

# ACT INTRODUCING PATENT TREATIES 1978

*(Federal Act on the Introduction of the European Patent Convention and the Patent Cooperation Treaty)  
as amended*

## *DEFINITIONS*

### 1.–

For the purposes of this Federal Act:

1. “EPC” means the Convention on the Grant of European Patents (European Patent Convention) signed at Munich on October 5, 1973;
2. “Protocol on Centralisation” means the Protocol on the Centralisation of the European Patent System and on its Introduction, which is an integral part of the EPC under Article 164 thereof;
3. “PCT” means the Patent Cooperation Treaty done at Washington on June 19, 1970;
4. “European patent application” means an application filed under the EPC in which the Republic of Austria is designated as Contracting State, and according to which protection is therefore sought in that State for the invention;
5. “European patent” means a patent granted under the EPC for the Republic of Austria as designated Contracting State;
6. “international application” means an application filed under the PCT in which the Republic of Austria is designated as Contracting State, and according to which protection is therefore sought in that State for the invention on the basis of the said international application;
7. “Patents Act” means the Patents Act (*Patentgesetz*) of 1970, published in the Federal Law Gazette No. 259/1970, as amended.

## *I. PATENT APPLICATIONS AND PATENTS UNDER THE EPC*

### *Filing with the Austrian Patent Office*

### 2.–

Patent applications under the EPC may be filed with the Austrian Patent Office in addition to the offices specified in Article 75(1) (a) of the EPC, in one of the official languages under Article 14 of the EPC, provided that at least the particulars specified in Article 80 (a) to (c) of the EPC are in German, English or French. Applications that do not meet these requirements shall be deemed not to have been filed.

### *Publication and Laying Open for Public Inspection: Information of the Public*

### 3.–

(1) European patent applications published under Article 93 of the EPC shall be laid open for public inspection by the Austrian Patent Office, together with the translation filed for that purpose (Section 4 (2)), until such time as a European patent is granted or the European patent application is rejected or withdrawn. Notice of such action shall be published in the Austrian Patent Gazette (*Österreichisches Patentblatt*), together with a mention of the language in which the European patent application is written. Section 10(1) and (3) of the Patents Act shall apply *mutatis mutandis*.

(2) The European Patent Gazette, published European patent applications and European patent specifications shall be laid open for public inspection at the Austrian Patent Office.

(3) Registers shall be kept of European patent applications and European patents which shall provide the public with rapid and reliable information concerning the protective rights concerned.

### *Rights Deriving from the European Patent Application after Publication: Translation*

#### 4.–

(1) The European patent application shall give the applicant, as from the date of publication under Article 93 of the EPC, a provisional claim to compensation appropriate to the circumstances from any person who has unlawfully made use of the subject matter of the application (Patents Act. Section 22 (1)). The European application shall not benefit from protection under Article 64 of the EPC.

(2) Where the European patent application has not been published in German, the claim under paragraph (1) shall exist only as from the date on which a translation of the patent claims in German, submitted by the applicant, has been published by the Austrian Patent Office in accordance *mutatis mutandis* with the provisions of Section 3 (1) and after payment of the publication fee (Section 22); or has been communicated by the Austrian Patent Office to the user of the subject matter of the application.

### *Translation of the European Patent Specification*

#### 5.–

(1) Where the European patent specification is not issued in German, a German translation of the patent shall be filed with the Austrian Patent Office within three months at the latest after publication of the mention of grant of the European patent in the European Patent Gazette, and a publication fee (Section 22) shall be paid. The Austrian Patent Office shall publish the translation in printed form.

(2) Subsection (1) shall apply *mutatis mutandis* to the submitting of the translation of the European patent specification as amended by a decision of the Opposition Division (EPC, Article 102 (3)).

(3) If the period (subsections 1 and 2) for filing the required translation and for the payment of the publication fee is not complied with, if a publication fee which was paid only in part is not completely paid within the period set for such complete payment, if the payment of the publication fee is not duly proved (Sec. 169 Patents Act) or if other formal defects are not remedied, the European patent shall be deemed never to have had effect *ab initio*.

### *Authentic Version of a European Patent Application and of a European Patent: Correction of the Translation*

#### 6.–

(1) Where a German translation is required under Section 4 or 5, the scope of protection of the European patent application or European patent shall be determined by that translation insofar as the scope of protection resulting from the translation is narrower than the scope of protection in the language of the proceedings. This shall not apply, however, to proceedings for revocation or forfeiture of the patent.

(2) The applicant for or owner of a European patent may request correction of the translation. The correction shall be effective on the date on which it is published by the Austrian Patent Office after payment of the publication fee (Section 22).

(3) The correction shall be published by display in the display hall of the Austrian Patent Office (Section 3 (1)) in the case of patent applications, and by the issue of a print in the case of patents.

(4) A notice of the correction shall be published in the Austrian Patent Gazette.

(5) Where a person appeals against the narrower scope of protection of the German translation of a published patent application, the correction shall also be effective against the appellant when the applicant has communicated the corrected German translation to him.

(6) The correction shall not be effective against a person who, before it became effective, had, in good faith, started to use the subject matter of the European patent application or European patent in Austria, or had made the necessary arrangements for such use (interim user). The rights of the interim user shall be determined by application, *mutatis mutandis*, of the provisions of Section 23 (2) to (4) of the Patents Act. Where a license agreement the scope of which extends to the protected subject matter affected by the correction has been concluded prior to the correction, and where the right of the licensee is adversely affected by the correction, the licensee may demand a reduction appropriate to the circumstances in the remuneration under the license agreement, or may withdraw from the license agreement where the adverse effect is such that he has no further interest in its implementation.

### *Patent Register*

#### 7.–

Entries relating to European patents shall be recorded in a special part of the Patent Register (Patents Act. Section 80) and shall have the same effect as entries in other parts of the Register.

### *Annual Fees Payable to the Austrian Patent Office*

#### 8.–

(1) Annual fees shall be paid to the Austrian Patent Office in respect of European patents for all years following that specified in Article 86 (4) of the EPC.

(2) The amount of the annual fees payable to the Austrian Patent Office under subsection (1) shall be determined pursuant to Section 166 (3) of the Patents Act, subject, however, to the following modifications:

1. for the third year of the term of the European patent the same annual fee as for the first year shall be payable, not taking into account the fees for additional pages of the description and additional sheets of drawings:
2. for the fourth to twentieth years of the term of the European patent the same annual fees shall be paid as for the second to eighteenth years.

(3) Annual fees for each coming year shall fall due on the last day of the month having the same name as the month of the application date.

(4) Annual fees may be paid not earlier than three months prior to their due date. The first annual fee to be paid to the Austrian Patent Office shall be paid within one year of falling due, and subsequent annual fees within six months of falling due.

(5) For payment after the due date, a 20% surcharge shall be paid in addition to the annual fee. This surcharge shall not be payable in respect of the first annual fee to be paid to the Austrian Patent Office when it is paid within three months of falling due.

(6) Annual fees may be paid by any person having an interest in the patent.

(7) Annual fees that are not yet due shall be refunded to the payer when the patent is renounced or lapses for other reasons before the said annual fees fall due.

### *Request for Conversion*

#### 9.–

(1) At the request of the applicant for a European patent, the Austrian Patent Office shall initiate the procedure for the grant of a patent when the European patent application is deemed withdrawn under Article (77 (5) or 162 (4) of the EPC.

(2) Where the request for conversion has been forwarded to the Austrian Patent Office, or has been filed at the Austrian Patent Office if it was to be filed there at the outset, the applicant shall be called upon by preliminary decision (Patents Act. Section 99) to do the following within three months:

- (a) pay the application fee (Patents Act. Section 166(1));

- (b) where applicable, file a German translation of the European patent application as originally filed and also, where applicable, of an amended version on which the applicant wishes to have the granting procedure before the Austrian Patent Office based.
- (3) For patent applications converted in the manner prescribed, the filing date of the European patent application shall be regarded as the filing date under Section 87(2) of the Patents Act.
- (4) Annual fees under Section 166 of the Patents Act shall be paid for the patent granted on the basis of the converted patent application.

### *Grounds for Revocation*

#### **10.–**

(1) European patents may be revoked on the grounds specified in Article 138(1)(a) to (d) of the EPC including Section 48(1)4. Patents Act and may be forfeited on the ground specified in Article 138(1)(e) of the EPC.

(2) Insofar and as long as a reservation in respect of Austria under Article 167(2)(a) of the EPC is effective, European patents may be revoked insofar as they afford protection to chemical compounds as such or to foodstuffs for human beings or pharmaceutical products as such, except where the patent relates to a process for the manufacture or use of a chemical compound or a process for the manufacture of a foodstuff for human beings or pharmaceutical products.

(3) The European patent may also be revoked when it is found that the invention is the subject of an earlier Austrian patent.

### *Suspension of Opposition Procedure*

#### **11.–**

(Constitutional provision) Proceedings before the Austrian Patent Office for the revocation of a European patent shall be suspended *ex officio* where an opposition procedure (EPC, Article 99) relating to the same subject matter is pending or brought before the European Patent Office. The suspended proceedings shall be resumed on request after the opposition procedure has been terminated by a decision having the force of *res judicata* when no decision on the matter at issue has been rendered by the European Patent Office. Otherwise the proceedings shall be discontinued on request or *ex officio*.

### *Infringement Proceedings*

#### **12.–**

Where the prosecution of an infringement action under Section 156(3) of the Patents Act has been suspended the defendant may, instead of submitting proof that he has filed a revocation claim with the Austrian Patent Office, or that revocation proceedings are already pending between the parties, or that he has already joined in such proceedings as an intervening party, submit proof that he has filed opposition to the European patent with the European Patent Office (EPC, Article 99) or is otherwise party to an opposition procedure concerning the European patent that is already pending between the parties to the dispute.

### *Complementary Search by the Austrian Patent Office*

#### **13.–**

(1) Any person may file a request with the Austrian Patent Office for the making of a complementary search in relation to any published European patent application or European patent. The search shall cover such Austrian patent specifications as are not included in the search file of the European Patent Office and shall identify patents issued by the Austrian Patent Office that have an earlier application date than the European patent application or European patent.

(2) The carrying out of a complementary search shall be recorded in the Patent Register. Any person may inspect the search report.

(3) The request for the issue of a search report shall be subject to a fee in the same amount as the application fee (Sec. 166(1) Patents Act). Payment of the fee shall be duly proved (Sec. 169 Patents Act).

### *Transmittal of European Patent Applications to the Austrian Patent Office for Processing*

#### **14.–**

(Constitutional provision) Agreements concerning the processing of European patent applications by the Austrian Patent Office that are concluded under Section IV(1) and (2) of the Protocol on Centralisation between the President of the European Patent Office and the Federal Minister of Commerce, Trade and Industry may specify, among other things, the nature, origin and number of European patent applications to be processed, the period for transmittal, the procedure for calculation of the costs to be refunded to the Austrian Patent Office for the processing of European patent applications and the obligation on the Austrian Patent Office to adhere to the guidelines of the European Patent Office for European searches and examinations.

### *Letters Rogatory*

#### **14a.–**

(1) The Austrian Patent Office shall accept the letters rogatory of the European Patent Office (Art. 131(2) EPC). The letters rogatory shall be answered by the member of the Legal Division responsible under the schedule of responsibilities with the assistance of the legally qualified member responsible for the respective technical field.

(2) The Law on the Scale of Fees. Federal Law Gazette No. 136, as amended shall apply.

## *II. APPLICATIONS UNDER THE PCT*

### *Receiving Office*

#### **15.–**

(1) The Austrian Patent Office shall be a Receiving Office within the meaning of Article 10 of the PCT for applicants who are Austrian citizens or have their residence (headquarters) in the Republic of Austria. Applications shall be filed in German. The priority of applications under the Patents Act may also be claimed.

(2) For every application under subsection 1 a transmittal fee in the same amount as the application fee (Sec. 166(1) Patents Act) shall be paid not later than on the filing date. Payment of the fee shall be duly proved (Sec. 169 Patents Act).

### *Designated Office*

#### **16.–**

(1) The Austrian Patent Office shall be a Designated Office for international applications except where the applicant has applied for the grant of a European patent.

(2) Where the Austrian Patent Office is the Designated Office, the applicant shall file a copy of the international application within the period set therefor in PCT Art. 22 unless it has been transmitted under PCT Art. 20 and, if the Austrian Patent Office is not also the Receiving Office, pay a fee in the same amount as the application fee (Patents Act, Section 166(1)). Where the application is not in German, a German translation shall be filed within the same period.

(3) A decision on the further processing of an international application under Article 25(2)(a) of the PCT shall be taken by the Austrian Patent Office only if a fee in the same amount as the application fee

(Patents Act, Section 166(1)) is paid, and where applicable a German translation of the international application is filed, in due time.

(4) If the timely payment of fees under subsections (2) and (3) has not been duly proved (Sec. 169 Patents Act), an additional time limit of two months shall be set.

### *Elected Office*

#### **17.–**

(1) Where, under Article 31(4)(a) of the PCT, the Republic of Austria is named in the international applications as the Contracting State in which the applicant intends to use the results of the international preliminary examination, and provided he has not applied for the grant of a European patent, the Austrian Patent Office shall be the Elected Office (PCT, Article 2(xiv), and subsections (2) and (3) shall apply.

(2) Where the election is made before expiry of the nineteenth month from the priority date, the Period under PCT, Art. 39(1)(a) shall be decisive for the actions referred to in Section 16(2). This shall not apply, however, when the applicant intends to avail himself of the provisions of Article 37(4)(b) of the PCT.

(3) Examination reports that are not established in German, English or French shall be translated into German according to Article 36(2) of the PCT.

### *International Searching Authority and International Preliminary Examining Authority*

#### **18.–**

(1) (Constitutional provision) The consent to the appointment of the Austrian Patent Office as International Searching Authority (PCT, Article 16(3)(b) or as International Preliminary Examining Authority (PCT, Article 32 (3)) shall be issued by the Federal Minister of Commerce, Trade and Industry.

(2) After the entry into force for the Republic of Austria of the EPC the Federal Minister of Commerce, Trade and Industry may issue his consent insofar as the conditions set forth in paragraph (3) or in the Protocol on Centralisation are met.

(3) (Constitutional provision) The Austrian Patent Office may, by virtue of an agreement between the President of the European Patent Office and the Federal Minister of Commerce, Trade and Industry, be entrusted with the independent carrying out of international searches and international preliminary examinations under the PCT on behalf of developing countries.

(4) (Constitutional provision) The agreements between the Director General of the World Intellectual Property Organization and the Federal Minister of Commerce, Trade and Industry (PCT, Articles 16(3)(b) and 32(3)) shall specify the rights and obligations of the Parties in the carrying out of the international search and international preliminary examination, and in particular the formal undertaking to apply and observe the common rules of international search and international preliminary examination.

### *International Search Fee and International Preliminary Examination Fee*

#### **19.–**

(1) The fee for international search and for all other tasks entrusted to International Searching Authorities by the PCT and the Regulations thereunder ("search fee") shall be in the same amount as the fee for the request for the carrying out of a search under Section 57a(1) of the Patents Act.

(2) Where the international application does not meet the requirement of unity of invention (PCT, Article 3(4)(iii)), the international search report shall be made for the parts of the international application that relate to the invention first mentioned in the claims. For any further invention or group of inventions that are interconnected in such a way as to constitute a single general inventive idea, an additional fee in the same amount as the search fee shall be payable.

(3) Where an international application claims the priority of an earlier international application which has been searched by the Austrian Patent Office as International Searching Authority, 75% of the

search fee paid shall be refunded when the first search report can be used entirely or to an essential extent in the making of the international search report. The same shall apply where reference is made in the international application to an earlier international-type search (PCT, Article 15(5)), and where the international-type search can be used entirely or to an essential extent in the making of the international search report.

(4) The fee for international preliminary examination and all other tasks entrusted to International Preliminary Examining Authorities by the PCT and the Regulations thereunder (“preliminary examination fee”) shall be in the same amount as the fee for the request for the making of an expert opinion under Section 57a(2) of the Patents Act when the state of the art is communicated by the applicant. The fee shall be payable at the same time as the handling fee to be paid to the International Bureau of the World Intellectual Property Organization.

(5) Where the Austrian Patent Office finds that the international application does not meet the requirement of unity of invention and calls upon the applicant to limit the claims or pay additional fees, the amount of the additional fees and the grounds therefor shall be stated. Where the applicant limits his claims to a unified invention or group of inventions, an additional fee in the same amount as the fee for preliminary examination shall be paid for each additional invention or group of inventions that are interconnected in such a way as to constitute a single general inventive idea.

(6) Payment of fees under subsections 1 to 5 shall not be deemed to have been made until it has been duly proved (Sec. 169 Patents Act).

(7) Appeals against decisions on the objection of an applicant to an additional fee set by the Austrian Patent Office under Article 17(3)(a) or 34(3)(a) of the PCT shall be determined by the Appeal Division of the Austrian Patent Office.

*Publication and Laying Open for Public Inspection:  
Information of the Public:  
Rights Deriving from  
Publication of the International Application*

**20.–**

(1) International applications that are published by the International Bureau of the World Intellectual Property Organization under Article 21 of the PCT shall be published and laid open for public inspection by the Austrian Patent Office, together with any translations that may have been filed (Section 21), until such time as a patent is granted or the patent application rejected or withdrawn. Section 101(1) and (3) of the Patents Act shall apply *mutatis mutandis*.

(2) The rights deriving from an international application published under Article 21 of the PCT shall be determined by application *mutatis mutandis* of the provisions of Section 4. This shall be without prejudice to Article 158(1) of the EPC.

(3) The Gazette of the International Bureau of the World Intellectual Property Organization (PCT, Article 55(4)) and published international applications shall be laid open for public inspection at the Austrian Patent Office.

(4) Registers shall be kept of international applications which shall provide the public with rapid and reliable information on those applications.

**III. COMMON PROVISIONS**

*Formal Requirements of Translation*

**21.–**

The formal requirements of a translation or correction of a translation, filed by the applicant under this Federal Act, shall be specified in detail by an order issued by the President of the Austrian Patent Office. Consideration shall be given in the issue of this order to ensuring the greatest possible conciseness and

simplicity and to meeting the requirements of the type of publication of the translation envisaged. Authentication may not be demanded.

### *Fees for the Publication of Translations*

#### **22.–**

(1) A publication fee shall be paid for every publication of a translation or a correction thereof provided for in this Federal Act.

(2) The publication fee shall amount to ATS 1,600 plus ATS 350 for the sixth and for every subsequent page of the translation filed or of the correction thereof as well as ATS 350 for the third and for every subsequent sheet of enclosed drawings. Sec. 166(10) Patents Act shall apply.

(3) Payment of the publication fee shall not be deemed to have been made until it has been duly proved (Sec. 169 Patents Act).

### *Competence to Handle Business: Form Examiners*

#### **23.–**

(1) Competence to handle business connected with European and international patent applications and European patents shall be determined, unless otherwise provided in this Federal Act, by application *mutatis mutandis* of the provisions of the Patents Act.

(2) Employees who are not members of the Patent Office may be authorized, by an order of the President of the Austrian Patent Office, to handle business connected with European and international patent applications, as well as European patents the nature of which business shall be specifically stated, notably examination as to form, insofar as this is appropriate in view of the simplicity of the business and the training of the employees (form examiners /*Formalprüfer*/) affords a guarantee of, orderly handling of the business. Form examiners shall be under the instructions of the member of the Austrian Office staff who is competent according to the distribution of responsibilities. That member may at any time reserve the handling of business for himself or take over business already being handled.

(3) Section 76(1), (4) and (5) of the Patents Act shall apply *mutatis mutandis* to form examiners.

(4) Decisions of form examiners may be appealed against in the same way as those of the competent member of the Patent Office staff. The competent member may grant the legal remedy himself; if he considers that the legal remedy should not be granted or should be granted only partially, he shall submit the appeal to the Appeal Division and state the reasons therefor in his report to it.

### *Complementary Application of the Patents Act*

#### **24.–**

European and international patent applications and European patents, and procedures concerning these protection rights, shall be subject, *mutatis mutandis* and on a complementary basis, to application of the provisions of the Patents Act, in addition to the provisions of the EPC, the PCT and this Federal Act.

## **IV. FINAL AND TRANSITIONAL PROVISIONS**

### *Entry into Force*

#### **25.–**

For European patent applications and patents this Federal Act shall enter into force on the entry into force of the EPC for the Republic of Austria (EPC, Article 169), and for international applications on the entry into force of the PCT for the Republic of Austria (PCT, Article 63).



## *Repeal and Transitional Provisions*

### **26.–**

- (1) (Constitutional provisions) This Federal Act shall be repealed:
1. in respect of applications under the EPC, when the EPC ceases to have effect in the Republic of Austria:
  2. in respect of applications under the PCT, when the PCT ceases to have effect in the Republic of Austria.
- (2) Article 175 of the EPC shall remain unaffected.
- (3) Article 66(2) of the PCT shall remain unaffected.

## *Implementation*

### **27.–**

The implementation of this Federal Act is entrusted to the Federal Government insofar as such implementation is not incumbent on the Federal Minister of Commerce, Trade and Industry and the Federal Minister for Foreign Affairs by virtue of the Federal Ministries Law (*Bundesministeriengesetz*), Federal Law Gazette No. 389.

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