

Protection of IP

Austria

TRADE MARKS**1.1. INTRODUCTION**

Austria implemented the European Trade Marks Directive with the amendment of the “Austrian Trademark Protection Act” (*Markenschutzgesetz*). As a result, Austria has a modern trade mark protection system which incorporates European laws and the important international treaties for the protection of trade marks.

Only registration of a trade mark guarantees the owner full protection against trade mark infringement. Unregistered trade marks are only protected if the owner is able to prove priority and trade mark acceptance in the relevant business sector, which can be a difficult burden of proof. In cases of unfair competition, registered and unregistered trade marks are also protected under the provisions of the “Austrian Law Against Unfair Competition“ (*Gesetz gegen den unlauteren Wettbewerb*).

So, if one uses a registered business name, a sign, a special trading style, a company logo or any other detail of a brand in commercial use knowingly without permission of the owner and, additionally, there is danger of confusion with the brand name and/or any other component of the registered trade mark, then the owner of the trade mark can apply for an order to prevent such unauthorised user ceases such unauthorised use and furthermore demand compensation for all damages related to the trade mark infringement.

1.2 REGISTERED TRADE MARKS

According to the definition of the “Austrian Trademark Protection Act”, trade marks are signs that serve to distinguish goods or services of their owner from those of other enterprises.

Any sign which can be presented in a graphic way can be registered as a trade mark. This definition covers words (including personal names), designs, letters, figures, and all other signs which have a distinctive character to identify goods and services of enterprises. It also includes colours, smells, sounds, and 3D-trademarks.

According to Austrian trade mark law there are absolute and relative grounds for refusal of an application for registration. An absolute obstacle to trade mark registration is the official character of a sign or the fact that its use is customary - meaning that signs or names that are commonly used in everyday language or in commerce to denote certain types of goods or services are excluded from registration.

Among the relative grounds for refusal, a “lack of distinctiveness” in comparison to other brands (or branding components) was explicitly added to the Austrian Trademark Protection Act in 1999. The applicant therefore has to prove that the consumers or dealers of the goods or services in question recognised the mark prior to the application as a sign of origin for the applicant’s goods or services.

Trademark registrations last for an initial period of 10 years and can be renewed for further periods of 10 years thereafter.

2. PROTECTION OF INVENTIONS IN AUSTRIA

2.1 PATENTS

In Austria patents are subject to the provisions of the “Austrian Patent Act 1970” (*Patentgesetz*), which has subsequently been amended several times. The requirements for a national Austrian patent application are identical to those for European patents registered with the European Patent Office. Austria is a member state of the Paris Convention, the European Patent Convention (EPC), the Patent Cooperation Treaty (PCT) and GATT/TRIPs. The Austrian patent law and court proceedings are compliant to the GATT/TRIPs rules. The latest amendment of the Austrian IP Laws in November 2009 removed the annual fees for the first five years after registration for patents and for the first three years for utility models in order to encourage innovation.

A patent may be obtained in Austria by filing a national patent in Austria, by nationalising a PCT application in Austria or by filing a European Patent with Austria being a designated contracting State. Since there is no automatic revocation or invalidity of the national patent once the European patent for Austria is granted, double protection for the same invention is possible.

Once granted, the patent entitles the patentee to prevent third parties from taking unauthorised advantage of his/her invention. The patentee can exclude others from industrially producing the subject matter of the invention, bringing it to market, offering it for sale, using it, importing it or possessing it for any of these purposes.

The “Austrian Patent Act” states that, upon application, a patent may be granted for inventions that:

- (i) are new,;
- (ii) do not form part of the state-of-the-art; and
- (iii) are capable of industrial application.

Applications for a patent are published in the Austrian Official Gazette. Simultaneously, applications are revealed for public inspection at the library of the patent office for four months. During this period, objections may be raised against the application.

Once registered, patents in Austria may be subject to an action for nullity or a claim for withdrawal of the patent. Nullity procedures are of particular importance as they offer a potential defence against patent right infringement.

There are various actions which a patentee may bring against an infringing party. These include applications for injunctions, claims for compensation and actions for accounting.

From the date of application onward, patents are protected for a maximum of 20 years.

2.2 UTILITY MODELS AND TOPOGRAPHY RIGHTS

For inventions that are not open to “classic” patent registration there are two more forms of legal protection:

- (i) A utility model (*Gebrauchsmustergesetz*) is a commercial right for technical inventions. The requirement for inventive step is smaller than for a patent. In contrast to a patent, a utility model application involves no test for novelty, inventive process or commercial applicability – but does include research for the relevant state-of-the-art. The time required to process a utility model application is significantly shorter than for a patent application. A utility model is only valid in the country in which it has been applied for and registered. The maximum duration of protection for an Austrian utility model is 10 years from the date of application.
- (ii) The three-dimensional structure of micro-electronic semiconductor products can also be protected under certain conditions (*Halbleiterschutzgesetz*). These topography rights extend to both the actual topography and the semiconductor product itself. Applications for the protection of topographies are entered in the semiconductor register if all formal requirements are fulfilled, without further research and examination. Protection begins on the day of the first commercial use of the semiconductor product if an application is submitted to the Patent Office within the following two years. For semiconductor products that have not yet been publicly used at the time of the application, protection begins with the application date. Protection lasts for a maximum period of 10 years.

3. INDUSTRIAL DESIGNS

The “Industrial Design Protection Act” (*Musterschutzgesetz*) offers protection for designs. A design is defined as a model for the appearance of an industrial product. For this reason, neither the industrial product itself nor the production procedure or the idea behind the product are protected. On the contrary, it is the appearance of the specific product - meaning the characteristics perceived by the eye – that is protected under the provisions of the Austrian laws.

A design has to be new and also has to have a unique character. Registered Austrian designs are protected for 5 years from the filing of the application. It can be renewed for up to a total term of 25 years.

A party whose design rights have been infringed is entitled to claim interim relief measures, such as cease and desist orders, as well as appropriate compensation for all damages, the surrender of profits and to bring an action for accounting. The person concerned is also entitled to receive information on provenance and channel of distribution of the goods.

4. PROCEDURE

The Austrian Patent Office (*Österreichisches Patentamt*) handles all applications regarding trade marks, patents, utility models, topographies and industrial designs. The Supreme Senate for Patents and Trade Mark Matters (*Oberster Patent- und Markensenat*) handles appeals against the decisions of the Patent Office.

4.1 PATENTS

A patent application must include a description of the invention, an abstract, claims in German and, if necessary, drawings. Two copies must be filed at the Austrian Patent Office.

Patent applications are automatically examined by the Patent Office, without any special request. Decisions of the Patent Office usually take at least six months. During the proceedings, the content of the application is kept secret until the letter of acceptance is issued by the Patent Office and the registration is published.

4.2 TRADE MARKS

The Austrian Patent Office examines every Austrian trade mark application for compliance with formality requirements (e.g. correct classification of the goods and services, power of attorney) and for absolute reasons for refusal of a registration. In addition, the Patent Office automatically carries out a search for similar trade marks in respect of every Austrian application. In Austria, the requirements on registrability of a trade mark are relatively high. It is particularly difficult to obtain a registration on geographic names.

The latest amendment of the “Austrian Trademark Protection Act” of November 2009 will introduce as of 1 July 2010 opposition proceedings so far unknown in Austria. For trade marks which are published after this date, any trade mark holder can file a motivated opposition within a deadline of three months after the publication of the new trade mark.

All other remedies after registration remain the same. A trade mark owner can still file an action for cancellation with the nullity department of the Austrian patent office and, if the younger mark is in use, he may also file a civil action for infringement. If the objective is to stop the use of an identical or similar sign by a third party, a suit has to be brought before the commercial court. Injunctive relief is also available.

The registered trade mark is finally published in the Austrian Trade and Service Marks Gazette.

4.3 REGISTERED DESIGNS

Applications for industrial designs are examined as to whether they meet the formal requirements but not as to novelty and individual character. It takes about 6-9 months to obtain a registration for an industrial design.

4.4 COURTS

As the aim of Patent Office proceedings is the total or partial cancellation of an infringing patent or trade mark, compensation must be claimed in court proceedings. This can be done based on the laws against unfair competition.

Therefore the Patent Office proceedings and civil court proceedings must be seen as completely separate proceedings which may result in different decisions. It has become quite common during recent years to also start criminal proceedings against a potential infringer of a trade mark or patent.

5. COPYRIGHT

Copyright in Austria is governed by the “Austrian Copyright Act” (*Urheberrechtsgesetz*). Copyrights arise without any formal act solely by creation of a relevant piece of work that is legally defined as a personal intellectual creation in the fields of literature, music, the visual arts and film as well as computer programmes. The rights to copy and distribute the work may be assigned to a third party by the author. The duration of a copyright was harmonized within the EU and lasts for 70 years after the death of the author.

Copyright is infringed if an unauthorized person copies a protected piece of work, issues copies of it to the public, performs, shows or plays a work in public or adapts a work without permission.

Legal proceedings may be introduced by copyright collecting societies. In fact, since an amendment of the copyright act in 2006, only copyright collecting societies are entitled to introduce legal proceedings in the name of a film director who has contributed a mandate to such collecting society.

6. GEOGRAPHIC INDICATIONS

Council Regulation (EC) No. 510/2006 grants in all member states of the European Union an protection of geographical indications and designations of origin for agricultural products and foodstuffs. In the Austrian Trademark Protection Act, a specific chapter is dedicated to a bundle of remedies to protect these protected designations of origins (PDO) and protected geographical indications (PGI).

7. DATA PROTECTION

The Data Protection Act (*Datenschutzgesetz 2000*) provides for protection of personal data. Collecting personal data with or without EDP support is inadmissible, if it is not covered by a justified purpose. Data revealing religious believe, political opinion or racial origin and data concerning health or sex life may only be obtained, processed or submitted upon express written consent of the person concerned.

Address publishers and direct marketing enterprises may collect data for their own processing from available public sources (e.g. land register, business register, telephone directories, registers of professional bodies etc.).

The data subject is entitled to demand information on the origin of his or her data. The processor is obliged to provide his information free of charge within eight weeks and – upon request – in writing. Transmission of data is in most cases possible as long as it has not been expressly prohibited by the data subject.

8. DISTANT SELLING AND E-COMMERCE

The Austrian legislation regarding distant selling and e-commerce are mainly addressed to business-customer (b2c) relations. If a b2c contract is concluded via internet, special provisions

of the Consumer Protection Act (*Konsumentenschutzgesetz*) are applicable: The consumer must be informed about the subject of the contract, the amount of the price and its due date of payment, delivery charges and taxes, if any, the right to withdraw, the validity of the offer or the price, the day and place of conclusion of the contract, the minimum term of the contract as well as the name and registered office of the enterprise **prior to concluding the contract**. The consumer is entitled to withdraw from the contract free of charge and without giving any reason within seven days.

If the enterprise has not fulfilled its disclosure requirements, the consumer is entitled to withdraw from the contract three months from the day of conclusion. Consumers must be informed about the right to withdraw in writing. The "Austrian E-Commerce Act" (*E-Commerce-Gesetz*) places the service provider under the obligation to provide certain information on the website as well. This obligation is also applicable for business to business (b2b) selling.

Starting 1 March 2006, sending mass advertisements via e-mail (spamming) is basically prohibited, if the recipient does not give express consent to receive such mails.

Author

Christoph Petsch

Petsch Frosch Klein Arturo
Vienna, Austria

E-mail christoph.petsch@pfka.eu

Tel. +43 1 586 21 80

To contact PLG

Julienne Laveaux
PLG Secretariat
PANNONE LAW GROUP E.E.I.G.
avenue de Sumatra 41
1180 Brussels
Belgium

Tel. +32 2 374 88 46

Fax: +32 2 374 90 61

E-mail plg@plg.be

www.plg.eu.com

Disclaimer

The contents of this article are intended to provide guidance only and should not be taken to constitute legal advice on specific problems. PLG cannot accept responsibility for this information or matters affected by subsequent changes in the law.

Readers are requested to direct their enquiries to the author(s) of the article.

© 2010 Pannone Law Group