

**Patents Law 1970 (BGBl. no. 259/1970)**  
**as amended by BGBl. nos. 581/1973, 349/1977, 526/1981, 201/1982, 126/1984, 234/1984,**  
**104/1985, 382/1986, 653/1987, 418/1992, 771/1992, 212/1994, 634/1994, 181/1996,**  
**175/1998, 191/1999 and 143/2001**

## **I. GENERAL PROVISIONS**

### **Patentable Inventions**

**Section 1.** (1) Upon application patents shall be granted for inventions which are new (Section 3), which, having regard to the state of art, are not obvious to a person skilled in the art and which are susceptible of industrial application.

(2) The following in particular shall not be regarded as inventions:

1. discoveries, scientific theories, and mathematical methods;
2. aesthetic creations;
3. schemes, rules and methods for performing mental acts, for playing games or for doing business, and programs for computers;
4. presentations of information.

(3) The provisions of subsection (2) shall exclude patenting of the subject matter or activities referred to in that subsection only to the extent to which protection is demanded for them as such

### **Exceptions to Patentability**

**Section 2.** Patents shall not be granted in respect of:

1. inventions the publication or exploitation of which would be contrary to “ordre public” or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by regulations;
2. methods for treatment of humans or animals by surgery or therapy and diagnostic methods practiced on humans or animals; this shall not apply to products, in particular substances or compositions, for use in any of these methods;
3. plant or animal varieties (animal races) or essentially biological processes for the production of plants or animals; these exceptions shall not apply to microorganisms as such nor to microbiological processes and the products obtained by means of such processes.

### **Novelty**

**Section 3.** (1) An invention shall be considered to be novel if it does not form part of the state of art. The state of art shall be held to comprise everything made available to the public by means of a written or oral description, by use or in any other way, before the priority date of the application.

(2) As state of art shall also be considered the contents of earlier priority date

1. patent applications on the basis of this Federal Law,

2. utility model applications on the basis of the Utility Models Act, Federal Law Gazette No 211/1994,

3. international applications in the meaning of section 1, Z 6 of the Act Introducing Patent Treaties, Federal Law Gazette No 52/1979, provided the conditions as set out in section 16, subsection 2 of the Act Introducing Patent Treaties are fulfilled, and

4. European patent applications in the meaning of section 1, Z 4 of the Act Introducing Patent Treaties, provided the conditions of article 79, subsection 2 of the European Patent Convention, Federal Law Gazette No 350/1979, or, where the European patent application was filed on the basis of an international application, the conditions of article 158, subsection 2 of the European Patent Convention are fulfilled,

in the version as originally filed whose contents were not officially published before the priority date of the later application or thereafter. When assessing the question whether the invention is not obvious to the person skilled in the art from the prior art, such applications of an earlier priority date are not taken into consideration.

(3) The patentability of substances or compositions that are comprised in the state of art shall not be excluded by subsections (1) and (2) if these are intended for use in a method referred to in Section 2(2) and unless their use in any of these methods is part of the state of art.

(4) For the application of subsections (1) and (2) a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months prior to the filing of the application and if it was directly or indirectly due to

1. an evident abuse to the prejudice of the applicant or his legal predecessor, or
2. the fact that the applicant or his legal predecessor has displayed the invention at official or officially recognized exhibitions within the meaning of the Convention on International Exhibitions, Federal Law Gazette No. 445/1980, as amended.

(5) Subsection (4)2 shall apply only if the applicant states, when filing the application, that the invention has been displayed at the exhibition and files a certificate of the management of the exhibition within four months after filing. The date of the opening of the exhibition and the date of the first disclosure, unless it is the same date, shall be indicated in such a certificate. A description of the invention provided with an attestation clause of the management of the exhibition shall be attached to such a certificate.

### **Right to a Patent**

**Section 4.** (1) Only the inventor or his successor in title shall have a right to the grant of a patent. Until the contrary is proved the first applicant shall be regarded as the inventor.

(2) Where an improvement or other further modification of an invention which is already protected by a patent or for which a patent has been applied for and is eventually granted is the subject of an application by the patentee of the parent patent or by his successor in title, the patentee or his successor in title may apply either for an independent patent for such improvement or other further modification or for a patent of addition dependent on the parent patent.

(3) Where the industrial application of an invention for which a patent has been applied for entails the full or partial use of an invention which is protected by a patent enjoying the earlier priority date or by a utility model enjoying the earlier priority date as defined by the Utility Models Act, Federal Law Gazette No. 211/1994, as amended from time to time, the owner of

the earlier right may request that a patent be granted on the invention for which an application has been filed with the addendum that it is dependent on the earlier patent or utility model which must be clearly specified (declaration of dependence). Such addendum shall also be included in the publication regarding the grant of the patent and in the letters patent.

**Section 5.** (1) The first applicant shall not, however, be entitled to the grant of a patent where he is not the inventor or his successor in title, or where the essence of his application has been usurped from the descriptions, drawings, models, implements or installations of a third person or from a process used by him and where, in the first case, the inventor or his successor in title or, in the second case, the injured party opposes the grant of the patent.

(2) In the case of several persons who have usurped an invention one after the other, an earlier possessor of the invention shall, in the event of dispute, have priority over a later one.

### **Employees' Inventions**

**Section 6.** (1) Employees shall also be entitled to the grant of a patent (Section 4) for inventions they have made during their employment relationship, unless otherwise provided by contract (Section 7(1)) or in the circumstances of Section 7(2).

(2) "Employees" shall mean salary and wage earners of every kind.

**Section 7.** (1) Agreements between employers and employees under which any future inventions of the employee are to belong to the employer or which grant the employer a right to use such inventions shall be valid only if the invention is a service invention (subsection (3)). To be valid, the agreement must be in writing; this requirement shall be satisfied if the agreement is included in a collective agreement (Article 2(1) of the Law on the Organization of Labor, Federal Law Gazette No. 22/1979, as amended).

(2) Where a person is employed under public law, the employer may, even in the absence of agreement with the employee, claim the service inventions of the latter completely or the right to use such inventions, such right being also binding on third parties. In such cases, the following subsection. Sections 8 to 17 and 19 shall apply *mutatis mutandis*.

(3) A service invention shall be one made by an employee which, by reason of its subject matter, falls within the activities of the enterprise in which the employee works, provided that:

(a) either the activity which has led to the invention forms part of the employee's employment obligations; or

(b) the invention was suggested to the employee by his work in the enterprise; or

(c) the invention was greatly facilitated by the use of the experience or resources of the enterprise.

**Section 8.** (1) An employee shall be entitled to special and fair remuneration in any case where his invention becomes the property of his employer or subject to the employer's right of use.

(2) Where, however, the employee has been appointed expressly to create inventions in the employer's enterprise and where this was in fact his principal activity and where such activity has led to an invention, the employee shall be entitled to special remuneration only to the extent that the higher pay received under the employment contract in view of his inventive activity does not constitute adequate remuneration.

**Section 9.** For the assessment of remuneration (Section 8), the following shall in particular be taken into account:

- (a) the economic importance of the invention for the enterprise;
- (b) any other exploitation of the invention in Austria or abroad;
- (c) the role which the suggestions, experience, preparatory work or resources of the employer's enterprise or service instructions have played in bringing about the invention.

**Section 10.** (1) At the request of one of the parties, the remuneration may subsequently be varied, on an equitable basis, where the circumstances on which the remuneration was assessed have substantially changed. Payments received by the employee on the basis of an earlier assessment shall, however, in no case be refunded. Similarly, payments already made or becoming due on the basis of an earlier assessment may not subsequently be supplemented, except where remuneration is in the form of a non-recurring payment.

(2) The employee may also claim a variation of remuneration where the invention has been transferred by the employer to a third party, if the proceeds obtained by the employer through such transfer are manifestly disproportionate to the remuneration paid by the employer or if the employer continues to participate in the exploitation of the invention and obtains a return manifestly disproportionate to the remuneration paid to the employee.

(3) The request (subsections (1) and (2)) may be made only after one year from the previous assessment of remuneration.

**Section 11.** (1) Where the amount of remuneration (Sections 8 to 10) has been made dependent on the exploitation of the invention by the employer and where the employer fails to work the invention to an extent commensurate with its economic importance for the enterprise, the remuneration shall be assessed as if the employer had worked the invention to an extent commensurate with its economic importance for the enterprise.

(2) The remuneration shall be assessed in the same way where the employer has transferred the invention to a third party or has otherwise alienated it, unless the employee has given his consent to such transfer or alienation and fails to prove that such transfer or alienation was only a pretense.

(3) The employer shall be released from the obligation under subsection (1) to pay remuneration if he undertakes to assign the right to the use of the invention to a third party to be designated by the employee. The third party benefiting from such right shall compensate the employer for his share in the invention assessed on the basis of Section 9(c). A variation of such compensation may be applied for subsequently in accordance with Section 10.

(4) The claim (subsections (1) and (2)) may not be made if the employer, with due regard to the circumstances of the case, cannot be expected to work the invention at all or to a greater extent than he has done or could be expected to do had there been no transfer or other alienation. Where, however, the employer derives an advantage from the invention without working it, fair remuneration shall be payable to the employee.

**Section 12.** (1) In the case of an agreement under which future inventions of the employee are to belong to the employer (Section 7), the employee shall immediately notify the employer of every invention that he makes other than those which clearly are not covered by the terms of the agreement. The employer shall, within four months of receiving such notification, inform the employee whether he claims the invention on the basis of the agreement as a service invention.

(2) Where the employee fails to make such notification, he shall be liable to the employer, without prejudice to the employer's right to the invention, for damages in respect of the loss, which shall also include loss of earnings. Where the employer fails to claim the invention or expressly does not claim it, the invention shall belong to the employee.

**Section 13.** (1) The employer and the employee shall be under an obligation of secrecy with regard to inventions which are the subject of the notification and claim referred to in Section 12 (1).

(2) The employee's obligation of secrecy shall lapse where:

(a) the employer has failed to make the claim provided for in Section 12(1) or expressly makes no claim within the period prescribed; or

(b) the employer has claimed the invention in time (Section 12(1)) and has waived secrecy.

(3) The lapse of the obligation of secrecy in accordance with the above provision shall not affect any obligation of secrecy which may otherwise be incumbent on the employee.

(4) The employer's obligation of secrecy shall lapse where he has claimed the invention in time (Section 12(1)) and the employee has not opposed that claim.

(5) The obligation of secrecy shall not preclude the employer and the employee from applying for a patent or from taking other steps to protect their rights.

(6) Any employer or employee violating the obligation of secrecy shall be liable to remedy the loss sustained by the other party, including loss of earnings.

**Section 14.** Where an employer who has paid remuneration to an employee for a service invention finds that not this one, but another of his employees had in fact made the invention or that another of his employees had contributed to the invention the employer shall be under no obligation to pay the remuneration to the rightful claimant—either in its entirety or in proportion to the rightful claimant's share in the invention, provided that the employer has made payment in good faith and that the invention also belongs to him under his legal relationship with the rightful claimant.

**Section 15.** (1) Where an employer has made an agreement with an employee in respect of a service invention, he may at any time wholly or partially waive his rights to the invention. In such case, the employee may request the assignment to him of the rights to the invention that have been waived.

(2) Where the employer waives the whole of his rights to an invention, the obligation to pay remuneration shall cease from the moment that the waiver is made. In the event of partial waiver, the employer may request a corresponding reduction of the remuneration to the extent that the rights assigned to the employee are capable of being assessed separately.

(3) The obligation to pay remuneration in respect of the period preceding the waiver shall remain unaffected.

**Section 16.** The rights of the employer and employee arising from Sections 6 to 15 shall not be affected by the termination of employment.

**Section 17.** The employee's rights under Sections 6 to 16 may not be withdrawn or restricted by agreement.

**Section 18.** In the case of an employment relationship arising from a private contract, the Labour Courts shall have jurisdiction over disputes based on Sections 7 to 17 between employers and employees or between employees.

**Section 19.** Claims of employers and employees under Sections 7 to 15 shall be statutebarred after three years.

### **Right to be Named as Inventor**

**Section 20.** (1) The inventor shall be entitled to be named as the inventor.

(2) The right may not be transferred or inherited. Renunciation of the right shall have no legal effect.

(3) The inventor shall be named on request by entry of his name in the Patent Register, in the official publication of the application (invitation for opposition, Section 101), in the letters patent, in the announcement of the grant of the patent and in the patent document (Section 109). Where the letters patent have already been issued or where the publications referred to have already been made, a special certificate naming the inventor shall be issued or a special notice shall be published in the Patent Gazette. The inventor's name shall also be included in any documents certifying priority issued by the Patent Office.

(4) The request may be made by the inventor, as well as by the applicant, or the patentee. Where several persons are entitled to make the request the party making the request shall produce proof that the other persons entitled agree, unless the request is made jointly by all those entitled. Where a person other than the one already named as inventor is to be named as such in addition or in place of the person so named, proof of the consent of the person already named shall also be produced.

(5) Where the applicant, patentee or person already named as inventor refuses his consent, the right shall be enforced by submitting a request to the Patent Office within the periods set out below, on pain of inadmissibility:

(a) for claims against the applicant or patentee, within one year of the announcement of the grant of the patent in the Patent Gazette (Section 109); or, where the inventor has assigned the patent, for claims against the assignee, within one year from the Patent Office's receipt of the petition for assignment (Section 43);

(b) for claims against the person already named as inventor, within one year of the publication of that person's name as inventor (subsection (3)).

(6) The petition (subsection (5)) shall be dealt with in accordance with the procedural rules relating to the contesting of patents. The grant of the patent shall not be suspended by the fact that proceedings regarding such petition are pending. Where a final decision allowing the petition has been given, action under subsection (3) shall be taken at the rightful claimant's request.

### **Representatives**

**Section 21.** (1) Anyone acting as a representative before the Patent Office or before the Supreme Patent and Trademark Chamber shall have his residence or place of business in Austria: however, professional laws and regulations shall apply to attorneys at law, patent attorneys and notaries. The representative shall prove his authorization by producing the original written power of attorney or a certified true copy thereof. A separate power of attorney shall be presented for each patent application. The same shall apply if a

representative is empowered with respect to a patent already granted. If a power of attorney has been granted to a plurality of persons, each may solely act as a representative.

(2) If an attorney at law, patent attorney or notary acts as a representative, he may refer to the authorization granted to him without actually presenting documentary evidence. However, an authorization to assign a patent shall in any case be proved by a written power of attorney which has to be duly certified.

(3) If a representative acts without a power of attorney or, in the event of subsec. (2), without referring to the authorization granted to him, the action in the proceedings taken by him shall be valid only on condition that he submits a proper power of attorney or refers to the authorization granted to him within the reasonable time limit prescribed therefor.

(4) Anyone having neither residence nor place of business in Austria may claim rights under this Federal Act before the Patent Office and before the Supreme Patent and Trademark Chamber only if he is represented by a representative as defined in Sec. 77; this shall not apply to the use of customer and information services of the Patent Office including expert opinions and searches.

(5) The place in which the representative has his Austrian residence or his Austrian place of business and in the absence of a representative with an Austrian residence or Austrian place of business the place in which the Patent Office is established shall, in matters concerning the patent, be deemed the residence or place of business of a patentee having neither his residence nor place of business in Austria.

(6) The authorization granted to an attorney at law, patent attorney or notary to act as a representative before the Patent Office shall empower him by law to exercise all rights under this Federal Act before the Patent Office and before the Supreme Patent and Trademark Chamber, in particular to file patent applications, restrict or withdraw applications, file opposition, waive patents, file and withdraw petitions or appeals to be dealt with by the Nullity Division, conclude compromises, accept service of documents of any kind and receive payment of official fees and of the cost of proceedings and representation from the adverse party and appoint an agent.

(7) The authorization pursuant to subsec. 6 may be limited to a particular right and to representation in particular proceedings. However, it shall not expire on the death of the principal or as a result of a change in his legal capacity.

(8) If a representative other than an attorney at law, patent attorney or notary is to have also the power to waive, in whole or in part, a patent granted, he must be expressly authorized to do so.

### **Effect of a Patent**

**Section 22.** (1) The Patent shall entitle the patentee to exclude others from the latter , to industrially produce the subject of the invention, put it on the market, offer it for sale or to work it or import or possess it for the purposes as stated.

(2) If the patent has been granted for a process, it shall be effective also in respect of the products manufactured directly by that process.

**Section 22a.** The extent of the protection conferred by a patent and a published application (Section 101 (2)) shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims. For this purpose the Protocol on the Interpretation of Article 69 of the European Patent Convention. Federal Law Gazette No. 350/1979 as amended shall apply mutatis mutandis.

**Section 23.** (1) A patent shall not be effective against a person who, at the time of filing, had already begun, in good faith, to use the invention in Austria or had made the necessary arrangements for doing so (prior user).

(2) A prior user may work the invention for the needs of his own business in his workshops or in those of others.

(3) The right may be inherited or transferred only together with the business.

(4) The prior user may request a document from the patentee recognizing his right. If such recognition is refused, the Patent Office shall, on request, determine the claim in accordance with the procedure relating to the challenging of patents. Recognition of the right shall be entered in the Patent Register at the request of the claimant.

**Section 26.** A patent shall have no effect in the case of vehicles and fittings of vehicles which enter Austria only temporarily in the course of their use in traffic.

### **Relationship of Co-Patentees**

**Section 27.** (1) A patent applied for by several persons as participants in the same invention shall be granted without any determination of each person's share.

(2) The legal relationship of the co-patentees shall be governed by civil law.

(3) The right to permit third persons to work the invention shall in case of doubt be exercised only by all the co-patentees jointly. Each co-patentee may however, bring proceedings for infringement.

### **Term of the Patent**

**Section 28.** (1) The maximum term of a patent shall be twenty years as from the date of application.

(2) Patents of addition shall expire together with the parent patent. A patent of addition may, however, be expressly maintained as an independent patent where the parent patent is revoked, annulled or waived. In respect of the term, the expiry date and the amount of annual fees payable, a patent of addition that has become independent shall replace the parent patent.

### **Patentee's Obligation to Comply with the Legal Provisions**

**Section 30.** A patent shall not release the patentee from the obligation to comply with the legal provisions.

**Section 31.** (1) Any applicant or his successor in title may work an invention commercially from the day when his application is published in the Patent Gazette (Section 101(1)) according to the scope of protection apparent from the application as laid open for public inspection (Section 101(3)); he shall not be bound by the regulations requiring trade licenses. The privilege shall cover the production, the marketing and offering for sale of the subject of the invention. Where the subject of the invention is a process, the privilege shall also cover the use of that process.

(2) Where there are several applicants for a patent, the privilege shall be enjoyed only by those who are entitled to not less than one-fourth of the rights arising from the application.



(3) Where the privilege is claimed by a person at a time when the rights arising from the application are shared by not more than four persons, it shall be assumed, until proved otherwise, that such person fulfills the requirement in subsection (2).

(4) Subsections (2) and (3) shall apply mutatis mutandis where a patent is granted to several patentees. Section 27(2) shall not be affected.

(5) Where the application has been withdrawn, rejected or is deemed under Section 166 (6) to be withdrawn, or where a patent is declared null and void or the patentee is declared to have no title, the invention may thenceforth be commercially worked only on the basis of the trade license for the activity concerned. The same shall apply—for any commercial exploitation no longer covered by the patent rights—where the patent rights have been limited, as compared with the application laid open for public inspection (Section 101(3)), or where there has been a declaration of partial nullity or partial lack of title. Where, however, the patent has expired (Section 46) or has been revoked (Section 47), the privilege under subsection (1) shall continue provided that it had already been claimed at the time of expiry or revocation.

**Section 32.** (1) Any person desiring to exercise the privilege under Section 31(1) shall inform the district administrative authority within whose jurisdiction the privilege is to be exercised not later than on the date when working of the invention begins.

(2) When providing that information, the person applying for a patent or the patentee shall state his place of residence, his nationality and the place where the invention is to be worked.

(3) If the invention is begun to be worked before the grant of a patent, information thereon must be accompanied by a copy of the Patent Gazette containing the patent application and a photocopy of the application as laid open for public inspection (Section 101(3)). Where the invention is worked by a successor in title to the applicant appearing in the Patent Gazette, proof of such title shall be produced, too. Where a patent is subsequently granted, the printed copy of the patent document (Patentschrift) shall be submitted to the district administrative authority within one month of its issue.

(4) Where, after information has been provided under subsection (1), the application for a patent is withdrawn, rejected or deemed withdrawn (Section 166(6)), the competent district administrative authority shall be notified within one month after publication in the Patent Gazette.

(5) If working of the invention is not begun until after the grant of the patent, information under subsection (1) shall be accompanied by the printed copy of the patent document and an extract from the Register less than one month old (Section 80(6)).

(6) A declaration of nullity or lack of title in relation to a patent for an invention the working of which was communicated under subsection (1) shall be notified to the district administrative authority within one month after the relevant decision has become final. Where a declaration of partial nullity or partial lack of title is made, a certified copy of such decision shall also be submitted.

(7) Information under subsection (4) or (6) shall be provided by anyone working the invention at the time when the events referred to in subsection (4) or (6) occur.

(8) Persons who cease operations under the privilege provided for in Section 31 shall inform the competent district administrative authority thereof within one month.

(9) Persons failing to provide information under subsections (1), (4), (6) or (8) in time shall be guilty of an administrative offense and shall be punished by the district administrative authority by a fine not exceeding 3,000 schillings or with detention for a term not exceeding two weeks.

### **Transfer**

**Section 33.** (1) The right arising from a patent application and the patent right shall be inheritable. Such rights shall not pass to the State.

(2) Both rights may be transferred to others, either wholly or in imaginary shares, by a legal act, by a court order or by a transfer pro mortis causa.

(3) Where the right arising from a patent application is transferred, the patent shall, if granted, be issued to the applicant's successor in title. Section 43(5) to (7) shall apply mutatis mutandis.

### **Liens**

**Section 34.** The right to a patent may be subject to a lien.

### **Voluntary Licenses**

**Section 35.** The patentee may permit third parties to work the invention in all the territory covered by the patent or part thereof. Such right (license) may or may not be made exclusive.

### **Compulsory Licenses**

**Section 36.** (1) If a patented invention cannot be worked without infringing an invention patented earlier (older patent), the holder of the later patent may apply for a non-exclusive license to work the earlier patent if the invention protected by the later patent involves an important technical advance of considerable economic significance. If a license is granted, also the holder of the earlier patent may apply for a non-exclusive license to work the later patent.

(2) Where a patented invention is not worked to a reasonable extent in Austria, the working being possible also by imports, and where the patentee has not taken all steps required for such working, any person may apply for a non-exclusive license to work the patent for the purposes of his business, unless the patentee proves that the invention could not reasonably have been worked, or could not reasonably worked to a greater extent, in Austria owing to the difficulties of exploitation.

(3) If a license for a patented invention is required in the public interest, any person may apply for a non-exclusive license to work the invention for the purposes of his business. The respective title of the federal administrative authorities, however, shall not be bound to a business.

(4) If the person entitled to grant a license in accordance with subsections 1 to 3 refuses to do so although the applicant for the license has made efforts to obtain within a reasonable period of time on reasonable, commercial terms and conditions, the Patent Office shall at the request of the applicant for the license decide the matter under the procedure relating to the contesting of patents. If a license is granted, an adequate remuneration shall be fixed, taking into account the economic value of the license. The security which may be required and any other terms governing use shall be fixed having regard to the nature of the invention and the circumstances of the case. The scope and duration of the license in accordance with

subsections 1 to 3 shall be authorised predominantly for the supply of the domestic market and shall be limited to the purpose requiring the license. In the case of semiconductor technology the license shall only be granted for public noncommercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive.

(5) A license in accordance with subsection 2 may not be applied for until four years after the filing of the application, or three years after the publication of the grant relating to the patent for which the license is sought, whichever period expires last.

(6) The requirement to obtain the authorization of the person entitled to grant a license can be waived in the case of subsection 3 in the case of national emergency or other circumstances of extreme urgency. In this case a temporary permission for the use of the invention shall be granted by an interim decision.

(7) A license granted in accordance with subsection 4 shall be canceled upon request subject to adequate protection of the legitimate interests of the entitled person, if and when the circumstances having brought about such permission have ceased to exist and are unlikely to crop up again. The Patent Office shall decide on request under the procedure relating to the contesting.

### **Transfer of a License**

**Section 37.** Licenses in accordance with section 35 and 36 (2 and 3) and to work the later patent in accordance with section 36 (1) may not, without the consent of the patentee, be transferred inter vivos except with the part of the business or commercial enterprise entitled to the license and shall not pass on death to the licensee's successor in title unless he continues the part of the business or commercial enterprise entitled to the license. A license granted in accordance with section 36 (1) to work the earlier patent may not be transferred except with the later patent.

### **Entry in the Patent Register**

**Section 43.** (1) A patent right (Section 33), a lien and other rights in rem relating to a patent shall be acquired by entry in the Patent Register and shall be binding on third parties.

(2) The date of acquisition of license rights shall be governed by civil law. License rights shall be binding on third parties only on their entry in the Patent Register.

(3) The order of priority of the rights referred to shall be determined by the order in which applications for entry have reached the Patent Office, provided that such applications lead to entry.

(4) Applications received at the same time shall have the same priority.

(5) Entries in the Patent Register under subsections (1) and (2) and the entry of the lapse of patent rights entered in the Patent Register shall be made at the request in writing by one of the parties or at the request of the courts.

(6) A request for such entry shall be accompanied by the original or a duly certified copy of the document on which the entry is to be based. A document other than a public document shall bear the duly certified signature of the person alienating his right.

(7) The request for entry and the document shall be examined by the Patent Office as to form and substance.

## **Charges**

**Section 44.** Any person acquiring a patent shall assume the charges encumbering it which have been entered in the Patent Register, or duly filed for entry, at the time when the petition for entry is submitted to the Patent Office.

## **Entries Relating to Disputes**

**Section 45.** (1) Disputes pending before the courts regarding the ownership of patents, liens or other rights in rem relating to a patent, disputes concerning a claim to be named as inventor (Section 20(5) and (6)), a right for prior user (Section 23) and the grant of compulsory licenses (Section 36), disputes concerning revocation (Section 47), a declaration of nullity (Section 48), a declaration of lack of title (Section 49) and a declaration of dependence (Section 50) shall, on request, be recorded in the Patent Register (entry relating to disputes).

(2) The effect of entry of a dispute shall be to render the decision fully effective against those parties whose own entry in the Patent Register was effected after the Patent Office had received the petition for entry of the dispute.

## **Expiry**

**Section 46.** (1) A patent shall expire:

1. no later than at the end of the maximum term, where the annual fees are paid in time;
2. where an annual fee is not paid in time;
3. where the patentee waives the patent.

(2) Where the waiver relates only to certain parts of the patent, the patent shall remain valid with regard to the other parts, provided that these parts may still constitute the subject of an independent patent.

(3) In the event of subsection (1)1 the patent shall expire on the day following the end of the maximum term, in the event of subsection (1)2 on the day following the end of the last year of validity and in the event of subsection (1)3 on the day following notification of waiver to the Patent Office.

## **Revocation**

**Section 47.** (1) A patent may be revoked in whole or in part if the grant of compulsory licenses (Section 36 (2) has not sufficed to secure the working of the invention in Austria to an appropriate extent. Revocation shall take effect as soon as the corresponding decision becomes final.

(2) Revocation may not be ordered until two years have elapsed since the grant of a compulsory license became effective. A patent may not be revoked if the patentee shows that, owing to the difficulties of exploitation, he cannot reasonably work the invention in Austria or have it worked at all or to a greater extent than it had been worked.

## **Declaration of Nullity**

**Section 48.** (1) A patent shall be declared null and void if:

1. the subject of the patent was not patentable under Sections 1 to 3;
  2. the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
  3. the microorganism deposited according to Section 87a(2)I has not been permanently accessible at the original depositary institution as defined by the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure dated April 28, 1977, Federal Law Gazette No. 104/1984 as amended (Budapest Treaty) or at another depositary institution to which it has been passed on according to that Treaty unless the patentee proves
    - (a) that he has deposited the microorganism again and that such deposit is deemed, under Art. 4 of that Treaty, to have been made on the day of the original deposit, or
    - (b) that he was prevented from such a new deposit by an unforeseeable or unavoidable event and that he has made such a deposit within two months after the obstacle ceased to exist.
- (2) Where the grounds for nullity apply only in part, the declaration of nullity shall take the form of a corresponding limitation of the patent.
- (3) The final declaration of nullity shall be retroactive to the date the patent was filed in the cases of subsection (1)1 and 2 and in the case of subsection (1)3 to the date on which the depositary institution noticed for the first time that it is not capable of delivering samples of the microorganism. If the subject of the patent was not patentable pursuant to Sec. 3(2), rights under a license lawfully granted by the later applicant and acquired in good faith by third parties which have been registered in the patent register for one year shall, however, provided that they are not the subject of a legally founded entry relating to a dispute (Sec. 45), be unaffected by such retroactive effect, without prejudice to any claims for compensation which may be made against the later applicant.

### **Declaration of Lack of Title**

**Section 49.** (1) A patentee shall be declared to lack title if it is proved:

1. that the patentee was not entitled to the grant of the patent (Sections 4(1), 6 and 7);
  2. that the essence of the application had been usurped from the descriptions, drawings, models, implements or installations of a third person or from a process used by him.
- (2) Where one of the conditions referred to (subsection (1)1 and 2) applies only in part, the patentee shall be declared only partially lacking in title.
- (3) In the first case, only the person entitled to the grant of the patent shall have a right to a declaration of lack of title: in the second case, only the injured person. A claim against a bona fide patentee shall become statutebarred after three years from the entry of the patent in the Patent Register.
- (4) Claims to compensation and reimbursement arising from a declaration of lack of title shall be governed by the civil law and be the object of civil proceedings.
- (5) Where the applicant's claim is allowed, he may, within one month of the decision becoming final, request assignment of the patent to himself.

(6) Failure to request such assignment in time shall be regarded as equivalent to waiver of the patent.

(7) In the case of such assignment rights under a license lawfully granted by the earlier patentee and acquired in good faith by third parties which have been on the Patent Register for one year shall, provided that they are not the subject of a legally founded entry relating to a dispute (Section 45), be binding also on the new patentee, without prejudice to any claims for compensation which may be made against the earlier patentee.

### **Declaration of Dependence**

**Section 50.** The owner of a patent of an earlier priority date or of a utility model of an earlier priority date within the meaning of the Utility Models Act. Federal Law Gazette No. 211/1994, as amended, may apply to the Patent Office for a decree that the commercial use of a patented invention entails the full or partial use of his invention, Such application shall be dealt with by the Patent Office under the procedure relating to disputes as to title.

### **Right of Retaliation**

**Section 51.** Retaliatory measures may be provided for by order of the Federal Government against citizens of a foreign State which accords no protection or incomplete protection to the inventions of Austrian citizens.

### **Time Limits**

**Section 52.** (1) Where a time limit is not prescribed by law or statutory order, the authority shall lay down such time limit having regard to the requirements and the nature of each case unless the President of the Patent Office has issued provisions on the time limits concerned (Section 99(6), second sentence).

(2) The time limits laid down by law or statutory order may not, unless provided otherwise, be extended. The time limits laid down by authority may be extended.

**Section 53.** (1) Time shall begin to run from the event which is determined by law or statutory order as the starting point, or unless otherwise provided when the time limit was fixed, from the date when the decision or order fixing the time limit was served on the party or, where the decision or order was not served but published, from the date of publication.

(2) Where a time limit is expressed as a number of days, the day of the event, the service or the publication which has been fixed as the starting point shall not be counted.

(3) Where a time limit is expressed in weeks, months or years, it shall end with the end of the day of the last week or the last month which in name or number corresponds to the date on which time began to run. Where there is no such day in the last month, the period shall end at the end of the last day of that month.

**Section 54.** (1) The beginning and the running of the period shall be unaffected by Sundays and holidays.

(2) If the end of a period falls on a Sunday or holiday or on a working day on which the mail reception center of the Patent Office is closed, the next working day shall be deemed to be the last day of the period.

(3) In the case of submissions posted in Austria, the days during which such documents are in the post shall not be counted for the purposes of the time limit. This shall not apply in

cases where the day of receipt of the submission by the Patent Office is the operative date (Sections 102(1) and 129(3)).

**Section 55.** Where different time limits are laid down for one and the same action to be taken by several persons concerned in the same case, the action may be taken by any one of those persons as long as the time limit laid down for one of them has not expired.

**Section 56.** Where a submission comprises several industrial property rights (patents, marks, industrial designs) or several applications relating to such rights, separate submissions may be asked for in respect of each or some of those rights (applications) in question, a time limit being set for filing. The separate submissions shall, if they have been received in time, be deemed to have been received on the day on which the original submission was received. Section 163(4) shall remain unaffected.

## **II. PATENT AUTHORITIES AND PATENT INSTITUTIONS**

### **Scope of the Patent Office's Activity**

**Section 57.** (1) The Patent Office shall be responsible for the grant and revocation of patents, for declarations of nullity or lack of title, for declarations of dependence of patents, for decisions on naming a person as inventor (Section 20), for decisions on the existence of a right of prior user (Section 23), for the grant of licenses (Section 36), for decisions on applications for a declaration under Section 163 as well as the rendering of services and giving of information in the field of protection of industrial property (Section 57a, 57b), and for all entries in the Patent Register.

(2) In the interest of international cooperation in the field of the protection of industrial property an agreement may be entered into that the Patent Office will give to states or international governmental or non-governmental organisations dealing with matters in the above-mentioned field technical or legal assistance free of charge or for adequate compensation for expenses. Gratuitousness may be agreed on only if such assistance is in the public interest, is given for purposes of development aid or involves only petty expenses.

### **Services Rendered and Information Given by the Patent Office**

**Section 57a.** The Patent Office shall, upon request, furnish expert opinions in writing

1. on the state of art concerning a concrete technical problem (searches) and
2. on the fact if there is an invention patentable according to the provisions of Sections 1 to 3 as compared with the state of art cited by the applicant or to be searched by the Patent Office.

**Section 57b.** (1) The Patent Office shall extend its customer and information services and in this connection shall in particular open its documentation in order to make it more accessible and shall furnish to the public improved information in all relevant areas.

(2) The fee for the customer and information services permanently offered by the Patent Office shall be promulgated in the Patent Gazette. The fee for customer and information services which are not permanently offered shall be fixed from time to time. The amount of the fee shall depend on the work and material required. In cases in which the service is predominantly in the public interest a lower fee or no fee at all can be fixed.

### **Location and Composition of the Patent Office**

**Section 58.** (1) The Patent Office shall be located in Vienna. It shall constitute an externally independent office as far as its conduct of business is concerned.

(2) The Patent Office shall consist of the President, his deputies (Vicepresidents) and the required number of legally qualified and technically qualified members just as other employees for the fulfilment of his tasks.

(3) There shall be both permanent and temporary members.

(4) The President and his deputies shall possess the qualifications prescribed for permanent members of the Patent Office, at least one of them possessing the qualifications of a legally qualified member and one those of a technically qualified member.

(5) The President, his deputies and the permanent members shall be salaried federal civil servants.

(6) The President, his deputies and the members of the Patent Office shall be appointed by the President of the Federal Republic.

(7) The President shall be in charge of the Patent Office. In addition to the tasks conferred on him by this Act, he shall direct the Office's activities and supervise the staff.

(8) The President of the Patent Office shall also be responsible for the industrial property service of the Federal Ministry of Commerce, Trade and Industry.

**Section 58.a**(1) The Patent Office shall be a legal personality (partial legal capacity) insofar as it is entitled to acquire property and rights in the field of the protection of industrial property by the following customer and information services:

1. written information an information by electronic data carriers and media on data referring to filed and registered industrial property rights,
2. statistical evaluations of data in the field the protection of industrial property,
3. assistance with search on the state of art and the preparation of expert opinions on the patentability of inventions for countries or international governmental or nongovernmental organisations engaged in tasks in the field of the protection in industrial property, in particular mediation, distribution, preparation, and execution,
4. assistance with search concerning property rights, in particular mediation, distribution, preparation, and execution,
5. written information and information by electronic data carriers and media within the scope of procedures for the filing of trade marks, or on the basis of special petitions as to whether a specific sign corresponds to, or possibly resembles filed or registered trade marks ("similarity search"),
6. translation of lists of goods and services for the international registration of trade marks,
7. classification of figurative elements of trade marks for national or international governmental or nongovernmental organisations, engaged in tasks in the field of the protection of industrial property,
8. distribution of information and information services of national or international governmental or nongovernmental organisations engaged in tasks in the field of the protection of industrial property,



9. production, publication, distribution, and mediation of printed matter, software and pre-recorded audio, video and data carriers as well as,

10. exhibitions, seminars, and similar events.

(2) The President of the Patent Office shall designate by decree, the customer and information services to be rendered by the Patent Office in accordance with subsection 1 within the scope of its partial legal capacity. On this occasion care shall be taken of the suitability of the individual customer and information service for being rendered within the scope of the partial legal capacity, and of avoiding any violation of interests of concealment worth of protection.

(3) Within the scope of its partial legal capacity the Patent Office shall also be entitled to:

1. to assign activities pursuant to subsection 2, accounting and the administration of property, personnel and inventory administration within the scope of partial legal capacity as well as auxiliary activities within the scope of the administration of the Patent Office to third parties, in particular also to federal administrative agencies, against reimbursement of expenses out of the property of the partial legal capacity.

2. to enter into legal transactions in connection with the activities pursuant to Z 1, and

3. to become, with the consent of the Federal Minister of Economic Affairs, a member of associations, other legal persons or intergovernmental organisations if this is in the interest of promoting the protection of industrial property.

(4) The Patent Office shall be entitled to make use of the property and the rights it has acquired within the scope of its partial legal capacity to perform its duties. The Federal Republic shall not be liable for any obligations incurred as a result of the activity of the Patent Office within the scope of its partial legal capacity.

**Section 58b.** (1) As far as the Patent Office acts within the scope of Sec. 58a, it shall exercise the care of a prudent businessman. The annual statement of accounts shall be presented to the Federal Minister of Economic Affairs as well as to the Federal Minister of Finance. Moreover, the Federal Minister of Economic Affairs shall be entitled to inspect the books and accounts at any time.

(2) The Federal Minister of Economic Affairs shall be entitled to examine the books and accounts resulting from the partial legal capacity for their compliance with the legal provisions in force and for the correctness of the figures.

(3) The Employees' Act, Federal Law Gazette No. 292/1921, as amended shall apply to the employment contracts entered into by the Patent Office within the scope of its partial legal capacity.

(4) The rules and regulations on the exercises of trades shall not apply to the activities of the Patent Office within the scope of Sec. 58a.

**Section 59.** (1) The legally qualified temporary members shall have completed studies in law and political science and shall have held, for not less than five years, a position for which completion of such studies was required. In addition, they shall have engaged in scientific or practical work in the field of the protection of industrial property.

(2) The technically qualified temporary members shall have completed studies at a technical university or studies in natural sciences at the philosophy faculty of a university,

and shall have held, for not less than five years, a position for which completion of such studies was required. In addition, they must have special knowledge of a particular technological subject.

(3) Only Austrian citizens of moral integrity and having full legal capacity may be appointed as temporary members. For the duration of their membership, they shall have the title of "Counsellor to the Patent Office" (Rat des Patentamtes).

(4) The temporary members shall be appointed for a period of five years; they may be reappointed. The appointment shall in no case prevent voluntary withdrawal on permanent retirement.

(5) A temporary member shall cease to hold office if he loses Austrian citizenship, if his legal capacity is restricted or, if, as a result of a willfully committed indictable act, he is condemned to more than one year's imprisonment, or if he is convicted of an indictable offense committed with a view to enrichment.

(6) Temporary members who are not civil servants shall take the following oath before the President prior to exercising their duties; "I solemnly promise that I shall perform my duties conscientiously and impartially and that I shall observe secrecy on anything that may come to my knowledge in the course of my official duties;". This oath shall be signed. Where an official is reappointed, it shall be sufficient to remind him of the oath he has taken.

(7) The temporary members shall receive special-duty pay, in accordance with their assignment;

(a) rapporteurs (joint rapporteurs) shall receive from 8 to 40 percent; and

(b) assessors shall receive from 4 to 15 percent of the monthly salary of a federal civil servant in active service in salary step 1 of service grade VIII of the General Administration whenever they are called upon to serve. Special duty pay shall be determined by the President of the Patent Office for all cases completed in one calendar year, with due regard to the time and labor required for each case.

(8) A temporary member shall be asked to serve only where in a particular case no permanent member is available for the subject in question or where his inclusion appears necessary having regard to the special nature of the case, the speed with which it has to be settled or the burden of work on the permanent member concerned.

### **Institutions of the Patent Office**

**Section 60.** (1) The Patent Office shall have:

(a) Technical Divisions and at least one Legal Division,

(b) at least one Appeal Division,

(c) at least one Nullity Division,

(d) at least one President's Division,

(e) a library,

(f) a book-keeping department.

(2) The number of the Divisions listed in subsection (1) shall be determined by the President in accordance with existing requirements.

(3) Without prejudice to the duties assigned to these Sections in other provisions.

(a) the Technical Division shall be responsible for the procedure for the grant of patents and for the giving of expert opinions in writing under Section 57a, and the Legal Division for matters relating to the assignment of the right arising from an application, to other forms of alienation of such right, to patents granted, and to petitions for restoration of rights, to the extent that the Appeal or Nullity Division is not responsible;

(b) the Appeal Division shall be responsible for the appeals procedure (Section 70 and 108);

(c) the Nullity Division shall be responsible for petitions for revocation, for a declaration of nullity or lack of title, for a declaration of dependence of patents (Section 50), for the naming of a person as inventor under Section 20(5), for recognition of the right of prior user (Section 23), for a declaration under Section 163, and for the grant of compulsory licenses;

**(d) the President's Division shall be responsible for matters reserved to the President and all matters not falling within the competence of another division.**

(4) For the discharge of the Patent Office's functions the President shall, moreover, establish the necessary administrative offices.

(5) The President may put an administrative offices directorate in charge of administrative offices.

**Section 61.** (1) The President shall subdivide the whole field of technology into classes of patents; if required, further subdivisions shall be made. He shall assign the various classes or subdivisions to the Technical Divisions in accordance with existing requirements.

(2) The President shall establish the various Divisions for every year in advance. In the course of any one year, the composition of Divisions may be altered only for important reasons, such as a change in the establishment, leave, illness, excessive work load or insufficient occupation of particular members.

(3) The Technical Divisions shall consist of technically qualified permanent members and the Legal Divisions shall consist of legally qualified permanent members. The Appeal and the Nullity Divisions shall consist of legally qualified and technically qualified members. The members of the Technical Divisions and Legal Divisions may be required to act at the same time in the Appeal and the Nullity Divisions.

(4) The President shall appoint a Division head from among the members of each Technical Division, Legal Division and President's Division to direct and supervise their activities; he shall also appoint the requisite number of chairmen from among the permanent members of the Appeal and the Nullity Divisions and make arrangements for others to act as their deputies. The President and his deputies shall be members of the Appeal Division and, if they are legally qualified members, also of the Nullity Division, as chairmen.

(5) A legally qualified member shall be assigned to every Technical Division for participation in joint decisions and for the submission of opinions (Section 62(4)). This legally qualified member may be assigned simultaneously to several Technical Divisions.

**“(6) The elocation of activities in the Technical Divisions and the Legal Divisions shall be determined by the head of the respective division.**

(7) In the Appeal and the Nullity Divisions the various cases shall be assigned to the chairmen by the President. In this connection, the work load and, in the case of the technically qualified chairmen, also the particular technical subject shall be taken into account.

### **Decisions in the Divisions**

**Section 62.** (1) Decisions and orders within the purview of the Technical Division shall be the responsibility of the competent technically qualified member (examiner), unless otherwise provided in subsections (3) and (4).

(2) Decisions and all orders in matters of patent protection falling within the purview of the Legal Division shall be the responsibility of the member assigned to the Technical Division (Section 61(5)) whose patent classes or subdivisions comprise the patent or the application in question (Section 61(1)). Where such matters relate to several patents (patent applications), the member responsible shall be the one responsible under Section 61(6) for the patent first mentioned in the submission concerned or for the patent application mentioned first.

(3) The rejection in whole or in part of an application (Section 100), the grant of a patent after opposition (Section 104), and the imposition of a disciplinary penalty (Section 83) shall be decided by three members of the Technical Division, two of whom shall be technically qualified members. This board (Senat) shall also consist of the Division head and the examiner. The Division head shall be the chairman.

(4) The legally qualified member assigned to the Technical Division shall participate in the decision under subsection (3) with the right to vote. If the examiner is entitled to render a decision alone (subsection (1)), he shall first obtain the opinion of the legally qualified member in the following cases:

1. where patentability is to be decided from the standpoint of commercial applicability or on the basis of Section 2;

2. where opposition is based on Section 102(2) 5 or 6;

3. where a decision is to be taken on priority rights (section 93 to 95) the legal conditions of such claims being in doubt or contested.

4. where witnesses or experts have been examined or a visit to the scene has been made;

5. where a decision is to be taken regarding an administrative or disciplinary penalty.

(5) Where, at a meeting of the Technical Division consisting of three technically qualified members, the majority takes the view that one of the matters referred to in subsection (4) should also be determined, the legally qualified member assigned to the Technical Division shall participate in the decision in place of one of the technically qualified members.

(6) To the extent to which the composition of the board is not determined by subsections (3) to (5), it shall be settled by the head of the Technical Division with due regard to the subject matter of the case concerned.

(7) Before a decision is taken on matters falling within the responsibility of the Legal Division (Section 60(3)(a)) and to which technical questions may be relevant, the legally qualified member shall obtain the opinion of the competent technically qualified member.

**Section 63.** (1) For final decisions of the Appeal and the Nullity Divisions the following members shall participate in addition to the chairman:

1. in the Appeal Division three technically qualified members and one legally qualified member, except in the case of appeals against decisions of a legally qualified member, in which case three members of the Division, two of whom being legally qualified members, shall take the decision;

2. in the Nullity Division by two legally qualified members and three technically qualified members.

(2) The chairmen of the Nullity Division shall be legally qualified, and the chairmen of the Appeal Division shall be legally qualified in the case of appeals against decisions of a legally qualified member.

(3) In the case of interim decisions in the Appeal and the Nullity Divisions the presence of three members shall be sufficient.

**Section 64.** (1) Decisions of the board shall be taken by a simple majority. In the event of a tie the chairman shall have the casting vote.

(2) The decisions of the Patent Office shall be accompanied by a statement of reasons; they shall be in writing and served on all parties. If a petition to the Technical Division or Legal Division is approved in its entirety in ex parte proceedings, the statement of reasons may be dispensed with.

(3) Approval for a notice shall require the signature of the person approving. This provision may be dispensed with if the approving person can otherwise be established beyond doubt.

(4) All papers issued by the Patent Office shall be issued in the name of the "Austrian Patent Office", with the addition of the Division or administrative office, the library or accounting department; in matters reserved to the President the words "the President" should be included. Written communications shall be dated and signed. Collective decisions shall be signed by the chairman. The signature may be replaced by an official certification to the effect that the copy delivered is a true copy of the document in question and that the original contains the signature required. Further particulars shall be settled by order.

(5) For written copies produced automation-assisted the addition of the name of the person approving shall be sufficient; no attestation by the office shall be required."

**Section 65.** (1) The instructions required to prepare the decision to be adopted by the Technical Division shall be issued by the examiner. Except in so far as merely formal defects in submissions or the description submitted are to be corrected, a record shall always be taken where parties, witnesses or experts are heard.

(2) Decisions shall be taken on the basis of a request substantiated in writing. Amendments adopted at the meeting shall be entered in the text of the request. If the decision departs in essentials from the terms of the request, the text shall be drawn up afresh in agreement with the member on whose draft the decision was based.

(3) Each member of the board may change his opinion up until the end of the meeting. If, as a result, the decision adopted no longer commands a majority, a new vote shall be taken.

(4) If there is no unanimity in the board regarding the decision or the reasons given for it, a record shall be taken showing the views of the members of the board and the result of the

vote taken. Otherwise an entry regarding the vote signed by all members of the board shall be sufficient.

**Section 66.** Boards dealing with cases before the Appeal and the Nullity Divisions shall be set up by the chairmen separately for each case. In this connection, the workload, and in the case of the technically qualified members, the subject of the particular case shall be taken into account.

### **Official Robe**

**Section 67.** (1) At all hearings, the members of the Appeal and the Nullity Divisions shall wear official robes. An order shall be issued to regulate further the kind of robe and the wearing of such robe.

(2) The representatives referred to in Section 77 may wear official robes at hearings of the Appeal and the Nullity Divisions and of the Supreme Patent and Trademark Chamber.

### **Business Routine**

**Section 68.** The business routine in the Divisions, the library, the accounting department and the administrative offices shall be regulated in detail by an order of the President of the Patent Office, having regard to the need for orderly and rapid work and to the tasks of the Patent Office. The order shall also determine how submissions may be made direct to the Patent Office and when they are deemed to have been received by the Patent Office. Care shall be taken to ensure that the time of receipt of the submission is precisely identified by day, hour and minute.

**Section 69.** Against the decisions of the President falling within his responsibility under this Act, an appeal shall lie only if it is expressly provided for in this Act. Section 2(2) of the Law on Administrative Procedure shall not, however, be affected.

### **Appeals against Decisions of Divisions**

**Section 70.** (1) The decisions of the Technical Division and Legal Division may be appealed against.

(2) Against the decisions (interim and final) of the Appeal Division no further appeal shall lie to a higher authority nor may an appeal be made to the Administrative Court.

(3) The final decisions of the Nullity Division may be the object of an appeal to the Supreme Patent and Trademark Chamber as the highest authority.

(4) No separate appeal shall lie against the rapporteur's acts preparing a decision of a Technical Division or Legal Division or a decision of the Appeal or the Nullity Division.

(5) Similarly, no separate appeal shall lie against interim decisions of the Nullity Division but an amendment of the rapporteur's preparatory acts (subsection 4) may be applied for in all three Divisions and an amendment of interim decisions of the Appeal or the Nullity Division may be applied for in the Division concerned.

**Section 71.** (1) The appeal shall contain a formal petition and shall be lodged with the Patent Office within two months from the date when the decision was served: it shall be substantiated no later than one month after the expiration of this period.

(2) If the appeal involves an adverse party, the submission intended for the Patent Office shall be accompanied by one copy of the appeal and its attachments for each adverse party.

(3) Appeals not arriving within the period referred to shall be dismissed by the Technical Division or Legal Division, as the case may be. Appeals which are inadmissible or were not substantiated in time (subsection (1)) or do not comply with other legal requirements shall, without further proceedings, be dismissed by the Appeal Division. In the case of defects of form, however, an appeal may be dismissed only after the appellant has failed, on request, to remedy the defects.

(4) In proceedings before the Appeal Division new facts and evidence shall be admissible only to support or refute facts and evidence submitted in time in the first instance: this shall not preclude restriction or clarification of the claim for protection. The parties shall be given an opportunity to state their views on the new facts submitted and on the result of any new evidence.

**Section 72.** (1) For appeals against decisions of the Technical Division the chairman shall appoint a rapporteur from among the voting members. The rapporteur shall be either a technically qualified permanent member or, if the chairman is not himself legally qualified, the legally qualified member, according to whether technical or legal questions are of greater importance for the decision. For appeals against decisions of the Legal Division the chairman shall appoint a legally qualified permanent member as rapporteur.

(2) The rapporteur shall send a copy of the appeal with its attachments to the adverse party, requesting him to submit his objections within a period of not less than one month, which may be extended in justifying circumstances. The rapporteur shall also make the necessary arrangements for the rendering of the decision or for the hearing, particularly in view of any further written submissions which may be necessary or for the taking of evidence offered by the parties.

(3) At the end of the preliminary proceedings, the rapporteur shall submit the files to the chairman with a written statement of all points of fact and law on which the decision essentially depends, with a statement of his conclusions (report). The chairman may request the rapporteur or any other voting member to supplement the report.

**Section 73.** (1) The chairman may order a hearing in the appeal. He shall order a hearing if the appellant or any adverse party so requests. The hearing shall be in public. Section 119(2) shall apply.

(2) The chairman shall open the proceedings and satisfy himself as to the identity of all persons appearing: he shall examine their status as parties and any powers of attorney. He shall conduct the hearing, without permitting digression or unnecessary details, in such a way as to ensure the parties' right to be heard.

(3) The chairman shall determine the order in which the parties are to be heard, the evidence is to be taken, and the results of earlier evidence or findings are to be submitted and discussed. The chairman or any members of the board appointed by him shall study the case on points of fact and law with the parties.

(4) A record of the hearing shall be taken by a registrar. The record shall show the place, time and subject of the hearing and, in addition, the names of the members of the board, the registrar, the parties, their representatives, the witnesses heard and the experts, and also a summary of the contents and course of the proceedings. The record shall be signed by the chairman and the registrar.

(5) The Appeal Division shall reach its own decision, having complete discretion as to its evaluation of the facts and evidence submitted. The Appeal Division may substitute its

opinion for that of the Technical Division or Legal Division both as to the decision and to the reasons given. It may accordingly amend the decision appealed against in any way.

(6) The deliberations and the vote of the Appeal Division shall take place in camera. Section 65(3) and (4) shall apply *mutatis mutandis*. Decisions to dismiss the case may be taken in writing by circulatory letter unless a member protests.

(7) The rapporteur shall draw up the decision on the basis of the resolutions adopted. If his views are those of the minority, he shall draw up the text of the decision in consultation with the member on whose draft the decision was based. The chairman may, however, assign the preparation of the text or parts thereof to another member of the board.

### **Supreme Patent and Trademark Chamber**

**Section 74.** (1) The Supreme Patent and Trademark Chamber shall be established in Vienna for appeals against final decisions of the Nullity Division of the Patent Office. The Chamber shall consist of a president, a vice-president, no less than eight other legally qualified members and the required number of technically qualified members as counsellors. During their term of office they shall have the title of "Counsellor of the Supreme Patent and Trademark Chamber" (Rat des Obersten Patent- und Markensenates).

(2) The president and the vice-president shall be or have been members of the Supreme Court as president or vice-president, or chairman of a division thereof.

(3) The legally qualified members shall have completed university studies in law and political science and shall have held, for not less than ten years, a position for which completion of such studies was required. In addition, they shall have engaged in scientific or practical work in the field of the protection of industrial property. At least three members shall be judges; at least three members shall be lawyers of Group A in the Federal Ministry of Commerce, Trade and Industry or legally qualified permanent members of the Patent Office.

(4) The technically qualified members shall have completed studies at a technical university or studies in natural sciences at the philosophy faculty of a university: they must have special knowledge of a particular technological subject and be not less than 30 years old.

(5) Only Austrian citizens of moral integrity and having full legal capacity may be appointed members.

(6) The members of the Supreme Patent and Trademark Chamber shall be appointed by the President of the Federal Republic for a period of five years: they may be reappointed. The appointment shall in no case prevent a member from voluntarily leaving the Chamber on permanent retirement.

(7) The term of office shall end on December 31 of the year in which a member reaches the age of 70. It shall also end if a member loses Austrian citizenship, if his legal capacity is restricted or if he is condemned to imprisonment for more than one year for a willfully committed indictable act or if he is convicted for an indictable act committed with a view to enrichment.

(8) Members who are not civil servants shall take the following oath before the president prior to exercising their duties: "I solemnly promise that I shall perform my duties conscientiously and impartially and that I shall maintain secrecy on anything that may come to my knowledge in the course of my official duties." This oath shall be signed. Where an official is reappointed, it shall be sufficient to remind him of the oath he has taken.



(9) The members shall be independent in the exercise of their duties and shall not be bound by any instructions. The decisions of the Supreme Patent and Trademark Chamber may not be annulled or amended by administrative procedures.

(10) The registrars shall be appointed by the Federal Minister of Commerce, Trade and Industry from among civil servants of Group A in that Ministry or in the Patent Office.

(11) The president of the Supreme Patent and Trademark Chamber as the head of that authority shall be entitled to annual special-duty pay at the rate of 250 percent and the vice-president at the rate of 125 percent of the monthly salary of a federal civil servant in active service in salary step 1 of service grade IX of the General Administration.

(12) All other members and registrars shall receive special-duty pay in accordance with their assignment:

(a) rapporteurs (joint rapporteurs) shall receive 8 to 40 percent;

(b) assessors shall receive 4 to 15 percent; and

(c) registrars shall receive 3 to 10 percent of the monthly salary referred to in subsection (11) whenever they are called upon to serve. Special-duty pay shall be determined by the Federal Minister of Commerce, Trade and Industry on the advice of the president at the end of the calendar year for all cases completed during the calendar year in question, with due regard to the time and labor required for each case.

(13) The secretarial work of the Supreme Patent and Trademark Chamber shall be performed by the Patent Office.

**Section 75.** (1) The Supreme Patent and Trademark Chamber shall deliberate and take decisions under the chairmanship of the president or—if he is unable to attend—of the vice-president in boards consisting of five members: a chairman, two legally qualified members and two technically qualified members. The chairman shall ensure that the board includes at least one lawyer of Group A and at least one judge. The lawyer shall be the rapporteur; if necessary, the chairman may appoint further members of the board as joint rapporteurs.

(2) At all hearings, the members of the Supreme Patent and Trademark Chamber shall wear official robes. An order shall regulate further the kind of robe and the wearing of such robe.

### **Reasons for Exclusion**

**Section 76.** (1) Members of the Patent Office and of the Supreme Patent and Trademark Chamber may not take part:

1. in cases in which they are themselves parties or in which they have a joint interest or joint liability with one of the parties or may be liable to one of the parties;

2. in cases concerning their spouses or persons directly related to them through consanguinity or marriage or who are their relatives by a collateral line up to the fourth degree or who are related by marriage up to the second degree;

3. in cases concerning their adoptive or foster parents, adoptive or foster children, wards or persons committed to their care;

4. in cases in which they represent or have represented one of the parties or have had or may have a material advantage or loss;

5. in appeals against a decision in which they have taken part;
6. for any other major reason likely to place their complete impartiality in doubt.

(2) Members of the Patent Office may not take part in decisions of the Appeal Division regarding of a patent application or a patent itself if they have taken part in the Technical Division's decision regarding publication or grant of the patent. Nor may they take part in an appeal against the decision of a Technical Division of which they are members or to which they have been assigned as legally qualified members.

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

1. in proceedings concerning petitions for a declaration of nullity of a patent if they have taken part in the decision regarding the publication or the grant of the patent;
2. in proceedings concerning all other petitions within the responsibility of the Nullity Division in the circumstances referred to in paragraph 1 where the proceedings are based on a situation which was the subject of a decision in proceedings before the Technical Division or the Legal Division or the Appeal Division.

(4) A member of the Patent Office or of the Supreme Patent and Trademark Chamber who regards himself as excluded from participating in a decision (subsections (1) to (3)) shall immediately inform the Division head or the chairman, stating his reasons. The Division head or the chairman shall, if he regards the reason for exclusion as valid, make the necessary arrangements for a replacement. If the reason for exclusion relates to the Division head or the chairman, it must be communicated to the President of the Patent Office in the case of proceedings before the Patent Office and to the president of the Supreme Patent and Trademark Chamber in the case of proceedings before the Supreme Patent and Trademark Chamber. In the case where either of the two presidents was in fact the chairman, the reason for exclusion shall be communicated to his deputy.

(5) If, in proceedings before the Patent Office or the Supreme Patent and Trademark Chamber, a party pleads a reason for the exclusion of a member, the procedure set out in subsection (4) shall be followed.

### **Representatives of the Parties**

**Section 77.** Only attorneys at law, patent attorneys and notaries as well as the Finanzprokuratur<sup>1</sup> may represent parties professionally before the Patent Office and before the Supreme Patent and Trademark Chamber.

### **Prohibition of Unauthorized Representation**

**Section 78.** (1) Anyone who, in matters relating to the protection of inventions, professionally

1. prepares written documents or drawings for proceedings before Austrian or foreign authorities,
2. gives information,
3. represents parties before Austrian authorities, or

4. offers to conduct any of the activities referred to in para. 1 to 3 without being authorized in Austria to represent parties professionally in such matters, shall be guilty of unauthorized legal representation and shall be liable to a fine not exceeding € 4.360.- imposed by the district administrative authority.

(2) The special provisions relating to the treatment of unauthorized legal representation and opinions in the ordinary courts shall not be affected.

### **Patent Gazette**

**Section 79.** (1) The Patent Office shall issue periodically a Patent Gazette (Patentblatt) containing the public notices provided for in this Act and the orders issued by the President of the Patent Office, except where they are solely intended for the Divisions, the library, the accounting department and the administrative offices of the Patent Office. Unless expressly otherwise provided, these orders shall take effect on the day after the issue of the Patent Gazette containing the notice concerned.

(2) The preparation and publication of this Gazette shall be regulated by an order of the Federal Minister of Economic Affairs.

### **Patent Register, Patent Documents**

**Section 80.** (1) The Patent Office shall keep a Patent Register which shall specify the number, title, application date and priority, if any, of patents granted, and the name and residence of patentees and their representatives. The following shall also be recorded: the beginning of patent protection, expiry, revocation, declarations of nullity, lack of title of the patent, designation of the inventor, declaration of independence of a patent of addition, declaration of dependence, assignments of patents, licenses, liens and other rights in rem relating to a patent, employer's rights under Section 7(2), rights of prior user (Section 23), restoration of rights (Section 133), decisions relating to declarations under Section 163, disputes, and indications under Section 156(2).

(2) The descriptions, drawings, models and samples relating to existing patents and also the petitions and documents on which entries in the Register are based shall be kept by the Patent Office.

(3) Any person may inspect the Patent Register.

(4) The Patent Office shall publish the descriptions, patent claims, drawings and abstracts of the patents granted to the extent that they are open to public inspection in separate printed copies (patent documents). The patent documents shall specify the references which the Patent Office has taken into consideration in order to assess the patentability of the invention in respect of which an application has been filed.

(5) Institutions under public law may, at their request, be provided free of charge with one copy each of all patent documents, issued as from the time of receipt of the respective request when those documents are made accessible to the public.

(6) On request, the Patent Office shall issue certified copies of entries in the Register.

### **Inspection of Files**

**Section 81.** (1) The parties to proceedings may inspect documents relating to those proceedings.

(2) Any person may inspect documents relating to published patent applications (Section 101) and patents granted thereon.

(3) Third parties may not inspect the files relating to unpublished applications without the consent of the applicant. The consent of the applicant shall not be required for any person against whom the applicant has invoked the rights under the application. Upon publication of a separate application, any person may inspect the files of an earlier application without the applicant's consent.

(4) Files relating to expert opinions in accordance with section 57a shall be open to inspection by third parties only with the consent of the requesting party. The consent shall not be required for any person against whom the requesting party has referred to the expert opinion.

(5) The right to inspect documents shall also include the right to make copies thereof. Copies shall be certified by the Patent Office on request.

(6) Information and official certificates as to the date and title of an application, the name of the applicant and of his agent (if any), the serial number, the class of patents to which it belongs, any priority claimed, the serial number of the application on which priority is based, whether an independent patent or a patent of addition is sought, where applicable the person named as inventor, whether the application is still pending, and whether and to whom the rights under the application have been assigned shall be supplied to any person.

(7) Records of deliberations and parts of files relating solely to internal administrative transactions shall not be accessible to the public. On request also parts of files not requiring a laying open to public inspection for information purposes may also be excluded if they refer to a trade or industrial secret or if there is another good reason therefor.

### **Samples of Deposited Microorganisms**

**Section 81a.** As from the date of publication of the application (Section 101(1)) anybody shall be entitled to receive a sample of a microorganism deposited according to Section 87a(2) subpara. 1 if he undertakes, vis-à-vis the applicant or patentee, not to make the deposited microorganism derived from the former accessible to third parties before

1. the application has been revoked or rejected (Sections 100 and 104) or is deemed abandoned (Section 166(6)), or

2. the patent has expired (Section 46), has been revoked (Section 47) or declared null and void (Section 48).

### **Administrative and Disciplinary Penalties**

Section 82. (1) The person who is in charge of a hearing, an examination, an inspection or the taking of evidence shall ensure that order and propriety are maintained.

(2) Persons who disturb official proceedings or violate the rules of propriety by misconduct shall be reprimanded; if the reprimand is not heeded, they may, after a prior warning, be deprived of the right to speak, or removed and ordered to appoint a representative, or sentenced to a fine of € 72.- and, in default, to detention not exceeding three days. In aggravating circumstances, the sentence of detention may be substituted for the fine or imposed in addition.

(3) The same disciplinary penalties may be imposed on persons who draw up their written submissions in an insulting manner.

(4) Measures under subsection (2) may be taken by the person in charge of the proceedings. In proceedings before the Appeal or the Nullity Division of the Patent Office or before the Supreme Patent and Trademark Chamber, decisions as to the removal of a person taking part in the proceedings or the imposition of a disciplinary penalty shall be taken by the board concerned. Disciplinary penalties under subsection (3) shall be imposed by the board in proceedings where decisions are taken by the board.

(5) Disciplinary penalties against public authorities who, in the exercise of their duties, act as representatives and are not subject to disciplinary regulations may not take the form of detention. Where public authorities and representatives authorized to act for parties on a professional basis are subject to disciplinary regulations, no disciplinary penalty shall be imposed but the case may be reported to the disciplinary authority in question.

(6) The imposition of a disciplinary penalty shall not preclude the institution of criminal proceedings for the same action.

**Section 83.** Persons who avail themselves of the services of the Patent Office or the Supreme Patent and Trademark Chamber in an obviously frivolous fashion or make incorrect statements in order to obstruct the proceedings may be sentenced to a fine not exceeding € 72.- and, in default, to detention not exceeding three days. In proceedings where the decision is taken by a board, the board shall decide on the disciplinary penalty.

**Section 84.** (1) The fines referred to shall be made over to the Federal Republic. Sections 12, 54 and 67 of the Law on Administrative Penalties, 1950, Federal Law Gazette No. 172, shall apply to the penalties referred to.

(2) The power to impose disciplinary penalties shall lie with the authority in charge of the disturbed proceedings or before which the misconduct took place or which received the submissions referred to in Section 82(3). The power to impose penalties under Section 83 for frivolous conduct shall lie with the authority whose services were frivolously used or before which incorrect statements were made in order to obstruct the proceedings.

(3) An appeal shall lie to the next higher instance (Section 70) against decisions of the Technical Division or Legal Division and the Nullity Divisions imposing a disciplinary penalty. The appeal shall be made within two weeks and shall have no delaying effect. No appeal shall lie against the decision of the Appeal Division or the next higher instance.

### **Service of Documents**

**Section 85.** The documents drawn up by the Patent Office and the Supreme Patent and Trademark Chamber shall be served in accordance with the Service Act. Federal Law Gazette No. 200/1982, unless otherwise provided in Section 86.

**Section 86.** Where a submission has been made by two or more persons not all of whom live in Austria, in doubt the Austrian resident whose signature first appears on the submission shall be deemed to be authorized to receive service of documents on behalf of all interested parties.

## **III. PROCEDURE**

### **A. Grant of Patents**

#### **Filing of a Patent Application**

**Section 87.** (1) An application for a patent shall be filed at the Patent Office in the written form prescribed. Filing may be effected by hand or by post. It shall be subject to an application fee (Section 166(1)).

(2) The date of an application's arrival at the Patent Office shall be regarded as the date of filing.

#### Disclosure

**Section 87a.** (1) The patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

(2) If an invention relates to a microorganism, a microbiological process or a product obtained by such process and if the microorganism is not accessible to the public and cannot be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall be deemed disclosed according to subsection (1) only if

1. a culture of the microorganism was deposited with a depositary institution as defined by the Budapest Treaty on the date of filing the application at the latest,
2. the application as originally filed contains the authoritative data available to the applicant concerning the features of the microorganism, and
3. if the Patent Office was notified of the depositary institution and the file number of the deposit of the culture prior to taking the publication decision (Sec. 101(1)).

#### Unity

**Section 88.** The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

#### Requirements of the Application

**Section 89.** (1) The application shall contain:

1. the name and domicile or place of residence of the applicant as well as of his representative, if any;
2. the petition for the grant of the patent;
3. an appropriate brief designation of the invention to be patented (title);
4. a description of the invention (specification);
5. one or more patent claims (Section 91(1));
6. the drawings necessary to understand the invention;
7. an abstract (Section 91(2)).

(2) The parts of the application cited in subsection 1 (4 to 7) shall be filed in duplicate. They may be worded also in English or French.

**Section 90.** Where the application is made through a representative, his power of attorney shall be attached. If an attorney at law, a patent attorney or a notary acts as representative,

he has to expressly refer to the authorization granted to him if he makes use of the possibility of Sec. 21(2).

**Section 91.** (1) The patent claims shall, in a clear and distinguishing manner, define the matter for which protection is sought. They shall be supported by the specification.

(2) The abstract shall contain a short summary of the disclosure contained in the application. It shall merely serve for use as technical information and may not be taken into account for any other purpose, in particular not for the purpose of interpreting the scope of protection sought.

(3) The specification, the patent claims, the drawings and the abstract may be amended until the publication decision is taken (Section 101(1)). In so far as these amendments affect the essence of the invention, they shall be separated from the application and, if applicant seeks protection for them, separate applications relating thereto shall be filed (Section 92a).

**Section 91a.** (1) If parts of the application are in English or French (Sec. 89(2)), a German translation thereof shall be filed within three months as from the date of filing the application. The preliminary examination proceedings shall be based on such translation; its correctness shall not be examined in the preliminary examination proceedings.

(2) If a translation is not filed in due time, the application shall be deemed abandoned.

**Section 92.** Form and contents of the application shall be regulated in detail by decree. In doing so, care shall be taken to ensure maximum expediency and simplicity as well as understandability of the patent specification and to meet the requirements involved in the printing and publication thereof.

#### Division of the Application

**Section 92a.** (1) The applicant may voluntarily divide the application until the publication decision (Section 101(1)) or the decision of rejection (Section 100(1)7)) is taken. Unless the part divided out is filed at the time of the division in a separate application, the applicant shall be set a time limit to do so provided that he had requested such a time limit when dividing the application.

(2) If the application is not uniform (Section 88) or if it has been inadmissibly amended (Section 91(3)), the applicant shall be requested by an official action to divide the application and shall be set a time limit for filing a separate application relating to the part to be divided out.

(3) At the applicant's request the lack of unity (Section 88) of the application shall be established by a decision. In such decision, applicant shall be set a time limit, beginning as from the date the decision becomes final, to divide the application and to file a separate application relating to the part to be divided out.

(4) If the application is rejected wholly or in part because it has been inadmissibly amended (Section 91(3)) and has not been divided despite a request or because opposition based on Section 102(2)4. is successful, applicant shall be set a time limit in such decision beginning as from the date the decision becomes final, to file a separate application relating to the inadmissible amendments.

(5) If the separate application is filed at the same time the original application (subsection 1) is divided or after division within the time limit set for filing the separate application (subsections 1 to 4), its filing date shall be deemed the day on which the original application

was filed with the Patent Office or on which the Patent Office was notified of the amendment in the proceedings concerning the original application.

### **Conversion of the Application**

**Section 92b.** Before the publication decision (Sec. 101(1)) or the decision of rejection (Sec. 100(1)) is taken the applicant may request the conversion of the application into a utility model application as defined by the Utility Models Act, Federal Law Gazette No. 211/1994 as amended. That utility model application shall enjoy as the filing date the date of filing the patent application with the Patent Office.

### **Priority**

**Section 93.** (1) The applicant shall have the priority right to his invention from the date on which his application for a patent was duly filed (Sections 87 to 92).

(2) From such date he shall have priority over every similar invention filed later.

(3) Where the application contains defects, and such defects are remedied in time (Section 99), this shall have no effect on the date of the first filing, provided that the nature of the invention is not affected by such amendments.

**Section 93a.** The applicant shall have the right of priority of a previous patent or utility model application for a period of twelve months following the date of filing a previous patent or utility model application with the Patent Office, if the subsequent patent application refers to the same invention (internal priority). The conditions and effects of this right of priority shall correspond to those listed in article 4 of the Paris Convention for the Protection of Industrial Property, Federal Law Gazette No 399/1973.

**Section 93b.** The applicant shall have the right of priority of a previous patent or utility model application for a period of twelve months following the date of filing a previous patent or utility model application, filed with an application office not covered by the scope of an intergovernmental agreement on recognition of priority, if the subsequent patent application refers to the same invention and if a respective mutuality with this application office is declared by a notice to be published by the Federal Minister for Economic Affairs in the Federal Law Gazette. The conditions and effects of this right of priority shall correspond to those listed in article 4 of the Paris Convention for the Protection of Industrial Property, Federal Law Gazette No 399/1973.

**Section 94.** (1) Separate priorities for separate parts of the subject of the application (partial priorities) may be claimed only on the basis of sections 93a or 93b or intergovernmental agreements. Such partial priorities shall also be admitted where the date of arrival of the application at the Patent Office is decisive for the priority of a feature of the application.

(2) The application fee shall be the single fee multiplied by the number of all priorities claimed for the application. Unless payment of the full amount is duly proved within the time limit set for such payment (Sec. 169), the priority of the application shall be determined by the day of its receipt by the Patent Office (Sec. 93), and the partial amount paid shall, insofar as it exceeds the single application fee, be refunded.

**Section 95.** (1) The rights of priority granted on the basis of sections 93a or 93b or intergovernmental agreements must be expressly claimed. The date and the country of the application the priority of which is claimed, shall be indicated (declaration of priority), as well as the serial number of the application.



(2) The declaration of priority shall be submitted to the Patent Office within two months of the arrival of the patent application at the Patent Office. Within that period, an amendment to the declaration of priority may be requested. For such request, a fee amounting to half the application fee shall be payable (Section 166(1)). In the case of partial priorities (Section 94), the fee shall be the multiple corresponding to the number of priorities to be amended.

(3) If the grant or maintenance of the protected right depends on the validity of the claim to priority, the right of priority must be proved. The evidence required for such proof (evidence of priority) and the time of submission shall be determined by decree.

(4) If the declaration of priority is not made in time, if evidence of priority is not submitted in time, or if the serial number of the application for which priority is claimed is not notified on official demand within the period laid down, priority shall be determined in accordance with the date of filing in Austria.

### **Preliminary Examination**

**Section 99.** (1) A preliminary examination of the application shall be made by a member of the Technical Division. The examination shall not relate to the financial return to be expected from the invention.

(2) If the application does not fulfill the requirements laid down, the applicant shall be requested to remedy the defects within a prescribed period.

(3) Where the preliminary examination shows, if necessary after experts have been heard, that the invention is manifestly not patentable under Sections 1 to 3, applicant shall be informed accordingly, if necessary after having been questioned by the examiner. He shall be informed of the reasons and requested to state his case within a prescribed period.

(4) The period (subsections (2) and (3)) may be extended on request. There shall be no remedy against rejection of a petition for extension of the period, but a statement of the case in reply to a preliminary decision may be submitted out of time within two weeks after the decision rejecting the petition has been served.

(5) If, within the time limit laid down, neither a statement of the case in reply to the preliminary decision (subsections 2 and 3) nor a petition for an extension of the time limit is submitted, the application shall be deemed withdrawn. This legal consequence shall not take effect if, within four months of the expiry of the period (subsections 2 and 3), the statement of the case in reply to the preliminary decision is postfiled, if a fee equal to the application fee is paid (Section 166(1)) and if the payment of that fee is duly proved (Sec. 169). If timely payment has not been duly proved, a time limit of one month, which may not be extended, shall be prescribed for the applicant.

(6) The President of the Patent Office may issue guidelines on the principles governing the preliminary examination and on the procedure for such examination to be observed by the members of the Technical Division. In particular, he may determine the periods to be laid down by the Office. In this connection, he shall take account of the need for as rational and careful a preliminary examination as possible and for uniformity in the treatment of applications.

### **Rejection of an Application**

**Section 100.** (1) Where the original or amended application does not fulfill the requirements laid down or where the invention is ex facie not patentable within the meaning of Sections 1 to 3 (Section 99), the application shall be rejected. Where the conditions referred to apply only in part, only the corresponding part of the application shall be rejected.

(2) Where the application is to be rejected for a reason which was not already communicated to the applicant during the preliminary examination, he shall be given an opportunity to state his case in regard to that reason within a prescribed period.

### **Publication of the Application and Laying Open for Public Inspection**

**Section 101.** (1) Where the Patent Office considers that the application has been made in proper form and that the grant of a patent is not precluded, it shall order the application to be published (public notice). Publication of the application shall be effected in the form of a notice in the Patent Gazette giving the name and residence of the applicant and an appropriate brief designation of the subject of the invention (title) and the date of the application.

(2) The legal effects of the patent (Section 22) shall begin to operate provisionally in the applicant's favor on the day of issue of the Patent Gazette, which must be mentioned in the Gazette.

(3) The application, together with all attachments, shall be laid open for public inspection in the Patent Office for a period of four months, dating from the day of publication, on all days on which the Patent Office is open for the filing of patent application. Where appropriate, the Patent Office may order such laying open also at other places. An order shall be issued to determine the details of such inspection; in that connection, every endeavor shall be made to ensure adequate and orderly inspection safeguarding, at the same time, the rights of the applicant. The President shall, with due regard to the interests of the service and of the public interested in the inspection, issue regulations for visitors to the place of display. He may prohibit access, for a period not exceeding six months, by persons who infringe the regulations despite written warnings.

(4) At the applicant's request, publications and laying open shall be suspended for a period of three months from the date of the decision regarding publication. Publication and laying open may also be suspended at the applicant's request for a period of one year from the date referred to.

### **Opposition**

**Section 102.** (1) Opposition to the grant of a patent may be made within four months of the date of publication. Such opposition must reach the Patent Office not later than the last day of the period laid down.

(2) Opposition shall be in writing and submitted in duplicate. It may be based only on the following grounds, which must be substantiated by definite facts:

1. that the subject matter of the published application is not patentable under Sections 1 to 3;
2. that the published application does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
3. that the subject matter of the published application extends beyond the content of the application in the version as originally filed determining the filing date;
4. that the microorganism deposited according to Section 87a(2) 1. has not been permanently accessible either at the original depositary institution as defined by the Budapest Treaty or at another depositary institution to which it has been passed on according to that Treaty unless the patentee proves

(a) that he has deposited the microorganism again and that such deposit is deemed under Art. 4 of that Treaty to have been made on the day of the original deposit, or

(b) that he was prevented from such a repeated deposit by an unforeseeable or unavoidable event and that he made such a deposit within two months after the obstacle ceased to exist;

5. that the applicant has no right to the grant of a patent (Sections 4(1), 6 and 7);

6. that the essence of the application which is opposed has been usurped from the descriptions, drawings, models, implements or installations of a third person or from a process used by him.

(3) In the case referred to in subsection (2)5, only the person entitled to the grant of the patent, and in the case referred to in subsection (2)6, only the injured person may oppose the grant of a patent.

(4) A copy of the opposition shall be served on the applicant, who may submit his written reply within a period of one month, which may be extended on grounds meriting consideration.

(5) Within the time limit prescribed for opposition (subsection 1), a declaration of dependence (Sec.4(3)) may be applied for by the owner of the patent of the earlier priority or of the utility model of the earlier priority within the meaning of the Utility Models Act. Federal Law Gazette No. 211/1994, as amended. The provisions concerning opposition shall apply to such petition.

### **Procedure for Opposition**

**Section 103.** (1) As soon as the applicant's reply has been submitted, or the period for its submission has expired, the rapporteur in charge of the case shall issue instructions relating to any further correspondence that may be necessary, the hearing of the parties, the taking of evidence offered by the parties, the taking of evidence and, in general, any other measures required for the establishment of the facts.

(2) With regard to witnesses' and experts' fees, the provisions of the Law on the Scale of Fees, 1975. Federal Law Gazette No. 136, as amended, shall apply. However, witnesses shall be entitled to a refund of expenses only if they have their residence in Austria.

### **Assessment of the Evidence and Decision**

**Section 104.** After the preliminary procedure, the Patent Office (Technical Division) shall freely assess the evidence in camera and take its decision on the grant of a patent.

### **Costs**

**Section 105.** The reimbursement of procedural and representation costs shall be determined by the application, mutatis mutandis, of Sections 40, 41(1) and (3) and 42 to 45 of the Code of Civil Procedure (ZPO).

### **Application for a Patent by the Opponent**

**Section 106.** Where, in the case provided for in Section 102(2) 5. and 6., opposition results in the withdrawal or rejection of an application, the opponent may, if he files an application

within one month after the Patent Office's decision has become final, request that the date of the withdrawn or rejected application be deemed to be the filing date of his application.

### **Grant of Patent Without Opposition Proceedings**

**Section 107.** Where no opposition (Section 102) has been filed in time against a published application (Section 101) and the first annual fee (Section 166(6)) has been paid in time, the patent shall be deemed to have been granted on the expiry of the period prescribed for the filing of opposition (Section 102(1)).

### **Appeals**

**Section 108.** (1) An applicant may appeal against a decision rejecting the application in whole or in part (Sections 100 and 104); an opponent may appeal against a decision granting a patent in its entirety, and both the applicant and the opponent may appeal against a decision granting restricted patent rights.

(2) In all other cases, the provisions of Sections 103(2) and 104 to 106 shall apply *mutatis mutandis*.

### **Letters Patent, Publication**

**Section 109.** When the patent has been finally granted, the Patent Office shall order the entry of the protected invention in the Patent Register, the publication of the grant in the Patent Gazette, the issue of letters patent (Patenturkunde) to the patentee, and the printing and publication of the patent document.

### **Refusal**

**Section 111.** (1) Withdrawal of an application after publication (Section 101) or refusal of a patent shall also be published.

(2) With the publication of withdrawal or refusal of a patent, the effects of provisional protection (Section 101(2)) shall be deemed not to have been operative.

## **B. Expert Opinions**

### **Requirements for and Processing of Petitions**

**Section 111a.** (1) A petition for the carrying out of a search under Section 57a(1) may relate to one technical problem only. The petition may also contain a request that the search extend back to a day in the past. The petition shall be accompanied by an accurate and clear description and, where necessary, a short summary of the concrete technical problem, and by drawings.

(2) The petition for the preparation of an expert opinion under Section 57a(2) shall be accompanied by a description of the invention, claims and, where necessary, drawings. Section 91(1) shall apply *mutatis mutandis*. Where the petitioner does not indicate the state of the art on which the expert opinion is to be based, the expert opinion shall be based on the state of the art known to the Patent Office on the day of its receipt of the petition. The petition may also contain a request that the expert opinion extend back to a day in the past.

(3) Petitions for the preparation of an expert opinion under Section 57a with attachments (subsections 1 and 2) shall be filed with the Patent Office in two copies and in writing. The

description, the claims and the summary may also be drafted in English or in French, in which case the Patent Office shall be entitled to demand a German translation.

(4) The processing of petitions shall be entrusted to the technically qualified member (Section 61) who is competent according to the distribution of responsibilities. A copy of the enclosures submitted by the petitioner (subsections (1) and (2)) shall accompany the settled file.

(5) Where the petition or an enclosure is defective, the petitioner shall be called upon to remedy the defect within a specified period. Where the defect is not remedied, the petition shall be rejected by decision. The rejection decision may be challenged in an appeal.

## **C. Contesting of Patents**

### **Making a Petition**

**Section 112.** (1) Proceedings for revocation or for a declaration of nullity or lack of title in relation to a patent shall be instituted only on request. However, the Patent Office may ex officio continue any proceedings for revocation or nullity of a patent where such petition has been withdrawn.

(2) A petitioner not resident in a state in which the decision by which the repayment of costs by the petitioner is requested would be enforced, shall provide security for the costs of proceedings if the defendant so demands. Such demand must be made within 14 days of service of the petition, failing which security may no longer be demanded.

(3) The Patent Office shall determine, at its discretion, the amount of security and set a term for the deposit thereof. If security is not furnished in time, the petition shall be deemed withdrawn.

### **Immediate Rejection**

**Section 113.** (1) Petitions for revocation or for a declaration of nullity or lack of title which are manifestly without legal basis, and submissions which do not contain any particular request or which the petitioner is not entitled to make (Sections 49 and 50) shall be rejected, without further proceedings, by the Nullity Division, which shall state the reasons for such rejection.

(2) Similarly, petitions shall, without further proceedings, be rejected with a statement of reasons where the Nullity Division is not competent to take a decision or where a case has been decided or is still pending.

(3) Such decisions shall be deemed final.

### **Form and Contents of the Petitions**

**Section 114.** (1) The petition shall contain a brief presentation of the case in dispute, and it shall set out the request that is being made and the evidence to be submitted.

(2) Where a petition is directed against a single patentee, it shall be submitted with its attachments, in duplicate, to the Patent Office.

(3) Where a petition is directed against several patentees, in addition to the copy intended for the Patent Office, a copy of the petition and its attachments shall be supplied to each of the parties concerned.

### **Third Party Intervention**

**Section 114a.** (1) Any person having a legitimate interest that proceedings, pending between other persons before the Nullity Division or the Supreme Patent and Trademark Chamber, be decided in favor of one of those persons may intervene on behalf of that person (third party intervention). The intervening third party shall have the status of joint litigant (Section 14, Code of Civil Procedure), even if the conditions of Section 20. Code of Civil Procedure, are not present.

(2) In all other respects Sections 18 to 20 of the Code of Civil Procedure shall apply *mutatis mutandis*.

### **Procedure for Petitions Contesting a Patent**

**Section 115.** (1) The chairman shall appoint as rapporteurs one technically qualified permanent member, and one legally qualified permanent member.

(2) The legally qualified rapporteur shall, if the petition has been considered well-founded, send a copy, together with copies of the attachments, to the defendant inviting him to submit his reply in writing and in duplicate within a period of not less than one month, which shall be extended for reasons meriting consideration.

### **Preliminary Proceedings**

**Section 116.** (1) After the reply has been submitted or the period prescribed for it has expired unused, the legally qualified rapporteur shall, if necessary, arrange for preliminary proceedings (subsections (2) and (3)) to prepare for a hearing. The rapporteurs shall seek agreement between themselves in the preliminary proceedings. Differences of opinion shall be decided by the chairman.

(2) In the preliminary proceedings, the entire matter in the dispute shall be prepared for the hearing so that it may, if possible, be conducted without interruption. In particular, the parties shall be heard or statements shall be obtained from them to ascertain the facts not in dispute, wherever they are not apparent from the briefs submitted.

(3) The preliminary proceedings shall also include the taking of evidence, such as personal inspection, the hearing of non-local witnesses and time-consuming investigations by experts if the taking of such evidence during the main hearing would considerably complicate or delay that hearing or cause disproportionately high costs or if it is essential to take the evidence immediately.

(4) Whenever evidence is taken in the preliminary proceedings, the parties shall be summoned. Their failure to appear shall not prevent the evidence from being taken.

(5) For the taking of evidence in preliminary proceedings. Section 120 shall apply. In the preliminary proceedings there shall be no oral examination of the parties.

(6) In the preliminary proceedings, the legally qualified rapporteur shall have all the powers and duties of a chairman provided for in Sections 180 to 185 of the Code of Civil Procedure.

(7) The chairman may order an extension of the preliminary proceedings with respect to certain clearly specified facts.

(8) After the reply has been received or the period laid down for its submission has expired unused and also, if applicable, after the preliminary proceedings have been held, the rapporteur shall submit the files to the chairman with a written statement of the facts and of

all points of fact and law relevant to the decision, as well as his conclusions (report). The legally qualified rapporteur shall report on legal questions and the technically qualified rapporteur on technical questions. The chairman may request a rapporteur or other voting member to supplement the report.

### **Termination of Proceedings Without a Hearing**

**Section 117.** If the patent expires during the proceedings before the Nullity Division, the proceedings shall be terminated by decision unless the petitioner insists on completion of the proceedings and is able to substantiate a legal interest in such completion. In the cases provided for in Section 46(1) 2, and 3, the petitioner shall, in principle, be entitled to reimbursement of costs, whereas the defendant shall be so entitled only if he has not provoked the petition by his conduct and the patent expired during the period prescribed for submission of the reply. The decision concerning the termination of the proceedings shall also settle the question of reimbursement of costs (Section 122(1)). This decision shall be deemed final.

### **Public Notice of the Hearing**

**Section 118.** (1) The chairman shall give public notice of the hearing. The petitioner shall receive the reply not later than the time when public notice was given.

(2) The hearing may, for important reasons, be postponed to another date by the chairman on request or ex officio.

(3) The parties or their representatives and the witnesses and experts to be questioned during the hearing shall be summoned to attend the hearing.

(4) Absence of the parties or their representatives shall not prevent the hearing from being held and the decision from being rendered.

(5) The board shall decide on any request for adjournment during the hearing.

### **Hearing**

**Section 119.** (1) The conduct and direction of the hearing shall be governed, mutatis mutandis, by Sections 171 to 203 of the Code of Civil Procedure, Section 73(3), last sentence, shall apply.

(2) In addition to the cases set out in Section 172 of the Code of Civil Procedure, the public may be excluded on request for part or all of the hearing if the presence of the public would endanger a major interest of the Federal Republic or a trade secret of one of the parties or of a witness.

(3) Members of the Patent Office and of the Supreme Patent and Trademark Chamber and officials of Group A of the Federal Ministry of Commerce, Trade and Industry shall have access to the hearing even where the public is excluded.

### **Evidence and the Taking of Evidence**

**Section 120.** (1) Unless otherwise provided by this Act. Sections 266 to 383 of the Code of Civil Procedure shall apply mutatis mutandis to the taking of evidence.

(2) Depositions of witnesses made before the Patent Office and sworn depositions of the parties made before the Patent Office shall be treated as equivalent to depositions made in court.

(3) The above principles regarding the taking of evidence shall apply both to the preliminary proceedings and to the hearing.

(4) The provisions of the Law on the Scale of Fees, 1975, Federal Law Gazette No. 136, as amended, shall apply. However, witnesses shall be entitled to a refund of expenses only if they have their residence in Austria.

(5) Disciplinary penalties imposed pursuant to Sections 313, 326, 333 and 354 of the Code of Civil Procedure shall not exceed **€ 72.-** or a three-day detention in default of payment. While evidence is taken during a hearing, disciplinary penalties shall be imposed by the board; during the preliminary proceedings, they shall be imposed by the rapporteur (Section 116(1)), Section 84(1) and (3) shall apply.

### **Deliberation and Vote**

**Section 121.** The Nullity Division shall deliberate and vote in camera. Terminations may be decided in writing by circulatory letter unless one member protests.

### **Costs**

**Section 122.** (1) The reimbursement of the costs of the proceedings and of representation shall, subject to subsection (2) and Section 117, be decided by application, *mutatis mutandis*, of Sections 40, 41(1) and (3) and 42 to 55 of the Code of Civil Procedure.

(2) Where a petition is withdrawn, the petitioner shall reimburse the defendant's costs.

### **Contents of the Decision**

**Section 123.** The document setting forth the decision shall contain:

1. the designation of the Division and the names of the members who took part in the decision;
2. the designation of the parties, their representatives and agents and the parties position;
3. the decision;
4. the facts underlying the decision, consisting of a brief description of the facts resulting from the hearing, with special reference to the main pleas made by the parties;
5. the reasons for the decision;
6. information as to the means of appeal.

### **Announcement of the Decision**

**Section 124.** (1) The decision, together with the principal reasons for it, shall, if possible, be announced orally immediately after the end of the hearing.

(2) At all events, the decision and a full statement of the reasons shall be served on the parties as soon as possible.

### **Record**



**Section 125.** (1) A record shall be taken by a registrar of all evidence in the preliminary proceedings and in the hearing. The record shall be signed by the registrar and by the chairman or, in the case of preliminary proceedings, by the rapporteur in charge of taking the evidence.

(2) In all other respects, Section 73(4) shall apply to the record.

(3) In the case of a hearing in camera (Section 121), a separate record shall be taken, showing the results of the deliberation and the vote. Such record shall be signed by the chairman and the registrar.

### **Assistance of the Courts**

**Section 126.** The courts shall provide their assistance to the Patent Office and the Supreme Patent and Trademark Chamber.

### **Reopening of Proceedings**

**Section 127.** (1) Where a decision has wholly or partially revoked or annulled a patent, or declared a patentee to lack title, or where a petition for such a decision has been rejected, proceedings which have been terminated may be reopened at the request of a party in the following cases:

1. where a document on which the decision is based has been forged or falsified;
2. where the decision is based on a false deposition of a witness or expert or on a perjurious statement of the defendant made during the hearing;
3. where the decision was obtained through fraud, amounting to a crime, on the part of the representative of the party or the defendant or his representative;
4. where a member who has taken part in the decision or in an earlier decision on which the decision is based has, to the party's detriment, committed a violation of his official duties amounting to a crime;
5. where the decision was based on a finding made during criminal proceedings which has subsequently been upset in a judgment that has become final.

(2) The petition to reopen proceedings may, however, only be made by the parties to the dispute within one year after the decision to be annulled has become final and without prejudice to the right acquired in the meantime by third parties.

(3) In particular, persons who have, since the first decision, begun to work the invention or have made arrangements to work it shall acquire the rights of prior user (Section 23).

(4) The reopening of proceedings shall be decided by the patent authority (Nullity Division of the Patent Office or Supreme Patent and Trademark Chamber) which took the contested decision. Where the petition to reopen proceedings is allowed by the Supreme Patent and Trademark Chamber, the Chamber shall at the same time decide whether proceedings are to be reopened before it or before the Nullity Division.

(5) A petition to reopen proceedings shall have no delaying effect on the execution of the decision.

**Section 128.** If the Patent Office has mistakenly entered a patent in the Register as invalid, it shall, after ascertaining the mistake, order the entry to be removed and the removal to be

published. Rights of third parties which have in the meantime been acquired in good faith shall be safeguarded in this case as in that of the reopening of proceedings.

### **Reinstatement into the Former Status**

Section 129. (1) Any person who is prevented by an unforeseeable or unavoidable event from observing a time limit, and is thus prejudiced by the application of a rule relating to the protection of inventions, may apply for reinstatement into the former status. A default based on minor errors shall not prevent reinstatement.

(2) Reinstatement shall not be granted:

1. where the time limit for a petition for reinstatement (Section 131(1)) and the time limit for appeal against the decision in relation to such petition have not been observed;
2. where the time limits for the postfiling of the statement of the case (Section 99(5)), for opposition (Section 102(1)) and for the opponent's appeal (Section 71(1)) are not observed;
3. where the time limit for lodging a claim in the ordinary courts has not been observed.

(3) In regard to the time limit for a declaration of priority, for an amendment to such declaration or for the submission of evidence of priority (Section 95(2) and (3)), reinstatement shall be allowed only if the petition, irrespective of the time limits prescribed for its submission in Section 131, reaches the Patent Office not later than the day before publication (Section 101). Where reinstatement is allowed, any decision to publish a patent (Section 101) or to reject it (Section 100) shall become inoperative.

**Section 130.** (1) A decision on the petition shall be taken by the Division before which the action omitted was to be taken. If an action before a Technical Division was omitted, the legally qualified member assigned to the Division shall decide on the petition.

(2) In matters within the responsibility of the Nullity Division of the Patent Office, decisions shall be taken by the chairman of the Division. Appeals against such decisions shall lie to the Supreme Patent and Trademark Chamber in accordance with the relevant provisions. For all other matters within the responsibility of the Patent Office, the other provisions in force shall apply to the manner in which the decision is taken and in which it may be appealed against.

**Section 131.** (1) The petition for reinstatement shall be filed within two months from the day on which the impediment ceased to exist and, in any case, not later than 12 months from the expiry of the time limit concerned.

(2) The petitioner shall state the facts on which his petition is based and, unless they are well known to the authority, he shall produce evidence of them. The action omitted shall be taken at the time the petition is made.

(3) A copy of the petition for reinstatement and its attachments shall be supplied to any adverse party in the case, if any.

**Section 132.** (1) The following procedural fees shall be payable when the petition is made:

(a) where payment of a fee or any action for which a separate fee is payable in addition to stamp duty has been omitted, the fee which was not paid or which is due when the action omitted is taken, in addition to any surcharge applicable;

(b) in all other cases, the fee payable on filing the application.

(2) Half of the procedural fee shall be refunded if the petition is withdrawn before a decision is taken.

(3) The procedural fee (subsection (1)) and the fee outstanding (Section 131(2) second sentence) shall be paid at the rate applicable at the time the petition for reinstatement is made.

(4) Where a respite may be granted for payment of the fee which was not paid or which is payable in respect of the action omitted (subsection (1)(a)), or where such payment may be cancelled, a respite may also be granted for payment of the procedural fee in respect of the petition for reinstatement or the latter fee may be cancelled.

**Section 133.** (1) If the petition or the action taken belatedly is defective, the petitioner shall be asked to remedy the defects within a prescribed period before a decision is taken.

(2) In the case of a protected right recorded in a public register, the petition and the manner it has been dealt with shall be entered in the Register.

(3) Any acceptance of reinstatement shall be published in the Patent Gazette to the extent that it relates to a protected right the extinction of which is officially published.

Section 134. (1) Before a decision is taken, any adverse party in the case shall be given an opportunity to make a submission within a prescribed period (Section 131(3)).

(2) The petitioner shall be ordered to pay the costs of proceedings and of representation incurred by the adverse party in connection with the petition irrespective of whether or not the petition is granted.

**Section 135.** With the acceptance of reinstatement the legal consequences resulting from nonobservance of the time limit shall cease to have effect. The authority shall issue appropriate instructions to give effect to the decision.

**Section 136.** (1) Restoration of a right which has been refused, has lapsed, become extinct or otherwise become inoperative shall not be binding on anyone who in Austria began to use the object of the right or made arrangements for such use (interim user) after the extinguishment of the right and before the day of official publication of restoration (Section 133(3)) or, in the case of Section 133(2), not later than the day when the petition was entered in the Register and in any other case not later than the day when the petition reached the competent authority. Such person may exploit the object of the right for the needs of his own business in his own or another's workshops. Such right may be inherited or otherwise alienated only with the business. Additionally, the provisions governing prior use shall apply.

(2) In the case of a license contract made during the earlier period of validity of a right which has been restored, a licensee whose right is restricted by an interim user (subsection (1)) may request an appropriate reduction of the royalties stipulated or if, owing to the above restriction, he is no longer interested in the continuation of the contract, he may rescind it.

## **Execution**

**Section 137.** (1) Final decisions of the Patent Office and of the Supreme Patent and Trademark Chamber shall give a right to execution within the meaning of Section 1 of the Regulations on Execution.

(2) The Patent Office shall ex officio make the necessary entries and deletions in its registers to give effect to its own final decisions and to those of the Supreme Patent and

Trademark Chamber. In the case of collective decisions of the Patent Office, the chairman shall issue the necessary instructions; in the case of decisions of the Supreme Patent and Trademark Chamber, this shall be done by the chairman of the Nullity Division. This provision shall also apply to reimbursement of the fees under Section 168(3).

### **Appeals**

**Section 138.** (1) Any party aggrieved by a final decision of the Nullity Division of the Patent Office may appeal to the Supreme Patent and Trademark Chamber. Such appeal shall have a delaying effect.

(2) There shall be no separate remedy against the decisions of the Nullity Division in the course of the preliminary proceedings or of the hearing. Such decisions may be contested by appeal to the Supreme Patent and Trademark Chamber only if they have affected the final decision (Section 70).

(3) The appeal shall be lodged in writing with the Patent Office within two months after the decision has been served. It shall contain a request for review with a statement of reasons.

(4) The appeal and its attachments shall be submitted in duplicate. Where the appeal is directed against several adverse parties, in addition to the copy intended for the Supreme Patent and Trademark Chamber, a copy of the appeal and its attachments shall be provided for each of the adverse parties.

**Section 139.** (1) For all matters within the responsibility of the Patent Office concerning appeals to the Supreme Patent and Trademark Chamber, the Nullity Division shall be competent. Its decisions, which shall be taken in camera, shall be deemed final.

(2) Where an appeal lodged in time and containing a substantiated request for review has formal defects, the legally qualified rapporteur of the Nullity Division shall impose a time limit for amendment on the appellant. If the defects are remedied within the period prescribed, the appeal shall be considered lodged in due form.

(3) Appeals lodged out of time or those not containing a substantiated request for review or not amended within the period prescribed according to subsection (2) shall be dismissed by the Nullity Division.

(4) In all other cases, the legally qualified rapporteur shall send a copy of the appeal document to the party opposing the appeal with the indication that he is free to file a rebuttal of the appeal within two months.

(5) Where the rebuttal of the appeal has been filed in time, or after expiration of the two-month period without such a rebuttal having been filed, the files shall be submitted to the Supreme Patent and Trademark Chamber by the legally qualified rapporteur.

### **Proceedings before the Supreme Patent and Trademark Chamber**

**Section 140.** (1) Unless otherwise provided hereunder. Sections 113 to 127 and 129 to 136 shall apply mutatis mutandis to proceedings before the Supreme Patent and Trademark Chamber.

(2) The Supreme Patent and Trademark Chamber shall not take further evidence.

(3) If the Supreme Patent and Trademark Chamber finds that the Nullity Division has infringed procedural provisions thereby preventing a decision according to law or if the

Chamber considers further evidence essential, it shall refer the case back to the Nullity Division.

**Section 141.** If the appeal has formal defects which have not been raised in accordance with Section 139(2), the rapporteur shall set a time limit for the appellant to remedy such defects.

**Section 142.** (1) The Supreme Patent and Trademark Chamber shall render its decision without preliminary proceedings and without a hearing in the following cases:

1. where the formal defects of the appeal have not been remedied within the period prescribed under Section 141;
2. where the appellant is not entitled to lodge the appeal;
3. where the appeal ought to have been dismissed by the Nullity Division (Section 139(3));
4. where the appeal is against decisions under Sections 113 and 139(3);
5. where the appeal is against a decision regarding a petition for reinstatement (Section 130(2));
6. where the appeal is solely against a decision regarding reimbursement of costs (Section 122);
7. where the appeal is solely based on the claim that an infringement of procedural provisions has prevented a decision according to law or where the documents in the file show that the case must be referred back to the Nullity Division because of the infringement of such procedural provisions.

(2) Where no final decision regarding an appeal is to be rendered, a decision may also be taken internally in writing a meeting of the Chamber if the chairman regards a meeting as unnecessary because of the simplicity of the case. If, in these circumstances, a member of the Supreme Patent and Trademark Chamber expresses an opinion differing from the rapporteur's proposal, a meeting shall in any event be held.

**Section 143.** (1) If a party waives his claim to a hearing and, if the adverse party does not insist on a hearing within a period prescribed by the rapporteur and if the chairman does not consider a hearing essential, the case shall be decided in camera.

(2) After the case has been called, the hearing shall begin with the reading of the rapporteur's written report. The report shall contain a statement of the principal facts, the content of the appeal and the reply to the appeal; it shall, however, express no opinion as to the decision to be made.

(3) Subsequently, the appellant and then the adverse party shall be heard. The adverse party shall in any event be entitled to the last word.

(4) The decision shall be rendered only by those members of the board who took part in the hearing on which the decision was based. If there is a change in the membership of the board before a decision is rendered, there shall be a rehearing before the reconstituted board.

**Section 144.** The appeal may be withdrawn before the end of the hearing. If the appeal is withdrawn before the hearing, the adverse party shall, if necessary, be allowed a period in which to substantiate a claim to reimbursement of his costs. If no costs are recorded, the

rapporteur shall terminate the proceedings. In all other cases, decisions regarding the close of proceedings and the claim to reimbursement of costs, if any, shall be taken in camera.

**Section 145.** (1) The Supreme Patent and Trademark Chamber shall render its decision and draw up its statements of reasons by an absolute majority. The chairman shall preside over the deliberations and the vote. He shall take part in the vote like any other member of the board. After the statement of the facts and proposals by the rapporteur and joint rapporteurs, if any, the chairman shall call upon the voting members to speak in the order in which they have asked for the floor. At the end of the deliberation, he shall put the proposals made to a vote. The chairman shall determine the questions and the order in which they are put to a vote. A member may not refuse to participate in the vote even where he was in the minority over a preliminary question. Before the end of the meeting, any voting member may change his vote.

(2) The result of the vote shall be recorded by the registrar and shall be signed by the registrar and the chairman. Any voting member may have the reasons for his opinion included in the record of the vote if his opinion was not incorporated in the decision.

(3) The rapporteur shall draw up the judgment to be issued on the basis of the decisions taken. If his views were those of the minority, the chairman may assign the preparation of the text or parts thereof to other members of the board. The chairman shall check the judgment prepared to ensure its conformity with the decisions taken.

#### **IV. INFRINGEMENT OF PATENTS AND OBLIGATION TO PROVIDE INFORMATION**

##### **Right to Demand an Injunction**

**Section 147.** (1) Any person who has suffered an infringement of one of the rights belonging to him under a patent or who worries that such an infringement might take place may sue for an injunction.

(2) Injunctions may be issued even where the conditions specified in Section 381 of the Code of Dstraint are not met. The court may, upon good cause shown, withdraw an injunction issued by it if the defendant provides adequate security.

##### **Claim for Elimination**

**Section 148.** (1) The patent infringer shall be obliged to eliminate the circumstances constituting the violation of the Law. The injured party may in particular demand that, at the expense of the infringer, the objects infringing the patent be destroyed, and that the implements, machinery and other means having served solely or mainly for the manufacture of the infringing objects be rendered unusable, insofar as the rights in rem of third parties are not thereby infringed.

(2) Where the infringing objects or infringing means specified in subsection (1) above contain parts of which the continued existence and use by the defendant do not infringe the exclusive right of the plaintiff, the court shall specify those parts in the judgment ordering them to be destroyed or rendered unusable. In the execution of the judgment these parts shall, as far as possible, not be destroyed or rendered unusable if the guilty party pays the cost associated therewith in advance. If it becomes apparent in the course of execution that greater costs would be incurred by making the means of infringement unusable than by destroying them, and if those costs have not been paid in advance by the guilty party, the Court of Execution shall, after having heard the parties, order the destruction of the means of infringement. If the patent-infringing circumstances can be eliminated in another way, which involves no or less destruction of assets, the injured party may request only measures of that kind. The injured party may, instead of demanding that the infringing objects be destroyed or

the means of infringement rendered unusable, demand that the infringing objects or means of infringement be handed over to him by their owner in exchange for adequate compensation not exceeding the cost of their manufacture.

(3) Execution in matters of elimination shall, where necessary, take place in the presence of an expert who shall specify the objects to be included in the said execution.

### **Publication of the Judgment**

**Section 149.** (1) In a suit for injunction or elimination, the court shall on request grant the successful party, if the latter has a legitimate interest therein, the right to have the judgment published at the expense of the opposing party within a period to be specified in accordance with Section 409(2) of the Code of Civil Procedure. The scope and nature of the publication shall be specified in the judgment.

(2) The publication shall comprise the judgment. However, at the successful party's request, the court may determine contents of the publication different in scope or wording from or supplementing the judgment. Such request shall be filed not later than four weeks after the judgment becomes final at the latest. Unless the request has been submitted before the end of the hearing, the court of first instance shall decide on it after the judgment has become final.

(3) The court of first instance shall, at the request of the successful party, specify the costs of the publication of the judgment and order the opposing party to repay them.

### **Monetary Claims**

**Section 150.** (1) The injured party in a case of unauthorized use of a patent shall have a claim on the infringer of appropriate monetary compensation.

(2) In cases of willful patent infringement the injured party may demand, in the place of appropriate compensation (subsection (1)):

(a) damages, including the profits of which he has been deprived; or

(b) surrender of the profits realized by the infringer through the patent infringement.

(3) The injured party shall also have a claim of appropriate compensation for damages not consisting in any monetary loss (subsection (2)) suffered as a result of the willful patent infringement insofar as this is justified by the special circumstances of the case.

### **Accounting**

**Section 151.** The infringer shall be obliged to draw up accounts for the benefit of the injured party and to have their accuracy verified by an expert. Where such verification reveals a higher amount than that resulting from the accounts, the cost of the verification shall be borne by the infringer.

### **Employer's Liability**

**Section 152.** (1) An injunction (Section 147) may be sought against the owner of an enterprise when a patent infringement has been committed or is likely to be committed by a person working for him or on his behalf in the course of the activities of the enterprise. He shall be liable to measures of elimination (Section 148) if he is the owner of the infringing objects or the means of infringement.

(2) Where the patent infringement on which a claim of appropriate compensation is based has been committed by a person working for or on behalf of an enterprise in the course of the latter's activities, the obligation to pay compensation (Section 150(1)) and to draw up accounts (Section 151) shall affect only the owner of the enterprise, except where the said owner neither was aware of nor derived a profit from the patent infringement.

(3) Where a person working for or on behalf of an enterprise infringes a patent in the course of his work for the latter, the owner of the enterprise shall be liable in accordance with Section 150(2) and (3), without prejudice to any liability of the person for damages, when the patent infringement was or should have been known to the said owner.

### **Liability of Several Persons**

**Section 153.** Where the same monetary claim (Section 150) is brought against several persons, they shall be jointly and severally liable.

### **Prescription**

**Section 154.** Section 1489 of the Civil Code shall apply to all monetary claims (Section 150) and the claim to the drawing up of accounts (Section 151). The running of the period of prescription shall also be interrupted by an action for the drawing up of accounts or a petition for declarations under Section 163.

### **Process Patents**

**Section 155.** In the case of a patent for a process for the manufacture of a new product, any product with the same characteristics shall, pending proof to the contrary, be regarded as having been manufactured according to the patented process.

### **Preliminary Questions**

**Section 156.** (1) The validity or effectiveness of a patent on which an infringement action is based may be judged separately by the court as a preliminary question, subject to subsection (3) below.

(2) The court of first instance shall send to the Patent Office in respect of every judgment ruling on the validity or effectiveness of a patent a copy confirming the legal force of the decisions, for attachment to the patent grant files. A notation shall be made in the Patent Register concerning such a judgment.

(3) Where a judgment is contingent on whether the patent is void (Section 148), the court shall suspend the proceedings unless nullity must obviously be denied. If the defendant does not, within one month from the service of the decision to suspend, prove that he has filed a nullity petition with the Patent Office, that nullity declaration proceedings between the parties to the dispute are already pending, or that he has engaged in such proceedings as intervening third party, the court shall resume the proceedings at the request of the plaintiff. In that case, the court shall decide without regard to the claim of nullity, provided that any decision of the Nullity Division pronounced before the completion of the hearing shall be taken into consideration.

(4) Where the court proceedings have been suspended on account of proceedings pending before the Patent Office, the court shall, after the decision on the preliminary question has come into full legal force, resume the proceedings at the request of one of the parties on the basis of the decision on the preliminary question.



(5) If the Patent Office or the Supreme Patent and Trademark Chamber has passed a different decision on the validity or effectiveness of a patent than the court in infringement litigation, an action for a re-trial (Section 530(1) of the Code of Civil Procedure) may be based on it: Section 532(2) of the Code of Civil Procedure in respect of jurisdiction and Section 544(1) of the Code of Civil Procedure in respect of the suspension of the proceedings on appeal shall apply mutatis mutandis: the time for institution of proceedings (Section 534(1) of the Code of Civil Procedure) shall begin to run as from the date on which the decision on the validity or effectiveness of the patent has become final.

#### Treatment of Prejudicial Proceedings by the Nullity Division and the Supreme Patent and Trademark Chamber

**Section 157.** (1) Where a decision to suspend (Section 156) is filed with the Nullity Division the following particulars shall apply to the procedure as from such filing:

1. The procedure shall be handled rapidly.
2. The receiving department shall immediately confirm to the party having filed a suspension decision, by means of the certifying copy of the relevant notification (Halbschrift), that he has initiated proceedings before the Nullity Division, has engaged in pending proceedings as intervening third party, or has filed a decision to suspend in relation to proceedings in progress.
3. The reply (Section 115(2)) shall be filed within a period of one month, which may not be extended.
4. Proof of statements that have not been submitted to the Patent Office and communicated to the opposing party not later than two weeks prior to the hearing may only be taken into consideration if the opponent has no objection thereto.
5. The periods for appeal (Section 138) and for the response to the appeal shall be one month and may not be extended.

#### Provisional Patent Protection

**Section 158.** (1) Infringement proceedings may also be instituted in the case where a patent has in fact not yet been granted for an invention which is worked without authorization but where the legal effects of the patent have in the meantime begun to operate within the meaning of Section 101. In such case, the period referred to in Section 156(3) shall not begin to run before the date on which the defendant has received from the plaintiff a copy of the decision by which the patent was granted with full legal effect. In the case of the grant of a patent under Section 107, there shall instead be sent a duplicate set of the application documents laid open for public inspection (Section 101(3)).

(2) Injunctions under Section 147(2) may not be issued before the entry into full force and effect of the patent grant.

#### Willful Patent Infringement

**Section 159.** (1) Any person who infringes a patent shall be condemned by the court to a fine of up to 360 times the per diem rate for calculating fines.

(2) The same penalty shall be imposed on the owner or director of an enterprise who does not prevent the infringement of a patent committed by a person working for him or on his behalf in the course of the activities of the enterprise. Where the owner of the enterprise is a legal entity, this provision shall apply to the bodies of the enterprise that have failed to

prevent such infringement. The enterprise shall be jointly and severally liable with the guilty party for the fines inflicted on the bodies.

(3) Prosecution shall take place only at the request of the injured party.

### **Claims under Private Law**

**Section 160.** The assertion of claims under Section 150 shall be subject to the provisions of Title XXI of the Code of Criminal Procedure, 1975, Federal Law Gazette No. 631, as amended. Both parties shall be entitled to appeal against the decision on the claim for compensation.

### **Characteristics of Criminal Prosecution**

**Section 161.** Criminal prosecution shall be governed by Sections 148, 149, 157 and 158, mutatis mutandis, and also by Section 156 with the following derogations: the period of one month under Section 156(3) shall begin to run on the date on which the criminal court calls upon the guilty party to certify that he has filed a petition for nullity with the Patent Office, that nullity declaration proceedings are already pending between the parties to the dispute, or that he has engaged in such proceedings as intervening third party. If the guilty party does not file the petition for nullity in time, the court shall, where it considers nullity of the patent to be possible, make the petition for nullity ex officio. The parties in such proceedings shall be the court making the petition, the private plaintiff and the guilty party: the costs arising in the course of such proceedings shall be deemed costs of the criminal proceedings.

#### **Jurisdiction**

**Section 162.** (1) The Commercial Court of Vienna shall have exclusive jurisdiction for actions and injunctions under this Federal Act. The board (Section 7(2) first sentence, Section 8(2) of the Rules of Jurisdiction) shall decide irrespective of the value of the matter in dispute. The same shall apply to injunctions.

(2) Jurisdiction in criminal matters under this Federal Act shall belong to the Vienna Provincial Court for Criminal Matters.

### **Petitions for Declaratory Decisions**

**Section 163.** (1) Any person who produces industrially, who puts on the market, offers for sale or uses an object, applies a process on an industrial scale or intends to take such steps may apply to the Patent Office for a declaration against the owner of the patent or the exclusive licensee, stating that the object or the process is not covered either completely or partly by the patent.

(2) The owner of a patent or the exclusive licensee may apply to the Patent Office for a declaration against any person who produces industrially, puts on the market, offers for sale or uses an object, applies a process on an industrial scale or intends to take such steps, which declaration shall state that the object or the process is covered either completely or partly by the patent.

(3) Petitions under subsections (1) and (2) shall be rejected if the party opposing the petition proves that an infringement action concerning the same object or process, filed prior to the filing of the petition for a declaratory decision, is pending before the court between the same parties.

(4) The petition for a declaratory decision may relate to only one patent, including any patent of addition. The petition shall be accompanied by an accurate and clear description of

the object or process, and drawing where necessary, in four copies. One copy of the description, and of the drawings if any, shall be attached to the final decision.

(5) When judging the scope of protection of the patent which is the subject matter of the declaration proceedings the Patent Office shall take into account the contents of the files of grant and the prior art proved by the parties.

(6) The cost of the proceedings shall be borne by the petitioner if the opponent has not provoked the petition by his conduct and recognizes the claim within the period allowed him for his reply.

(7) In all other respects, the provisions on the procedure for challenge shall apply to the declaration procedure.

### **Obligation to Provide Information Regarding Patent Protection**

**Section 165.** Any person who designates products in a manner likely to give the impression that they enjoy patent protection shall on request provide information regarding the patent on which such designation is based.

## **V. FEES**

### **Application Fee and Annual Fees**

**Section 166.** (1) For every patent an application fee of € 50.- shall be payable on filing.

(2) In addition, an annual fee shall be payable for each patent in proportion to the duration of protection requested.

(3) The annual fee shall be:

€uro

for the first year                      € 65.-

plus a fee of € 25.- for the sixth and every subsequent page of the specification and patent claims laid open to public inspection and €25.- for the third and every subsequent sheet of the drawings attached.

for the second year                      € 65.-

for the third year                      € 72.-

for the fourth year                      € 94.-

for the fifth year                      € 101.-

for the sixth year                      € 138.-

for the seventh year                      € 174.-

for the eighth year                      € 247.-

for the ninth year                      € 305.-

for the tenth year	€ 370.-
for the eleventh year	€ 465.-
for the twelfth year	€ 523.-
for the thirteenth year	€ 581.-
for the fourteenth year	€ 850.-
for the fifteenth year	€ 1,068.-
for the sixteenth year	€ 1,162.-
for the seventeenth year	€ 1,453.-
for the eighteenth year	€ 1,744.-
for the nineteenth year	€ 1,744.-
for the twentieth year	€ 1,744.-

(4) For patents of addition which are not declared independent patents (Sec. 28) a single annual fee shall be paid for the entire period of validity: this fee shall be € 327.- plus € 25.- for the sixth and every subsequent page of the specification and patent claims laid open to public inspection and € 25.- for the third and every subsequent sheet of the drawings attached.

(5) The annual fees shall be payable from year to year in advance, from the day when the application was published in the Patent Gazette (Section 101). Where, however, the patent is granted with legal effect only after the beginning of the second or any subsequent year, counted from the day when the application was published in the Patent Gazette, the annual fees for these years shall be payable on the day after the patentee has been notified of the patent's entry in the Patent Register.

(6) The first annual fee shall be paid within four months of the date of publication of the application in the Patent Gazette (Section 101), failing which the application shall be deemed withdrawn.

(7) The second and subsequent annual fees may be paid three months before the due date. They shall be paid not later than six months after the due date. Whenever payment is made after the due date, a surcharge of 20 percent of the annual fee shall also be paid. There shall be no surcharge for annual fees which do not become due until notice has been given of the entry of the patent in the Patent Register (subsection (5)).

(8) Payment of annual fees may be made by any person interested in the patent.

(9) The application fee shall not be refunded. Half of the first annual fee shall be refunded if the application is withdrawn or rejected after publication in the Patent Gazette (Section 101). Any other annual fees which have been paid but have not yet become due shall be refunded if the patent is waived, revoked or declared null and void.

(10) The number of pages of the specification and patent claims laid open to public inspection and the number of sheets of drawings attached in accordance with subsections (3) and (4) shall be calculated as follows:

1. up to 40 lines shall be counted as a page;
2. representations of formulae shall be counted as full lines in accordance with the area they occupy on the page;
3. incomplete pages shall be counted as full pages;
4. an area with maximum dimensions of 34 cm by 22 cm shall be counted as a sheet.

### **Procedural Fees**

**Section 168.** (1) The following procedural fees shall be payable:

**Euro**

1. for the filing of opposition (Section 102) € 58.-
2. for the filing of an appeal (Section 70) where there is no adverse Party € 65.-  
Where there is an adverse party € 188.-
3. for any petition to be dealt with by the Nullity Division € 210.-
4. for an appeal (Section 138) € 319.-
5. (a) for a petition for entry of the right of prior user (Section 2.3 (4)), a petition for entry of an assignment (Section 33(2) and (3)), in the case of transfer inter vivos, a petition for entry of a license or the transfer of a license (Sections 35 to 37) or a petition for any of the entries in the Patent Register provided for in Section 43 € 58.-  
(b) for an application for an entry relating to a dispute in the Patent Register (Section 45) € 23.-  
(c) for a petition for an extension of the time limit set for the submission of a case in reply to the preliminary decision (Section 99 (4)) € 12.-  
(d) for a petition for suspension of publication and laying open of a patent application (Section 101(4)), where the duration of suspension requested exceeds three months, for every subsequent

three-month period, periods of less than three months being  
counted as full three-month periods      € 58.-

6. (a) for a request for the carrying out of a search under Section

57a (1)      € 159.-

(b) for a request for the preparation of an expert opinion under  
Section 57a (2) where the state of the art is indicated by the  
applicant      € 159.-

(c) for a request for the preparation of an expert opinion under  
Section 57a (2) where the state of the art has to be assessed  
by the Patent Office      € 239.-

(2) The fees provided for in subsection (1)2 to 5 shall be paid for every application and every patent which is the subject of the appeal or petition.

(3) The fee for an appeal (subsection (1)2 shall be refunded if the appeal is essentially successful and if the proceedings have been conducted without an adverse party. Half of the fees provided for in subsection (1)3 and 4 shall be refunded if the petition to be dealt with by the Nullity Division or the appeal is dismissed or the proceedings are terminated without any hearing. Half of the fees provided for in subsection (1)5 shall be refunded if the petition is withdrawn before a decision is taken. If, in the case of subsection (1)5(d) suspension is not granted for the entire duration applied for and if an amount less than that paid is due for the duration approved, the excess amount shall be refunded. The amount of € 116.- shall be refunded on the fee fixed in subsection (1)6(a) and (b) and the amount of € 196.- shall be refunded on the fee fixed in subsection (1)6(c) if the petition is rejected or withdrawn before the date of service of the expert opinion.

(4) Special fees for official publications, certifications, extracts from the Register. Letters Patent, priority documents and official certificates may be laid down by ordinance. In the determination of the fees for each particular case, which shall not exceed € 23.-, account shall be taken of the labor and material required for the official service involved. To the extent to which fees depend on the number of pages or sheets. Section 166(10) shall apply.

(5) Petitions for official publications and petitions which may be accepted only after official publication under this Act shall be refused if the relevant fees are not paid in time.

### **Method of Payment of Fees**

**Section 169.** The method of payment of the fees charged within the jurisdiction of the Patent Office as well as the type of the proof of payment shall be laid down by ordinance, which shall specify in particular when any payment is deemed to have been made in time. The ordinance shall be so framed as to take into account, on the one hand, methods of payment available other than payment in cash and, on the other hand, the need for simple and economical verification by the Patent Office.

### **Stamp Duty**

**Section 170.** Letters patent issued under this Act shall be exempt from stamp duty. In all other respects the provisions regarding stamp duty and direct charges shall remain unaffected.

### **Exemption from Payment of Fees**

**Section 171.** (1) The President of the Patent Office shall, on request, grant a respite for payment of the application fee and of the annual fee for the first, second and third years, or of some of these fees, up to the due date for the second, third or fourth annual fees if the applicant proves that he is without means or files a petition the evident purpose of which is the production or saving of energy. In such cases, the grant of the patent applied for must not appear without prospect of success. The fees in question shall be cancelled if the patent expires by the end of the third year of the period of protection. Failure to pay the deferred application fee shall cause the patent to expire, according to the period of respite granted, at the end of the first, second or third year of protection. These provisions shall also apply to the application fee and the annual fees for patents of addition. The period to be taken into consideration begins on the day of publication of the application for a patent of addition in the Patent Gazette (Section 101).

(2) The President of the Patent Office shall cancel the fees provided for in Section 168 (1)1 to 4 and 5(c) and (d) if the applicant proves that he is without means and if the petition or the remedy for which the fee would be payable is not clearly frivolous or without prospect of success.

(3) When deciding whether the applicant is without means, the applicant's present or prospective income, his capital and the charges borne by the capital and the number of persons that he is maintaining shall be taken into account.

(4) Where a respite has been granted for payment of a fee under subsection (1), payment of the fees referred to in subsection (2) which would be payable by the applicant during the procedure concerning his application shall be deemed to have been cancelled.

(5) The privilege accorded under subsection (1) shall not pass to the beneficiary's successor in title. Where there are several patent applicants or several parties to a dispute, the respite may be granted only if the requirements are fulfilled by all parties concerned.

### **Change in the Amount of the Fees**

**Section 172a.** (1) If the provisions of this Federal Act concerning the amount of fees are changed, the new provisions shall apply, irrespective of subsections (2) and (3), to all payments which are made after the entry into force of these provisions, or which are paid before the entry into force of these provisions, but which are intended for petitions which are submitted after the entry into force of these provisions.

(2) The first annual fee and the annual fee for patents of addition shall be paid in the amounts as indicated in the respective decisions pursuant to Sec. 101(1).

(3) Fees for the payment of which a respite is granted shall be payable in the amount in force at the time the respite was granted.

## **VI. FINAL PROVISIONS**

**Section 172b.** (1) In as far as this Federal Act refers to provisions of other federal laws, the latter shall be applicable in the currently valid versions unless otherwise indicated.

(2) 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.

**Section 172c.** The form chosen in this Federal Act for all designations referring to persons shall to both sexes.

**Section 173.** The following shall be responsible for the implementation of this Act:

1. in the case of Section 51, the Federal Government;
2. in the case of Sections 49(4) and Sections 147 to 156, Section 158 to 162, 162 and 165, the Federal Minister of Justice;
3. in the case of Section 74(2) and (3), insofar as it relates to the appointment of judges, and also in the case of Section 126, the Federal Minister of Economic Affairs and the Federal Minister of Justice;
4. in the case of Sections 56 and 170, the Federal Minister of Economic Affairs and the Federal Minister of Finance;
5. in the case of Section 168(4), the Federal Minister of Economic Affairs in agreement with the Federal Minister of Finance;
6. in the case of Section 57(2) the Federal Minister of Economic Affairs in agreement with the Federal Minister of Foreign Affairs;
7. in the case of all other provisions of this Act, the Federal Minister of Economic Affairs.

**Section 173a.** (1) Section 2 para. 2, Sections 3, 4 subsec. 1, Sec. 48 subsec. 1, para. 2 to 4, Sec. 48 subsec. 3, Sec. 62 subsec. 4 para. 2, Sec. 92 a subsec. 4, Sec. 102 subsec. 2 para. 2 to 7. Sec. 102 subsec. 3 and Sec. 106 in the wording valid before the entry into force of the Federal Act Federal Law Gazette No. 634/1994 shall continue to be applicable to patents and patent applications filed before January 1, 1994.

(2) For the term and expiry of patents based on patent applications filed prior to December 1<sup>st</sup>, 1984, article VI of the 1984 Patent Law amendment, Federal Law Gazette no. 234/1984 shall continue to apply, but the term of these patent shall be at least 20 years after application. For patents for which the due date for paying of the annual fee for the 19<sup>th</sup> year falls between January 1<sup>st</sup>, 1996 and June 30, 1996 no extra fee shall be payable upon payment after the due date. Rights to which claims were made by the military and monopoly administrations according to sections 24 and 25 prior to January 1<sup>st</sup>, 1996, sections 24, 25 and 173 (3) shall be applied in the version effective prior to January 1<sup>st</sup>, 1996.

**Section 174.** (1) The Sections 21, 60 subsec. 4 and 5. Sec. 64 subsec. 3 and 4. Sec. 68, 78 subsec. 1, Sec. 79, 89 subsec. 1. Sec. 90, 94 subsec. 2, Sec. 99 subsec. 5, Sec. 166 subsec. 3 and 4, Sec. 168, 169, 171 subsec. 2, the title of Sec. 172 a, Sec. 172 a, the title of Part VI as well as Sec. 173 in the wording of 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) Sec. 167 shall cease to be in force as of the end of the third month following the promulgation of the Federal Act Federal Law Gazette No. 418/1992.

(3) Sec. 4 subsec. 3. Sec. 21, Sec. 48 subsec. 1 para. 2, Sec. 50, Sec. 77, Sec. 81 subsec. 3. Sec. 90, Sec. 91 a subsec. 1, the title of Sec. 92 b, Sec. 92 b, Sec. 102 subsec. 2 para. 2



to 4 as well as Sec. 192 subsec. 5 in the wording of the Federal Act Federal Law Gazette No. 211/1994 shall enter into force as of April 1, 1994.

(4) Sections 22 and 28, subsection 1, sections 36, 37 and 47, subsection 1, Section 80, subsection 1, Section 81, subsection 7, Sections 110 and 112, subsection 2, Section 137, subsection 2, Sections 155 and 166, subsection 3, Section 173 Z 2 to 7 and Section 173a in the version as published in Federal Law Gazette no. 181/1996 shall enter into force as of January 1<sup>st</sup>, 1996.

(5) Sections 24, 25, the heading of section 29, the headings of Section 38, Sections 38 to 42 and 47, subsection 3, Section 110, subsection 2, the headings of Section 164 and Sections 164, 172 and Section 173, Z 3 shall be abrogated as at December 31, 1995.

(6) Section 3, subsection 2, section 58, subsection 2, sections 58a and 60, subsection 3, lit.d, section 61, subsection 6, section 62, subsection 4, Z 3 to 5, section 64, subsection 3 to 5, section 70, subsection 5, section 81, subsection 4, sections 93a, 93b and 94, subsection 1, section 95, subsection 1, section 166, subsection 2, sections 172b and 172c, and section 173 Z 2 in the version of the Federal Act, Federal Law Gazette I, No 175/1998 shall enter into force as of the beginning of the second month following the promulgation of the Federal Act, Federal Law Gazette I No 175/1998. Simultaneously, section 62, subsection 4, Z 3 in the version valid until now and section 110 including the heading shall cease to be in force.

(7) Section 36, subsection 4 in the version of the Federal Act, Federal Law Gazette I, No 175/1998 shall become effective on January 1, 1996.

(8) Section 78, subsection 1, Section 82, subsection 2, Sections 83, 120, subsection 5, Section 166, subsection 1, 3 and 4 and Section 168, subsection 1,3, and 4 in the version of the Federal Act Federal Law Gazette I, No 143/2001 shall become effective on January 1, 2002.