4 par 1 subpars 3, 4 and 5, it shall be determined by a decision upon request of the applicant prior to the refusal that the filed sign shall be eligible for registration only under the preconditions laid down in Section 4 par 2; such decision shall be contestable by appeal (Section 36).

Section 21

(1) Any trade mark filed shall furthermore be examined by the Patent Office within the framework of its partial legal capacity (Section 58a par 1, of the 1970 Patents Act, Federal Law Gazette No 259) whether it is identical or possibly similar to marks filed earlier and registered for goods or services of the same class (similarity research).

Identical or possibly similar trade marks shall be notified to the applicant together with the notice that the sign filed will be registered in case of its admissibility (Section 20 par 2) unless the application is withdrawn within the period determined by the Patent Office.

(2) The notification referred to in par 1 or the absence of such a notification shall in no way affect the evaluation of the scope of protection of the respective sign. It shall require neither signature nor official certification.

Section 21a

International trade marks (Section 2 par 2), for which protection is claimed in Austria, shall be examined for similarity within the period open for the notification of a refusal of protection, provided the necessary technical and organisational preconditions are at hand. Section 21 shall be applied *mutatis mutandis*.

Section 22

(1) The Patent Office within the framework of its partial legal capacity (Section 58a par 1 of the 1970 Patents Act, Federal Law Gazette No 259) shall provide any person, upon request, with written information, whether a specific sign is identical or possibly similar to trade marks whose respective goods and services fall into the classes specified in the request. Section 21 par 2 shall apply to such information. Where the sign is a registered trade mark, the indication of the registration number shall suffice. If the necessary technical and organisational preconditions are at hand, the similarity research shall also cover applications, community trade marks and applications of community trade marks.

(2) Information according to par 1 may be requested once only or regularly, i.e. at semi-annual, annual or biennial intervals. Regularly requested information shall be despatched in January, semi-annual information also in July.

(3) The requests shall be subject to payment of a remuneration the amount of which shall be published in the Patent Gazette (Section 79 of the 1970 Patents Act, Federal Law Gazette No 259).

(4) Upon renunciation of further information the respective amount shall be refunded.

Section 23

(1) The applicant shall obtain the right of priority on the day the application is properly filed.

(2) The list of goods and services in respect of a filed or registered mark may be subsequently extended. The rules for the application of a mark shall apply to such an extension *mutatis mutandis*.

Section 24

(1) The rights of priority granted on the basis of intergovernmental agreements or in accordance with par 2 must be expressly claimed. For that purpose, the date of the application the priority for which is claimed and the country in which the application was effected, shall be indicated (declaration of priority). The filing number shall be indicated too.

(2) The applicant shall enjoy the right of priority of a previous trade mark application for a subsequent application in Austria for a period of six months following the date of

filing the previous trade mark filed with an application office not covered by the scope of an intergovernmental agreement on recognition of priority, if the subsequent trade mark application refers to the same mark and if a respective mutuality with this application office is declared by a notice to be published by the Federal Minister of Economic Affairs in the Federal Law Gazette. The conditions and effects of this right of priority shall correspond to those listed in Art 4 of the Paris Convention for the Protection of Industrial Property, Federal Law Gazette No 399/1973.

(3) The declaration of priority shall be submitted to the Patent Office within two months after the application has been filed. Within this period, an amendment of the declaration of priority may be requested. Such a request shall be subject to payment of a fee amounting to half of the fees payable for an application.

(4) Where the granting or maintenance of the right of protection depends on whether or not the priority was lawfully claimed, the right of priority must be proved. The evidence required for this proof (priority documents) and the time of submission shall be determined by ordinance.

(5) If the declaration of priority has not been filed in due time, if the priority documents have not been submitted in due time or if the filing number of the application for which the priority is claimed has not been communicated on official demand within the period laid down, priority shall be determined according to the date of filing in Austria.

Section 25

(1) Trade marks used for the designation of goods displayed in a domestic or foreign exhibition shall enjoy priority in accordance with the provisions of Sections 26 and 27.

(2) The provisions of Sections 26 and 27 shall apply in particular also to displays in model or merchandise exhibitions.

Section 26

(1) The protection shall be accorded only if the Federal Minister of Economic Affairs has granted the exhibition of the privilege of priority protection for trade marks used for the designation of goods displayed there.

(2) Such privilege shall be applied for by the exhibition management. The request shall contain all particulars required for the decision on the desired priority privilege.

(3) The request shall be granted where intergovernmental obligations require protection to be afforded or where it is justified in view of the economic importance of the exhibition.

(4) The grant of the privilege of priority protection shall be published in "Amtsblatt zur Wiener Zeitung" and in "Österreichisches Patentblatt" at the expense of the exhibition management.

Section 27

(1) The protection shall have the effect that the trade mark enjoys a priority right as from the date the goods designated with the mark were brought to the exhibition premises provided the mark is filed with the Patent Office within three months after the day of closure of the exhibition. The application may only comprise the displayed goods designated with the trade mark at the exhibition.

(2) Where identical or similar goods designated by identical or similar trade marks are brought to the exhibition premises at the same time the trade mark filed first shall have priority.

(3) The right of priority must be expressly claimed. For that purpose, the exhibition and the day when the goods marked were brought to the exhibition premises shall be indicated (declaration of priority). The provisions of Section 24 par 2 shall apply *mutatis mutandis*.

(4) The right of priority shall be evidenced by a reproduction of the trade mark and a certificate of the exhibition management stating the goods that were displayed with the respective mark and the time they were brought to the exhibition premises (priority documents).

(5) If the declaration of priority is not submitted in due time or if the priority documents are not submitted on official demand in due time, the priority shall be determined according to the date of filing.

2. Changes in the Register

Section 28

(1) The record of transfer of a trade mark, the entry and cancellation of licence-rights and liens shall be effected at the written request of one of the parties concerned and the submission of a document. If the document is not of an official nature, it shall be required to bear the duly certified signature of the person alienating his right. The entry and cancellation of liens shall also be effected at the request of the courts.

(2) Legal disputes concerning trade mark rights and cancellation proceedings (Sections 30 to 34 and Section 66), assignment proceedings (Section 30a) and proceedings for the establishment a posteriori of the invalidity of a trade mark (Section 69a) shall, on request, be recorded in the trade mark register (entry relating to disputes).

(3) Furthermore, Section 43 par 3, 4 and 7 and Section 45 par 2 of the 1970 Patents Act, Federal Law Gazette No 259 shall apply *mutatis mutandis*.

(4) For each request referred to in par 1 a fee equal to the application fee shall be payable, for a request in accordance with par 2 a fee to the amount of 23 €.

(5) The entries referred to in par 1 shall be noted, on request, in the official confirmation of the registration entry (Section 17 par 4).

(6) The transfer of the trade mark shall be published.

3. Cancellation

Section 29

(1) The trade mark shall be cancelled:

1. at the request of the proprietor;
2. where the registration has not been renewed in due time (Section 19);
3. where the right to the mark has lapsed for reasons other than those referred to under subpars 1 and 2;
4. following a final decision granting a petition for cancellation submitted to the Nullity Division.

(2) Cancellation shall be entered in the trade mark register (Section 17) and published.

Section 30

(1) The proprietor of an earlier trade mark being still valid may request the cancellation of a trade mark provided that either

1. the two trade marks and the goods or services for which the trade marks are registered are identical, or
2. the two trade marks and the goods and services for which the trade marks are registered are identical or similar so that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(2) The proprietor of an earlier trade mark being still valid and having a reputation in Austria may also request the cancellation of a trade mark, if the two trade marks are identical or similar but registered for not similar goods or services and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the reputed trade mark. The reputation of the earlier trade mark shall be required to have existed at the latest on the date of filing of the later trade mark or on the date of priority or seniority claimed for the registration of the later trade mark, as the case may be.

(3) Petitions in accordance with par 1 or 2 shall be dismissed if the petitioner has acquiesced, for a period of five successive years, in the use of a later trade mark while being aware of such use. This shall only apply to goods and services for which the later trade mark has been used and only if registration of the later mark was not applied for in bad faith.

(4) If a petition for cancellation in accordance with par 2 is based on a earlier Community trade mark, evidence of reputation in the European Community, instead of evidence of reputation in Austria, shall be furnished.

(5) The cancellation decision shall have retroactive effect to the beginning of the period of protection (Section 19 par 1)

Section 30a

(1) A person having acquired rights to a sign abroad by registration or use may request an identical or similar trade mark, filed at a later date for identical or similar goods or services to be cancelled, if the proprietor of such mark is or was committed to looking after the business interests of the petitioner and had the trade mark registered without the latter's consent and without proper justification.

(2) The cancellation decision shall have retroactive effect to the beginning of the period of protection (Section 19 par 1).

(3) Instead of the cancellation in accordance with par 1 the petitioner may request that the trade mark is transferred to him.

Section 31

(1) The cancellation of a trade mark may be requested by a person furnishing evidence that the unregistered sign used by him for identical or similar goods or services, already at the date of application of the contested trade mark being identical or similar to his unregistered sign, had been considered within the trade circles concerned as designation of his undertaking's goods or services, unless the trade mark has been used by its proprietor unregistered for at least as long as it has been used by the undertaking of the petitioner.

(2) The petition shall be dismissed if the petitioner has acquiesced, for a period of five successive years, in the use of the registered trade mark while being aware of such use. This shall only apply to goods and services for which the registered trade mark has been used and only if the application for the registered trade mark was not filed in bad faith.

(3) The cancellation decision shall have retroactive effect to the beginning of the period of protection (Section 19 par 1).

Section 32

(1) An entrepreneur may request the cancellation of a trade mark if his name, his firm name or the special designation of his undertaking or a designation similar to these designations has been registered without his consent as a trade mark or as component of a trade mark (Section 12), and if the use of the trade mark could entail the likelihood of confusion in trade with one of the signs distinctive of the petitioner's undertaking mentioned above.

(2) The petition shall be dismissed if the petitioner has acquiesced, for a period of five successive years, in the use of the registered trade mark while being aware of such use. This shall only apply to goods and services for which the registered trade mark has been used and only if the application for the registered trade mark was not filed in bad faith.

(3) The cancellation decision shall have retroactive effect to the beginning of the period of protection (Section 19 par 1).

Section 33

(1) On any of the grounds for cancellation ex officio anyone shall be entitled to request the cancellation of a trade mark.

(2) If a trade mark is cancelled because it ought not to have been registered, the cancellation decision shall have retroactive effect to the beginning of the period of protection (Section 19 par 1).

Section 33a

(1) Anyone may request the cancellation of a trade mark registered in Austria or enjoying protection in Austria in accordance with Section 2 par 2 for at least five years, if this trade mark was not genuinely used (Section 10a) for the designation of goods or services in respect of which it is registered within a period of five years prior to the day of submission of the petition in Austria, either by the proprietor of the trade mark himself or, with his consent, by any third party, unless the proprietor of the trade mark can justify the non-use.

(2) Where trade marks have not been used because of legal restrictions in trade with the goods or services for which they are registered, they shall be exempt from cancellation in accordance with par 1 only if interests warranting protection of the trade mark in Austria can be recognised because of genuine use of the sign abroad or other circumstances worthy of consideration.

(3) The proprietor of the trade mark may not, however, cite use of the trade mark which had been started only after

1. the proprietor of the trade mark or a licensee had cited the right to the mark vis-à-vis the person submitting the petition, or

2. the person submitting the petition had drawn the attention of the proprietor of the trade mark or of a licensee to the fact of non-use, if the petition for cancellation was submitted within three months after one of the actions referred to under subpar 1 or 2 firstly has occurred.
- (4) Use of the trade mark shall be equivalent to the use of the trade mark in a form differing only in elements which do not alter the distinctive character of the mark in the form in which it was registered.
- (5) Evidence of use (par 1) shall be furnished by the proprietor of the trade mark.
- (6) The cancellation decision shall have retroactive effect for five years as from the date the petition is filed, but at most to the end of the fifth year of the protection period.

Section 33b

- (1) Anyone may request the cancellation of a trade mark which in consequence of acts or inactivity of its proprietor subsequent to its registration has become the common name in the trade for a product or service in respect of which it is registered.
- (2) The cancellation decision shall have retroactive effect to the date for which the accomplished development of the trade mark to a sign in general use (generic term) has been proved.

Section 33c

- (1) Anyone may request the cancellation of a trade mark which in consequence of the use made of it by its proprietor or with his consent in respect of the goods or services for which it is registered is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
- (2) The cancellation decision shall have retroactive effect to the date for which deceptive use of the trade mark has been proved.

Section 34

- (1) Anyone may request the cancellation of a trade mark where the applicant was acting in bad faith when he filed the application for the trade mark.
- (2) The cancellation decision shall have retroactive effect to the beginning of the period of protection (Section 19 par 1).

4. Authorities and procedures

Section 35

- (1) In the Patent Office the taking of decisions and other activities in all matters of trade mark protection and of the protection of geographical indications and designations of origin in accordance with Chapter VII, shall be the responsibility of the competent member, according to the allocation of activities, of the Legal Division entrusted with these matters, unless where such matters fall within the competence of the President, the Appeal Division or the Nullity Division.
- (2) Sections 58 to 61 of the 1970 Patents Act, Federal Law Gazette No 259, shall apply mutatis mutandis.
- (3) By order of the President, employees who are not members of the Patent Office may be empowered to deal with matters – whose nature shall be clearly defined - of

the Legal Division insofar as this is expedient in view of the simplicity of the matters in question and to the extent that the employees so empowered are qualified to deal properly with such matters. Such employees may not be authorised to take decisions as to the protectability of trade marks or to the admissibility of lists of goods and services. They shall comply with the instructions of the member of the Legal Division, competent according to the allocation of activities. Such member may at any time reserve matters or take charge of them.

(4) A reasoned representation against the decision of an employee empowered in accordance with par 3, may be made to the competent member of the Legal Division within one month. Where such representation is made in due time, the decision shall cease to be effective.

Section 36

The decisions of the Legal Division shall be subject to appeal. There shall be no ordinary legal remedy against the decisions of the Appeal Division.

Section 37

The Nullity Division shall decide in respect of petitions for the cancellation of a registered trade mark (Sections 33 to 34 and Section 66), requests for transfer (Section 30a) and petitions for the establishment a posteriori of invalidity of a trade mark (Section 69a).

Section 38

(1) The Appeal Division and the Nullity Division shall pass decisions by a panel of three members, one of whom shall be in the chair. The chairperson and one other member shall be legally qualified.

(2) Preliminary decrees of the rapporteur and interim decisions shall not be subject to separate appeal, but their review may be requested at the respective division.

Section 39

(1) The final decisions of the Nullity Division shall be appealable to the Supreme Patent and Trade Mark Chamber as highest instance. Section 74 of the 1970 Patents Act shall apply.

(2) The Supreme Patent and Trade Mark Chamber shall deliberate and take decisions under the chairmanship of its president or, in his absence, of the vice-president in boards consisting of five members, representing the chairperson, three legally qualified members (Section 74 par 3 of the 1970 Patents Act) and one technically qualified member (Section 74 par 4 of the 1970 Patents Act). The boards shall be composed by the chairperson in such a way as to include one legally qualified civil servant of Group A and at least one judge. The legally qualified civil servant shall be the rapporteur, the chairperson may, if necessary, appoint further members of the board as joint rapporteurs.

(3) The provisions of Section 75 par 2 of the 1970 Patents Act shall apply.

Section 40

(1) For appeals a fee of 65 € shall be payable in respect of every trade mark filed or registered, to which the appeal relates. A fee of 210 € shall be payable for petitions to be dealt with by the Nullity Division (Section 37), a fee of 319 € for an appeal (Section 39) in respect of each trade mark to which the petition (appeal) refers.

(2) The fee for an appeal (par 1) shall be reimbursed if the appeal essentially meets with success and the proceedings have been conducted without an adverse party. Half of the fee provided for a petition to be dealt with by the Nullity Division or for an appeal shall be refunded if that petition or appeal is rejected or the proceedings are terminated without any hearing.

Section 41

(1) Members of the Patent Office and of the Supreme Patent and Trade Mark Chamber shall be excluded from any participation under the conditions specified in Section 76 par 1 of the 1970 Patents Act.

(2) Members of the Patent Office may not take part in the work of the Appeal Division when they have participated in the examination for compliance with the law (Section 20) or similarity (Sections 21 and 22) in respect of the mark concerned by the appeal.

(3) Members of the Patent Office may not take part in the work of the Nullity Division and members of the Supreme Patent and Trade Mark Chamber may not participate in the work of the Chamber:

1. in proceedings for the cancellation of a trade mark under Section 30 or for the establishment a posteriori of the invalidity of a trade mark under Section 69a in combination with Section 30, if they have taken part in the similarity examination (Sections 21 and 22) of the mark concerned;
2. in proceedings for the cancellation of a trademark under Section 33 or for the establishment a posteriori of the invalidity of a trade mark under Section 69a in combination with Section 33, if they have taken part in the decision as to the admissibility of the registration.

(4) Section 76 pars 4 and 5 of the 1970 Patents Act shall apply mutatis mutandis.

Section 42

(1) In all other respects, unless otherwise provided for hereunder, Sections 52 to 56, 57b, 58a, 58b, 64, 66 to 73, 79, 82 - 86, 112 to 126, 127 pars 1, 2, 4 and 5, Section 128 first sentence, Sections 129 to 133 par 2, Sections 134, 135, 137 to 145, 165, 169 and 172a par 1 of the 1970 Patents Act, Federal Law Gazette No 259, shall be applied to the procedure mutatis mutandis; the procedural fee provided for in Section 132 par 1 lit. b of the 1970 Patents Act shall correspond to the application fee (Section 18 par 1).

(2) The publications provided for in Section 17 par 5, in Section 28 par 6 and in Section 29 par 2 shall be made in the Österreichischer Markenzeiger (Trade Mark Bulletin). Any authorisation of a reinstatement shall be announced in the Österreichischer Markenzeiger if the effect thereof is to reinstate the right to the mark.

(3) If the proprietor of a contested trade mark does not gainsay in writing within the period prescribed, the Nullity Division shall, in accordance with the petition, without any further proceedings order the entire or partial cancellation or transfer of the trade mark or establish a posteriori the entire or partial invalidity of the trade mark. Where both, the cancellation and the transfer of a trade mark are requested in the same

procedure, the Nullity Division shall order the transfer, unless the petition reads to the contrary.

Sections 43 to 49 (repealed; Federal Law Gazette 1977/350)

Section 50

(1) Those involved in proceedings shall be entitled to inspection of documents referring to the proceedings and to making copies thereof. Other persons shall have that right with the consent of those involved or on furnishing prima facie evidence of a legal interest.

(2) Where documents refer to a trade mark still in force, anyone may inspect or copy them or may have copies made of them.

(3) Copies shall be certified by the Patent Office upon request.

(4) The wording or the representation of the trade mark filed and the list of goods and services as it stands at the time of application shall be communicated to anyone so requesting. Information and official certificates as to the date of an application, the name of the applicant and of his representative - if any -, the serial number of the application, the priority claimed, the serial number of the application on which priority is based, whether the application is still pending and if and to whom the right to the application was assigned, shall be supplied to anyone so requesting.

(5) Records of deliberations and parts of files referring to internal administrative transactions only shall not be accessible to the public. Furthermore also parts of files not requiring a laying open to public inspection for information purposes may be excluded on request if they refer to a trade or industrial secret or if there is another good reason therefore.

Chapter III

Civil rights claims in respect of infringements of trade mark rights

Section 51

Any person who suffers an infringement of one of the rights belonging to him under a trade mark or who has to worry that such an infringement might take place, may sue for an injunction.

Section 52

(1) The infringer of a trade mark shall be obliged to eliminate the circumstances constituting the violation of the law.

(2) The infringed party may, in particular, demand that at the expense of the infringer the objects infringing the trade mark and possibly existing stocks of imitated trade marks (infringing objects) be destroyed and the implements, machinery and other means having served solely or mainly for the manufacture of the infringing objects (infringing means) be rendered unusable for the intended purpose, insofar the rights in rem of third parties are not thereby infringed.

(3) Where the infringing objects or infringing means specified in par 2 contain parts of which the continued existence and use by the defendant do not infringe the right of exclusion of the plaintiff, the court shall specify those parts in the judgment ordering

them to be destroyed or rendered unusable. At the execution of the judgment these parts shall, as far as possible, be exempt from being destroyed or rendered unusable if the obligor pays the costs incurred in advance.

(4) If it becomes apparent in the course of execution that rendering infringing means unusable would entail higher costs than their destruction and if these costs are not paid by the obligor in advance, the court of execution shall order the destruction of these infringing means after having heard the parties.

(5) If the law contending circumstances can be eliminated in another way than that specified in par 2, which involves no or less destruction of assets the injured party may request only measures of this kind. The mere removal of the trade mark from the good shall be sufficient only if another procedure would cause undue hardship for the infringer.

(6) Instead of the destruction of infringing objects or the rendering infringing means unusable the injured party may demand that the infringing objects and means be handed over to the injured party by their owner in exchange of an adequate compensation not exceeding the production costs.

Section 53

(1) The party infringed by unauthorised use of a trade mark shall be entitled to an appropriate compensation by the infringer.

(2) In the case of a culpable infringement of a trade mark the infringed may, instead of an appropriate compensation, demand

1. damages including the missed profit or
2. the handing over of the profit made by the infringer through the trade mark infringement.

(3) Irrespective of proof of a damage the infringed may demand twice the compensation due to him in accordance with par 1 if the infringement of the trade mark results from gross negligence or intention.

(4) The infringed shall also have a claim of appropriate compensation for disadvantages not consisting of a damage in property suffered by the culpable infringement of the trade mark insofar as this is justified by the special circumstances of the case.

(5) Where the same pecuniary claim is raised against several persons, they shall be jointly and severally liable.

Section 54

(1) The proprietor of an enterprise may be sued for an injunction (Section 51) if an infringement of a trade mark has been, or is likely to be, committed by an employee or an agent in the course of the activities of his enterprise. He shall be obliged for the elimination (Section 52) if he is the owner of the objects or means of infringement.

(2) If the infringement of a trade mark constituting a claim for appropriate compensation is committed in the course of the activities of an enterprise by an employee or an agent, the obligation to pay compensation (Section 53 par 1) and to draw up accounts (Section 55) shall affect only the proprietor of the enterprise unless the latter neither knew of the infringement of the trade mark nor obtained any profit from it.

(3) If the infringement of a trade mark is committed in the course of the activities of an enterprise by an employee or an agent culpable, the proprietor shall be liable in accordance with Section 53, pars 2 to 4, without prejudice to the liability of these

persons, provided that he knew or should have known about the infringement of the trade mark.

Section 55

In all other respects Section 119 par 2 (exclusion of the public), Section 149 (publication of the judgement), Section 151 (accounting) and Section 154 (prescription) of the 1970 Patents Act, Federal Law Gazette No 259, shall apply *mutatis mutandis*.

Section 56

In order to safeguard the claims for injunction or elimination provided for in this chapter, interim injunctions may be issued also where the preconditions stipulated in Section 381 of the Order of Execution (EO) are not met. However, an interim injunction, based on a trade mark registered for more than five years, may only be issued, if *prima facie* evidence is furnished that there is no justification for a cancellation in accordance with Section 33a.

Section 57

If it transpires in the course of court proceedings that the decision depends on the preliminary question of whether the trade mark right in respect of which the infringement is claimed, is valid in accordance with the provisions of this law, and if the court has suspended proceedings until a legally effective decision has been passed on the preliminary question by the Patent Office at which the preliminary question had already been brought to trial prior to the beginning of or during the court proceedings, the judgment shall be based on that decision.

Section 58

(1) Where the proprietor of an earlier registered trade mark has acquiesced, for a period of five successive years, in the use of a later sign in Austria while being aware of such use, he shall no longer be entitled on the basis of the previous right to oppose the use in respect of the goods or services for which the later sign was used, unless the user of the later sign commenced the use in bad faith or, if the later sign refers to a registered trade mark, its application was made in bad faith.

(2) In the case of par 1 the proprietor of the later trade mark or the user of the later sign shall not be entitled to oppose the use of the previous registered trade mark although the latter may no longer be invoked against him.

Section 59

(1) Where a commercial announcement or communication in respect of which an injunction in the meaning of Section 51 is at issue, appears in a publication not subject to the disposition of the obligor, the competent court for the authorisation of the execution may, upon request of the acting creditor, issue an order (Section 355 EO) to the proprietor of the enterprise dealing with the publishing or the distribution of the publication to discontinue further publications of the announcement or communication in numbers, volumes or editions of the publications appearing after

the delivery of the order or, if the publication contains the announcement or communication only, to discontinue the further distribution of the latter.

(2) This measure may also be adopted as an interim order in the meaning of Section 382 EO under the terms of the rules of the Order of Execution upon request of an endangered party. Section 56, first sentence, shall be applied.

(3) As regards the claim for damages of the applicant on the grounds of infringement of the order (Section 355 EO) Section 53 par 2 subpar 1 and par 4 shall be applied *mutatis mutandis*.

Chapter IV

Punishable Infringements of Signs

Section 60

(1) Whoever infringes a trade mark in the trade shall be punished by the court with a fine of up to 360 daily rates. Whoever commits the deed for gain shall be punished with imprisonment of up to two years.

(2) Equally punished shall be whoever uses, without authorisation, a name, a firm name or the special designation of an undertaking or a sign similar to these designations for the identification of goods or services in accordance with Section 10a entailing the likelihood of confusion in the trade.

(3) The proprietor or manager of an enterprise shall be punished if he fails to prevent an infringement in accordance with pars 1 or 2, committed by an employee or an agent in the course of the activities of the enterprise.

(4) Where the proprietor of the enterprise in accordance with par 3 is a company, a cooperative, an association or an other legal subject not being a physical person, par 3 shall be applicable to the organs guilty of failure to act. As regards the fine imposed, the proprietor of the enterprise shall be jointly and severally liable with the person found guilty.

(5) The penal provisions referred to in par 1 and 2 shall not be applicable to employees or agents having acted upon instruction of their employer or the ordering party if it would be unreasonable to expect them to refuse the execution of such action because of their economic dependency.

Section 60a

(1) The offences referred to in Section 60 shall be pursued only upon request of the infringed.

(2) The criminal proceedings shall be incumbent on the judge sitting alone at the court of the first instance.

(3) As regards the assertion of claims under Section 53 the provisions of the Title XXI of the Code of Criminal Procedure, 1975, Federal Law Gazette No 631, shall apply. Both parties shall be entitled to appeal against the decision on the claims for compensation.

Section 60b

In respect of criminal proceedings concerning the infringement of trade marks and signs Section 52 of this Federal Act (elimination) and Section 119 par 2 (exclusion of the public) and Section 149 (publication of judgement) of the 1970 Patents Act,

Federal Law Gazette No 259, shall apply mutatis mutandis. In respect of the criminal proceedings concerning the infringement of trade marks Section 57 shall also apply.

Section 60c

Whoever acts in contradiction to the provisions of an ordinance issued pursuant to Section 9 shall be punished by the district administration authority with a fine up to € 72 or with arrest of up to one month. In case of aggravating circumstances both penalties may be imposed simultaneously. In case of a conviction the forfeiture of the goods shall always be adjudged.

Section 61

(1) Anyone acting as a representative vis-à-vis the Patent Office or the Supreme Patent and Trade Mark Chamber shall have a domestic residence; however, the respective professional regulations shall apply to attorneys at law, patent attorneys and notaries. The representative shall prove his authorisation by furnishing the original written power of attorney or a duly certified copy thereof. If more than one person are vested with the power of attorney each of them shall be entitled to act alone as a representative.

(2) If an attorney at law, patent attorney or notary takes action, reference to the authorisation granted to him shall replace its documentary evidence.

(3) If a representative takes action without a power of attorney or in the case of par 2 without referring to the authorisation granted to him, the procedural action taken by him shall be effective only on condition that he furnishes a proper power of attorney or refers to the authorisation granted to him within a reasonably fixed time limit.

(4) Anyone having neither domestic residence nor domestic place of business may assert rights on the basis of this Federal Act vis-à-vis the Patent Office only if he has a representative meeting the requirements of par 1. He may assert such rights vis-à-vis the Appeal Division and the Nullity Division and the Supreme Patent and Trade Mark Chamber only if he is represented by an attorney at law, a patent attorney or a notary. If the residence or place of business is situated in the EEA the appointment of a representative for service having a domestic residence shall suffice for asserting rights on the basis of this Federal Act. Neither the appointment of a representative nor of a representative for service shall be required for the use of the customer and information services of the Patent Office.

(5) An authorisation granted to an attorney at law, a patent attorney or a notary for the purpose of representation at the Patent Office shall entitle the latter, in virtue of the law, to assert all rights on the basis of this Federal Act vis-à-vis the Patent Office and the Supreme Patent and Trade Mark Chamber, in particular to file trade mark applications, withdraw applications, waive rights to trade marks, file and withdraw petitions and appeals falling within the competence of the Nullity Division, furthermore to conclude compromises, accept deliveries of all kinds as well as official fees and the procedural and representation costs to be paid by the adverse party, and to appoint a substitute.

(6) An authorisation in accordance with par 5 may be restricted to a certain protective right and to the representation in certain proceedings only. However, it shall not be revoked by the death of the grantor nor by a change in his capacity to take legal action.

(7) If a representative other than an attorney at law, a patent attorney or a notary also is meant to be entitled to waive a trade mark wholly or in part, he shall have to be explicitly authorised therefore.

Section 61a

Supplementary to Section 83c JN the place where

1. the representative has his domestic residence or domestic place of business, or
2. the representative for service has his domestic residence, or,
3. in lack of a representative with a domestic residence or a domestic place of business or a representative for service with domestic residence, the place where the Patent Office is situated

shall be considered for all matters referring to the trade mark as the residence or place of business of a proprietor of a trade mark who has neither a domestic residence nor a domestic place of business.

Chapter VI Collective marks

Section 62

(1) Associations with legal personality may apply for the registration of trade marks intended for the purpose of identifying goods or services of their members and capable of distinguishing these goods or services from those of other undertakings (collective marks).

(2) Legal persons governed by public law shall be considered to be equal to the associations referred to in par 1.

(3) The provisions of this Federal Act shall apply accordingly to collective marks unless otherwise provided for in par 4 and in Sections 63 to 67. In particular, the legal effects provided for in Section 4 par 2 and Section 31 of this Federal Act and in Section 9 par 3 of the 1984 Federal Act Against Unfair Competition, Federal Law Gazette No 448 in favour of unregistered signs shall apply where the sign is recognized in the trade concerned as distinctive of the goods or services of the members of an association.

(4) In derogation from par 1 and Section 4 par 1 subpar 4 collective marks may consist exclusively of signs or indications which may serve in trade to designate the geographical origin of the goods or services. Such a trade mark shall not entitle its proprietor or any other association member, authorised to file a claim according to the regulations on their own, to prohibit a third party from using these signs or indications in the course of trade, provided that such use corresponds to the honest practices in industrial and commercial matters; in particular, such a trade may not be invoked against a third party entitled to use a geographical name.

Section 63

(1) The application of a collective mark shall be accompanied by regulations rendering information on the name, place of business, purpose and representation of the association, on the circle of persons authorised to use the collective mark, the conditions governing such use, the withdrawal of the right of use in case of misuse of

the collective mark, and on the rights and obligations of the members where the collective mark is infringed. With collective marks in accordance with Section 62 par 4 the regulations shall, furthermore, authorize any person whose goods or services originate in the geographical area concerned and correspond to the conditions of use of the collective mark as contained in the regulations, to become a member of the association. Subsequent amendments of the regulations shall be communicated to the Patent Office. They shall be binding on third parties only as from the day following such communication. The regulations and any amendments thereto shall be submitted in duplicate. The regulations shall be open to public inspection.

(2) The application fee for collective marks shall be four times the application fee provided for in Section 18 par 1, the fee for the period of protection and the renewal fee shall be ten times the fee for the period of protection provided for in Section 18 par 2.

Section 64

When registering collective marks the Patent Office shall enter the particulars prescribed in Section 17 par 1 in the Trade mark Register and in the certificate to be issued to the party in question, with the following supplements and modifications:

1. under the registration number the term "collective mark";
2. a reference to the regulations and its date.

Section 65

(1) Collective marks may only be transferred to associations in the meaning of Section 62 pars 1 or 2. The request for a transfer shall be accompanied by the regulations of the new proprietor. Section 63 par 1 shall be applied mutatis mutandis.

(2) The transfer fee for collective marks shall be four times the application fee provided for in Section 18 par 1.

Section 66

Notwithstanding the provisions otherwise in force in respect of the cancellation of a trade mark (Section 62 par 3) a collective mark shall be cancelled

1. where an association in the meaning of Section 62 pars 1 or 2 no longer exists as proprietor of the collective mark;
2. where the association permits or tolerates that the collective mark is used in a way contrary to the general purposes of the association or its regulations. In particular, use of the collective mark which is likely to mislead the trade shall be considered as misuse.

Section 67

The claim of the association to compensation for unauthorized use of the collective mark in accordance with current provisions shall also extend to any loss sustained by a member.

Chapter VII
Geographical indications and designations of origin in accordance with
Regulation (EEC) No 2081/92 of July 14, 1992 on the Protection of
Geographical Indications and Designations of Origin for Agricultural Products
and Foodstuffs, OJ. No L 208, page 1, as amended by Regulation (EC) No
1068/97 of July 13, 1997 OJ. No L 156, page 10

Section 68

(1) Applications for registration of a geographical indication or designation of origin in the Register kept by the Commission of the European Communities of protected designations of origin and protected geographical indications and enclosures thereto shall be filed in triplicate with the Patent Office.

(2) For the application a fee to the amount of 581 € shall be payable.

(3) The form and content of the application may be determined in more detail by an ordinance of the President of the Patent Office. When issuing such an ordinance consideration shall be given to the utmost usefulness and simplicity as well as to the requirements in respect of the publication of an application.

(4) If an application does not meet the specified requirements, the applicant shall be requested to remedy the deficiencies within a prescribed period to be extendable upon request. Not amended applications shall be rejected by decision.

(5) Half of the fee stipulated in par 2 shall be refunded if the application is rejected in accordance with par 4 or is withdrawn prior to having been forwarded to the Commission of the European Communities.

(6) Unless otherwise provided for in this Chapter the other provisions of this Federal Act shall be applied to the procedures in accordance with this Chapter *mutatis mutandis*.

Section 68a

(1) If it appears from the examination that the application meets the requirements of the Community Law regarding the Community-wide protection of geographical indications or designations of origin, the name and address of the applicant, the geographical indication or designation of origin, the type of the agricultural product or foodstuff to be designated with, in the case of applications in accordance with Section 68c the designation of the element of the specification covered by the amendment, as well as information on the possibility of delivering an opinion in accordance with par 2 shall be published in the Patent Gazette. Failing this, the application shall be dismissed by decision.

(2) Within a period of three months from the day of publication anyone may file a written opinion on the application with the Patent Office, to be included into the official examination procedure. By doing so the intervening person shall neither become a party nor be entitled to compensation of costs. The intervening person shall not be informed on the result of the examination procedure, either. Opinions lodged out of time shall not be taken into consideration.

(3) If no opinions are received or if the examination carried out on the basis of the opinions received reveals that the application meets the requirements of the Community Law regarding the Community-wide protection of geographical indications and designations of origin, the applicant shall be informed accordingly and the application forwarded to the Commission of the European Communities with all documents of relevance for the decision. Failing this, the application shall be dismissed by decision.

Section 68b

(1) Objections to the intended registration of a geographical indication or designation of origin in accordance with Art 7 par 3 of Regulation (EEC) No 2081/92 shall be raised with the Patent Office within three months of the date of the relevant publication in the Official Journal of the European Communities in accordance with Art 6 par 2 of this Regulation and the grounds for the objection shall be stated within this time limit. The substantiated objection and all enclosures if any shall have to be submitted to the Patent Office in triplicate at the latest on the last day of the period.

(2) The circumstances explaining the reasonable interest of the objector shall be indicated in the objection.

(3) Objections lodged out of time or those being not substantiated in good time or objections not containing statements in accordance with par 2, shall be deemed not to have been raised. This shall be communicated informally to the objector. This communication or any absence thereof shall have no bearing on the commencement of the legal effect.

(4) A reinstatement into the former status shall not be granted where the time limit stipulated for the activities referred to in pars 1 and 2 has not been observed.

(5) The Patent Office shall be the competent authority for procedures in accordance with Art 7 par 5 of Regulation (EEC) No 2081/92 .

Section 68c

Applications for amendments of the specification shall be filed with the Patent Office. Section 68 par 3, 4 and 6 and Sections 68a and 68b shall be applied mutatis mutandis.

Section 68d

In procedures in accordance with this Chapter the Patent Office may obtain the opinion of, in particular, federal ministries, regional authorities as well as associations, organisations and institutions of trade and industry.

Section 68e

Where a legitimate interest can be demonstrated the Patent Office shall grant authorisation to consult the file and to make copies in accordance with Sections 68 to 68c. Section 50 pars 2 to 5 shall be applied mutatis mutandis.

Section 68f

(1) Whoever performs acts in trade which infringe Art 8 or 13 of Regulation (EEC) No 2081/92 may be sued by parties entitled to the use of the protected geographical

indications or designations of origin or by associations for the promotion of economic interests of entrepreneurs, in as far as these associations represent interests affected by the acts performed, by the Federal Chamber of Labour (Bundesarbeitskammer), the Austrian Chamber for Trade and Industry (Bundeskammer der gewerblichen Wirtschaft), the Standing Conference of the Presidents of the Agricultural Chambers in Austria (Präsidentenkonferenz der Landwirtschaftskammern Österreichs) and the Austrian Trade Union (Österreichischer Gewerkschaftsbund), for an injunction and, as far as the person concerned is vested with the respective right of disposal, for the elimination of the conditions infringing the relevant provisions. Section 52 pars 2 to 6 shall be applied *mutatis mutandis*.

(2) If an act as referred to in par 1 is performed culpably the person entitled to the use of the protected geographical indication or designation of origin shall be entitled to pecuniary claims in application of Section 53 pars 2, 4 and 5 *mutatis mutandis*.

(3) The proprietor of an enterprise may, in accordance with par 1, be sued for an injunction if one of the acts referred to in par 1 has been performed or is likely to be performed by an employee or an agent in the course of the activities of his enterprise. If he is the owner of the objects or means of infringement he shall be obliged for their elimination in accordance with par 1.

(4) If an employee or agent in the course of the activities of an enterprise culpably performed an act as referred to in par 1, the proprietor of the enterprise may be sued for damages in accordance with Section 53 pars 2 and 4 irrespective of possible liabilities of the above-mentioned persons, and for accounting, provided that he knew or should have known about the infringement of the law.

Section 68g

(1) In order to safeguard the claims for injunction or elimination provided for in this Chapter, interim injunctions may be issued also where the preconditions stipulated in Section 381 of the Order of Execution (EO) are not met.

(2) In all other matters Section 119 par 2 (exclusion of the public), Section 149 (publication of the judgement), Section 151 (accounting) and Section 154 (prescription) of the 1970 Patents Act, Federal Law Gazette No 259 shall apply, *mutatis mutandis*, to the civil rights infringement procedures in accordance with this Chapter.

Section 68h

(1) Whoever, in trade, without justification on the basis of an accepted exceptional Community Law provision for the use of a protected geographical indication or designation of origin

1. uses such an indication or designation for identifying other products than those referred to in the respective specification but comparable to the latter, or
2. misuses or imitates such an indication or designation or evokes the protected name, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as "style", "type", "method", "as produced in", "imitation" or similar, or
3. uses such an indication or designation in a way that exploits the reputation of the protected name, or
4. uses the above in any other misleading way in connection with the

distribution of goods or services or for the identification of his undertaking,

shall be punished by the court with a fine of up to 360 daily rates. Whoever commits the deed for gain shall be punished with imprisonment of up to two years.

(2) Whoever offers goods as designated in par 1 for sale, puts them on the market, or imports, exports or possesses the latter for these purposes, shall be punished in the same way.

(3) The proprietor or manager of an enterprise shall be punished if he fails to prevent an infringement in accordance with pars 1 or 2 committed by an employee or agent in the course of the activities of the enterprise.

(4) Where the proprietor of the enterprise in accordance with par 3 is a company, a cooperative, an association or an other legal subject not being a physical person, par 3 shall be applicable to the organs guilty of failure to act. As regards the fine imposed, the proprietor of the enterprise shall be jointly and severally liable with the person found guilty.

(5) The penal provisions referred to in pars 1 and 2 shall not be applicable to employees or agents having acted upon instruction of their employer or the ordering party if it would be unreasonable to expect them to refuse the execution of such action because of their economic dependency.

Section 68i

(1) The offences referred to in Section 68h shall be prosecuted only upon request of a person entitled to the use of the protected geographical indication or designation of origin.

(2) The assertion of claims under Section 68f par 2 shall be subject to the provisions of Title XXI of the Code of Criminal Procedure, 1975, Federal Law Gazette No 631. Both parties shall be entitled to appeal against the decision on the claims for compensation.

(3) In criminal proceedings the provisions on the elimination in accordance with Section 68f par 1 of this Federal Act and Section 119 par 2 (exclusion of the public) and Section 149 (publication of the judgement) of the 1970 Patents Act, Federal Law Gazette No 259, shall apply *mutatis mutandis*.

Section 68j

(1) The commercial courts shall be the competent authorities for actions and interim injunctions in accordance with this Chapter irrespective of the value of the matter in dispute.

(2) Jurisdiction in criminal matters in accordance with this Chapter shall be incumbent on the judge sitting alone at the court of the first instance.

Chapter VIII Community trade marks

Section 69

Applications for Community trade marks may be filed at the Patent Office in accordance with Art 25 par 1b of Regulation (EC) No 40/94 on Community trade marks, OJ No L 11, January 1, 1994, page 1, as amended by the Regulation (EC) No

3288/94 for the implementation of agreements concluded in the framework of the Uruguay-Round, OJ No L 349, December 31, 1994, page 83. The Patent Office shall endorse the application with the date of receipt of the latter and shall forward the documents without any verification within the time limit of two weeks as provided for in Art 25 par 2 of this Regulation to the Office for Harmonization in the Internal Market in Alicante (trade marks and designs).

Section 69a

(1) Where the seniority of a trade mark either entered into the Trade mark Register of the Patent Office or enjoying protection in Austria on the basis of an international registration was claimed for a Community trade mark application or a Community trade mark in accordance with Art 34 or 35 of Regulation (EC) No 40/94, and where that trade mark forming the basis of the seniority-claim was taken off the register due to renunciation on the part of its proprietor or in the absence of a renewal in due time, the invalidity of the trade mark may be established a posteriori on the grounds for cancellation provided for in Sections 30 to 34 and Section 66.

(2) Petitions in accordance with par 1 shall be addressed to the registered proprietor of the Community trade mark.

(3) Where the establishment a posteriori of the invalidity of a trade mark in accordance with par 1 is requested in connection with Section 33a, the relevant date shall not be the date the petition was filed as provided for in Section 33a pars 1 and 6, but the date when the taking off the register of the trade mark forming the basis of the seniority claim, due to renunciation on the part of its proprietor or in the absence of a renewal in due time, became effective.

Section 69b

(1) The Patent Office shall decide on the admissibility (Art 108 par 2 of Regulation (EC) No 40/94) of a request for conversion of a Community trade mark application or Community trade mark transmitted in accordance with Art 109 par 3 of Regulation (EC) No 40/94.

(2) Upon request of the Patent Office the applicant shall, within a period of two months, extendable upon request

1. pay the application fee and the class fee (Section 18 par 1, Section 63 par 2),
2. submit the required representations of the trade mark, in the case of sound marks the acoustic presentation of the trade mark on a data carrier in accordance with Section 16 par 2,
3. submit the translation into German of the request for conversion and the attached documents if the request for conversion and the attached documents have not already been submitted in German,
4. indicate an address for service in accordance with Art 110 par 3 lit. c of Regulation (EC) No 40/94 if he is not represented in accordance with Section 61 by an authorised representative or has not nominated a representative for service.

(3) If it appears from the examination that there are objections to the admissibility of the conversion, the applicant shall be requested to comment on them within a period to be determined by the Patent Office. If upon submission of a comment in due time or upon expiry of the period the inadmissibility of the conversion is determined or if

the request in accordance with par 2 was not met, the request for conversion shall be rejected by decision.

Section 69c

(1) The request shall be dealt with like a national trade mark application and be examined for compliance with the law (Section 20) with the exception of the case regulated in par 2.

(2) Where the request for conversion refers to a trade mark that has already been registered as a Community trade mark, the trade mark shall not be examined for compliance with the law (Section 20).

Section 69d

(1) The Community trade mark court of first instance in the meaning of Art 91 par 1 of Regulation (EC) No 40/94 shall be the Commercial Court of Vienna, irrespective of the value of the matter in dispute. In legal matters in which a Community trade mark court is the competent authority for actions the Commercial Court of Vienna shall also have exclusively jurisdiction for interim injunctions.

(2) Jurisdiction in criminal matters in respect of Community trade marks shall belong to the Vienna Provincial Court for Criminal Matters.

Chapter IX

Trade marks in accordance with the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Section 70

(1) A request for conversion of an international registration shall be designated as such and shall show the number of the international registration. In addition, within a period of two months, extendable upon request

1. a certificate of the International Bureau of the World Intellectual Property Organization, in the original or a certified copy, showing the trade mark and the goods and services covered by the protection of the international registration in the territory of the Republic of Austria at the date of cancellation in the international register, and
2. a translation into German of all documents as far as not drafted in German,

shall be submitted. If the request does not meet the conditions listed it shall be rejected by decision.

(2) The request shall be dealt with like a national trade mark application and examined for compliance with the law (Section 20) with the exception of the case regulated in par 3.

(3) Where the request refers to an international registration for which at the date of its cancellation the time limit for the refusal of protection in accordance with Art 5 par 2 of the Protocol already has elapsed unused, the trade mark shall not be examined for compliance with the law (Section 20).

Chapter X

Prohibition of Unauthorized Representation

Section 71

(1) Anyone who in matters relating to the protection of trade marks, without being authorised to represent parties professionally in Austria in such matters, for gain

1. prepares written submissions or documents for use before Austrian or foreign authorities,
2. provides opinions
3. represents parties before Austrian authorities, or
4. offers to perform a service mentioned in subpars 1 to 3,

shall be guilty of unauthorized legal representation and is liable to a fine not exceeding 4 360 € imposed by the district administrative authority.

(2) The representation of a legal person by employees of another legal person having economic connections with the first legal person shall not be considered as unauthorized representation. Other legal entities, with the exception of natural persons, shall be equivalent to legal persons.

(3) The special provisions relating to the treatment of unauthorized legal representation at ordinary courts shall remain unaffected.

Chapter XI

Special fees

Section 72

(1) Contributions to the costs of printing as well as special fees for official copies, publications, certificates and attestations as well as for extracts from the register may be determined by ordinance. In the determination of any fee which shall not exceed 87 €, account shall be taken of the labour and material expenditure required for the official service. In as far as the amount of the fee depends on the number of pages or sheets, Section 166 par 10 of the 1970 Patents Act, Federal Law Gazette No 259, as amended, shall apply mutatis mutandis.

(2) Requests for official publications and requests entailing official publications on the basis of a provision regulating the trade mark right, if consented, shall be refused if the relevant fees or contributions to the costs of printing have not been paid.

Chapter XII

Transitional Provisions

Section 73

The provision of Section 4 par 1 subpar 9 shall be applicable to trade marks filed in good faith prior to January 1, 1996 neither as regards the examination for compliance with the law (Section 20) nor in respect of the cancellation procedure in accordance with Section 33.

Section 74

In respect of claims against the proprietor of a trade mark registered prior to the entering into effect of the Federal Act Federal Law Gazette I, No 111/1999 and existing at that date, the time period of five years stated in Section 32 par 2 shall start with the entering into effect of this Federal Act.

Section 75

(1) As regards petitions for the cancellation of a trade mark in accordance with Section 33 in combination with Sections 1, 3, 4, 7, 60 or 66 filed prior to the entering into effect of the Federal Act Federal Law Gazette I, No 111/1999, these provisions in the version applicable prior to the entering into effect of the Federal Act Federal Law Gazette I, No 111/1999 shall continue to be applied.

(2) Where after the entering into effect of the Federal Act referred to in par 1 a petition for cancellation of a trade mark previously registered is filed in accordance with Section 33, this petition shall no longer be based on Section 33 in combination with Sections 1, 3, 4, 7, 60 or 66 in the version applicable prior to the entering into effect of the Federal Act referred to in par 1, but only on Section 33 in combination with Sections 4, 7 or 66 in the version applicable after the entering into effect of the Federal Act as mentioned in par 1.

Section 76

As regards petitions in accordance with Section 33a, Section 33a in the version applicable prior to the entering into effect of the Federal Act Federal Law Gazette I, No 111/1999 shall continue to be applied as far as the evaluation of the use of a trade mark until January 1, 1994 is concerned.

Section 77

(1) As regards actions entered prior to the entering into effect of the Federal Act Federal Law Gazette I, No 111/1999, the provisions of Chapter III in the version applicable prior to the entering into effect of the Federal Act Federal Law Gazette I, No 111/1999 shall continue to be applied.

(2) In respect of claims against the proprietor of a trade mark registered prior to the entering into effect of the Federal Act Federal Law Gazette I, No 111/1999 or against the user of a sign, the use of which was commenced prior to this date, existing at the time of the entering into effect of the Federal Act Federal Law Gazette I, No 111/1999, the time period of five years stated in Section 58 shall start with the entering into effect of this Federal Act. Any prescription already occurred shall remain unaffected by this provision.

CHAPTER XIII Final Provisions

Section 78

The form chosen in this Federal Act for all designations referring to persons shall equally apply to both sexes.

Section 79

In as far as reference is made in this Federal Act to provisions of other federal laws, the latter shall be applicable in the currently valid versions, unless otherwise indicated.

Section 80

The following shall be responsible for the implementation of this Federal Act:

1. as regards Sections 10, 10a, 10b, 12, 14, 23 and 57 the Federal Minister of Economic Affairs and the Federal Minister of Justice,
2. as regards Section 6 par 2 the Federal Minister of Economic Affairs in agreement with the Federal Minister of Foreign Affairs,
3. as regards Sections 13, 51 to 56, 58 to 60b, Section 67 and Sections 68f to 68j the Federal Minister of Justice,
4. as regards Section 72 par 1 the Federal Minister of Economic Affairs in agreement with the Federal Minister of Finance,
5. as regards all other provisions the Federal Minister of Economic Affairs.

Section 81

(1) Section 18 pars 1, 2 and 4, Section 40 par 1, Sections 42, 61, 69 par 1, Section 70 and the heading of Chapter IX as amended by the Federal Act Federal Law Gazette No 418/1992 shall enter into force as of the beginning of the fourth month following the promulgation of the Federal Act Federal Law Gazette No 418/1992.

(2) Section 4 par 1 subpar 2, Sections 9, 10a, 16 par 2, Section 17 par 4, Sections 18, 22 par 3, Sections 26, 28 par 2, Sections 30, 30a, 31 par 3, Sections 32, 33, 33a pars 3 and 6, Sections 33b, 33c, 37, 42, 60 par 1, Section 62 par 3, Sections 70, 71 and 72 par 1 as amended by the Federal Act Federal Law Gazette No 773/1992 shall enter into force at the same time as the European Economic Area Agreement.

(3) Section 2 par 3, Section 4 par 1 subpar 9, Section 17 par 2 subpar 1, Section 24 par 1 and Chapter VIII with the exception of Section 69d in the version of the Federal Act Federal Law Gazette I, No 111/1999 shall become effective retroactively on January 1, 1996.

(4) Section 17 par 2 subpar 2, Section 18 par 4 and Chapter IX in the version of the Federal Act Federal Law Gazette I, No 111/1999 shall become effective with the entering into force of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks for the territory of the Republic of Austria, Federal Law Gazette III, No 32/1999.

(5) Section 6 par 3, Section 18 pars 1, 2 and 4, Section 19 par 2, Section 28 par 4, Section 40 par 1, Sections 60c and 68 par 2, Section 71 par 1 and Section 72 par 1 in the version of the Federal Act Federal Law Gazette I, No 143/2001 shall become effective on January 1, 2002.

Section 82

Ordinances on the basis of this Federal Act as amended may be enacted at any day following the promulgation of the Federal Act to be implemented; they shall not become effective prior to the entering into force of the provision to be implemented.

