

TRADEMARK PROTECTION ACT 1970

as amended

The term “mark” as used in the text of the laws should be understood as meaning both trademarks in the narrowest sense as well as service marks.

I. GENERAL PROVISIONS

1.–

(1) In this Act “marks” shall mean any special signs used to distinguish, in the course of trade, the goods or services of an enterprise from similar goods or services of other enterprises.

(2) For a decision as to whether a sign fulfills that purpose, all circumstances, particularly the period of use of the sign, shall be taken into account, with due regard to the views in the trade concerned.

2.–

(1) It shall be necessary to enter a mark in the Trademark Register in order to obtain rights therein.

(2) This Federal Act shall apply *mutatis mutandis* to the right to a mark acquired for the territory of Austria on the basis of international agreements. Such marks shall also be examined for compliance with the law (Section 20).

3.–

The right to a mark shall only be granted where the goods and services stated in the list of goods and services can be produced in the enterprise of the applicant or the acquirer; the right shall lapse when the requirement is no longer met.

4.–

(1) The following shall be excluded from registration: signs

1. which consist exclusively

(a) of state coats of arms, national flags or other national emblems or of the coats of arms of Austrian provincial or local authorities;

(b) of official test or guarantee signs which are used in Austria or – pursuant to a notice to be published in the Federal Law Gazette (Section 6(2)) – in a foreign state, for the same goods or services as those for which the mark is intended or for similar goods or services;

(c) of signs of international organizations to which a member country of the Paris Union for the Protection of Industrial Property belongs, insofar as such signs have been promulgated in the Federal Law Gazette. The last sentence of Section 6(2) shall apply to such promulgation;

2. which contain exclusively information in words or pictures as to the place, time or manner of manufacture, as to the nature, purpose, price, quantity or weight of the goods or as to the place, time or method of performance, nature, purpose, price or scope of a service;

3. which are in general commercial use for the designation of certain kinds of goods or services;

4. which contain matter likely to cause annoyance or otherwise are contrary to public order or contain inscriptions or statements that are inaccurate and are apt to mislead the public;

5. which pursuant to the Act on the Protection of New Plant Varieties. Federal Law Gazette No. 108/1993, are registered as designation of a variety for similar goods.

(2) In the case referred to in subsection (1)2., registration shall, however, be admissible where the sign is recognized in the trade concerned as distinctive of the goods or services of the applicant’s enterprise.

5.–

Marks containing a distinctive sign or any other of the signs referred to in Section 4(1)1. as one of their features may, insofar as the use of such sign is subject to statutory restrictions, be registered only after the right to the use of such distinctive or other sign has been proved.

6.–

(1) The state coat of arms, the national flag or any other national emblems or the coat of arms of an Austrian provincial or local authority may not without authorization be used in trade as marks of goods or services or as features of such marks. Nor may the signs referred to in Section 4(1)1.(c) be used without the consent of the competent authority. Similarly, test or guarantee signs may not, without the consent of the authority issuing such signs, be used for the marking, or as feature of such marking, of goods or services for which the sign has been introduced or of similar goods or services.

(2) Subsection (1) shall apply to foreign national emblems and official test or guarantee signs only in the event of an international agreement or of reciprocity and provided that the foreign sign has been promulgated in the Federal Law Gazette. Where such notice does not include a reproduction of the official presentation of the sign, it shall state where the public may have access to such reproduction.

(3) Persons infringing the prohibition (subsection (1)) shall be punished by the district administrative authority by a fine not exceeding 3,000 schillings or with detention for a term not exceeding one month. In aggravating circumstances, the penalties may be imposed concurrently.

7.–

Section 4(1)1. and Sections 5 and 6 shall also apply to representations which are similar (Section 14) to the official presentation of the distinctive or other sign. Approved distinctive or other signs of the kind referred to in Section 4(1)1. may, however, even where they are similar to distinctive or other signs of the same kind (Section 14), be used as features of marks (Section 5) or for the marking of goods or services (Section 6).

9.–

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

10.–

The right to a mark shall not preclude another enterprise from using the same sign to distinguish other kinds of goods and services.

10a.–

(1) The mark shall not entitle its owner to prohibit a third party from using the mark for goods which have been brought on the market in the EEA under that mark by their owner or with his consent.

(2) Subsection (1) shall not apply if it is justified for good reasons that the owner opposes the continued distribution of the goods, in particular if the condition of the goods changes or deteriorates after they have been put on the market.

11.–

(1) In the event of a change of ownership of the complete enterprise, the right to a mark and any license rights pertaining thereto shall pass to the owner, unless otherwise agreed.

(2) The right to a mark may be transferred without the enterprise. Transfer in respect of only part of the goods and services shall not be permissible where such goods and services are identical with or of the same type as the goods and services not transferred.

(3) Until such time as the transfer of the mark has been recorded, the right to the mark may not be asserted before the Patent Office and all communications concerning the mark served on the registered owner of the mark shall have effect with regard to the acquirer of the mark.

12.–

No one may, without the consent of the person authorized, use the name, firm name or special designation of the enterprise of another person for designating goods or services.

13.–

Designation of a mark for goods or services shall mean not only use of the mark on the goods themselves or on articles for which a service has been or is to be performed or which are to be employed for the provision of services, but also use of the mark on containers, wrapping or packaging and in advertisements and commercial stationery.

14.–

Signs shall be “similar” within the meaning of this Act where there is a likelihood of confusion in trade. The fact that one sign consists of words and the other of a device shall not in itself preclude similarity.

II. REGISTRATION, TRANSFER AND CANCELLATION OF MARKS

1. Registration

16.–

(1) The Trademark Register shall be kept by the Patent Office.

(2) Applications for registration of a mark shall be made in writing to the Patent Office. Where a mark does not consist exclusively of figures, letters or words having no pictorial design or claim to particular characters, a reproduction of the mark shall be submitted. The number of reproductions of the mark to be submitted, their nature and dimensions shall be laid down by order.

(3) The application shall indicate the goods and services for which the mark is intended (list of goods and services); more detailed requirements for the list of goods and services and the number of items to be submitted shall be laid down by order.

(4) The orders to be issued by the President of the Patent Office pursuant to subsections (2) and (3) shall take into consideration the requirements of the registration procedure and of the registration, printing and publication of the mark.

17.–

(1) On registration, the following shall be entered in the Trademark Register:

1. the mark;
2. the registration number;
3. the date of the application and the priority claimed, if any;
4. the name of the registered owner of the mark and his representative, if any;
5. the goods and services for which the mark is intended, arranged in accordance with international classes (Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, Federal Law Gazette No. 401/1973 as amended);
6. the beginning of the period of protection;
7. where appropriate, a note that the mark was registered on the basis of proof that it is in use.

(2) Marks consisting exclusively of figures, letters or words, having no pictorial design and for which no particular characters have been claimed, shall be entered in capital letters or Arabic figures.

(3) The trademark owner shall receive official confirmation of entries in the Register made under subsection (1).

(4) The mark shall be published after registration.

(5) The Trademark Register and the catalogs to be compiled of its contents shall be open to public inspection. On request, a certified copy shall be made of the entries.

18.–

(1) When registration of a mark is applied for, an application fee of ATS 950, including a search fee (Section 21) in the amount of ATS 400, shall be payable together with a class fee. The class fee shall be ATS 220 if the list of goods and services does not comprise more than three classes; for each additional class, the fee shall be increased by ATS 290.

(2) Before a mark is registered, a fee of 2,000 schillings covering the period of protection shall be paid on demand, together with a contribution to the cost of printing for the publication (Section 17(4)). The amount of such contribution shall depend on the size of the publication and shall be laid down by order (Section 70(1)).

(3) Fees already paid under subsection (2) shall be refunded if the application does not lead to registration. This shall also apply to the contribution to the cost of printing (subsection (2)).

(4) Applications for international registration of a mark under the Madrid Agreement Concerning the International Registration of Marks. Federal Law Gazette No. 400/1973 as amended, shall be subject to an Austrian fee of 1,200 schillings in addition to the fee to be paid to the International Bureau.

19.–

(1) The right to a mark shall begin with the day of entry in the Trademark Register (registration). The period of protection shall expire ten years after the end of the month in which the mark was registered. The period may be extended for further periods of ten years provided that renewal of registration is applied for in time (subsections (2) and (3)). Further periods of protection shall, irrespective of the day of renewal, date from the end of the preceding period.

(2) Registration shall be renewed by the payment of a renewal fee in the amount of two and a half times the fee for the first period of protection (Section 18(2)).

(3) The renewal fee (subsection (2)) may be paid no earlier than one year before the end of the period of protection and no later than six months after the end of the period. Where payment is made after the end of the period, a 20 percent surcharge shall be added.

20.–

(1) Every application for registration of a mark shall be examined for compliance with the law.

(2) If such examination reveals obstacles to the registration of the trademark, the applicant shall be invited to submit his response within a specified period. If, after timely receipt of the response or expiry of the time limit, registration is found not to be admissible, the application shall be rejected by a final decision. Where there is no obstacle to registration, registration shall be granted after an examination for similarity (Section 21) and payment of the fee prescribed in Section 18(2) and of the contribution to the cost of printing.

(3) Where there are objections to the admissibility of registration due to a lack of distinctiveness (Section 1) or in view of Section 4(1)2., it shall be laid down by a decision, at the applicant's request, prior to rejection that the mark may only be registered subject to the requirements of Section 1(2) or Section 4(2); such decision may be appealed against (Section 36).

21.–

(1) In addition, for every mark filed, an examination shall be made for identicalness or similarity (Section 14) to a mark with earlier priority registered for goods or services belonging to the same class. The applicant shall be notified of any such marks and shall be informed that the mark filed will be registered if registration is admissible (Section 20(2)) unless he withdraws his application within the period laid down by the Patent Office.

(2) The notification under subsection (1) or the failure to give such notification shall be of no consequence for the assessment of the scope of protection of the sign concerned. It shall require neither signature nor official certification.

22.–

(1) The Patent Office shall provide any person, on request, with written information as to whether a specific sign could be identical or similar (Section 14) to marks whose respective goods and services fall under the classes specified in the request. Section 21(2) shall apply to such information. Where the sign is a registered mark, it shall be sufficient to state the registration number.

(2) On request, information under subsection (1) may be given once only or repeatedly, for each half year, for each year or for every two years. Repeated communications shall be sent in January, and in July where half yearly.

(3) The petitions shall be subject to the payment of a fee which shall be fixed by order of the President of the Austrian Patent Office. In the determination of the fees for each individual case account shall be taken of the labor and material required for the service involved.

(4) Where further information is no longer required, the amount corresponding thereto shall be refunded.

23.–

(1) The applicant's right of priority shall date from the day that the mark is duly filed.

(2) The list of goods and services in respect of a filed or registered mark may be subsequently extended. Such extensions shall be subject, *mutatis mutandis*, to the rules for applications for marks.

24.–

(1) The right of priority granted in Article 4 of the Paris Convention for the Protection of Industrial Property, Federal Law Gazette No. 399/1973 as amended, must be expressly claimed. For that purpose, the date and country of the application for which priority is claimed shall be indicated (declaration of priority), as well as the serial number of such application.

(2) The declaration of priority shall be submitted to the Patent Office within two months of the arrival of the 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 fees charged on filing the mark shall be payable.

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

(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 periods laid down, priority shall be determined in accordance with the date of filing in Austria.

25.–

(1) Marks used to distinguish goods or services displayed in an Austrian or foreign exhibition shall enjoy priority in accordance with Sections 26 and 27.

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

26.–

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

(2) Such privilege shall be applied for by the management of the exhibition. The application shall contain the particulars required for a decision regarding the priority claimed.

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

(4) The grant of the privilege of priority protection shall be notified in the *Amtsblatt zur Wiener Zeitung* and in the *Österreichisches Patentblatt* (Patent Gazette) at the exhibition management's expense.

27.–

(1) The priority of a mark arising from such protection shall date from the day that the goods marked were brought to the exhibition premises provided the mark is filed with the Patent Office within three months from the day on which the exhibition closed. The application for registration may only comprise the goods on which the mark was used during the exhibition.

(2) If identical or similar goods designated by the same or similar (Section 14) marks are brought to the exhibition premises at the same time, the mark first filed shall have priority.

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

(4) The right of priority shall be evidenced by a reproduction of the mark and a certificate issued by the exhibition management mentioning the goods that were displayed with the mark and the time that they reached the exhibition premises (priority documents).

(5) If the declaration of priority is not made in time or if the priority documents are not submitted on official demand within the period laid down, priority shall be determined in accordance with the date of filing.

2. Changes in the Registered Status

28.–

(1) The record of transfer of the mark and the entry or cancellation of license rights shall be effected at the written request of one of the parties concerned and the submission of documentary evidence. Where the documentary evidence is not of an official nature, it shall be required to bear the duly certified signature of the person to whom the right belongs.

(2) Legal disputes concerning rights to marks, cancellation proceedings (Sections 30 to 33c) or assignment proceedings (Section 30a) shall be recorded, on request, in the Trademark Register (entry relating to a dispute).

(3) In other cases, Sections 43(3) and (4) and 45(2) of the Patents Act, 1970, Federal Law Gazette No. 259 as amended, shall apply *mutatis mutandis*.

(4) A fee equal to the application fee (Section 18(1)) shall be paid for each of the requests referred to in subsections (1) and (2).

(5) The entries referred to in subsection (1) shall be noted, on request, in the official confirmation of the registration entry (Section 17(3)).

(6) Transfer of the mark shall be published.

3. Cancellation

29.–

(1) The mark shall be cancelled:

1. at the request of the owner;
 2. where registration has not been renewed in time (Section 19);
 3. where the right to a mark has lapsed for reasons other than those referred to under 1. and 2.;
 4. following a final decision granting a request for cancellation submitted to the Nullity Division.
- (2) Cancellation shall be entered in the Trademark Register (Section 17) and shall be published.

30.–

(1) The petition for the cancellation of a mark may be made by the registered owner of a mark filed earlier for identical or similar goods or services and still in force where the two marks are identical or similar (Section 14).

(2) The petition shall be filed within a period of five years as from the date knowledge is obtained of the use of the mark registered later. This shall apply only to goods or services for which the later mark was used and only if the application of the later mark was not filed in bad faith.

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

30a.–

(1) A person having acquired rights abroad in a sign by registration or use may request an identical or similar (Section 14) mark filed at a later date for the same or similar goods or services to be cancelled or transferred to him, where the owner of such mark is or was committed to looking after the business interests

of the person making the request and had the mark registered without the latter's agreement and without proper justification.

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

31.–

(1) Any person may apply for cancellation of a mark if he proves that a sign used by him for identical goods or services and not registered was recognized in the trade concerned as distinctive of his enterprise's goods or services at the time when the contested mark – identical or similar (Section 14) to his own unregistered mark – was filed, unless the enterprise for which the mark was filed had used it unregistered for at least as long as the applicant's enterprise.

(2) Cancellation of such mark shall be applied for within five years from the beginning of the period of protection, unless the registered owner was aware or should have been aware of the mark as a sign distinguishing the goods or services of the applicant's enterprise at the time the mark was filed or acquired (Section 11).

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

32.–

(1) An entrepreneur may apply for the cancellation of a mark if his name, his firm name or the special designation of his enterprise or a designation similar (Section 14) to these names has been registered without his consent as a mark or feature of a mark (Section 12) and if the use of the mark is likely to give rise to confusion in trade with one of the signs distinctive of the applicant's enterprise.

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

33.–

(1) Anyone may apply for the cancellation of a mark on any of the grounds for cancellation *ex officio*.

(2) If the trademark is cancelled on the ground that it ought not to have been registered, the cancellation decision shall have retroactive effect to the beginning of the period of protection (Section 19(1)).

33a.–

(1) Any person may request the cancellation of a mark which has been registered for a minimum of five years where it has not been used as a distinctive sign to any reasonable extent in Austria during the five years preceding submission of the request for cancellation, either by the owner of the mark or by any third party with the owner's consent (Section 13), unless the owner of the mark can justify his non-use.

(2) Where non-use of a mark is the result of statutory restrictions on trade in the goods or services for which it is intended, it shall not be subject to cancellation under subsection (1) if it is recognized that a worthwhile interest exists in giving protection in Austria in view of serious use of the sign abroad or for other reasons worthy of consideration.

(3) The owner of the mark may not, however, cite use of the mark which had not begun until after:

(a) the owner of the mark or a licensee had cited the right to the mark in respect of the person submitting the request; or

(b) the person submitting the request had informed the owner of the mark or a licensee of the non-use,

where the request for cancellation is submitted within three months of the first occasion on which the acts under (a) or (b) took place.

(4) Use of a sign similar to the mark shall be equivalent to use of the mark itself (Section 14). Use in respect of certain goods and services shall have effect for similar goods and services in the list of goods and services.

(5) Proof of use (subsection (1)) shall be furnished by the owner of the mark.

(6) The cancellation decision shall have retroactive effect for a period of five years as from the date the petition is filed, but at most to the end of the fifth year of protection.

33b.–

(1) Any person may request the cancellation of a mark if after the date of its registration it has become the usual designation of goods or services for which it is registered in business dealings as a result of its owner's conduct or inactivity.

(2) The cancellation decision shall have retroactive effect to the date for which the completed development of the mark to the usual designation (generic term) has been proved.

33c.–

(1) Any person may request the cancellation of a mark if after the date of its registration it is likely, due to its use by the owner or with his consent for goods or services for which it is registered, to mislead the public in particular as to the type, the nature or the geographic origin of these goods or services.

(2) The cancellation decision shall have retroactive effect to the date for which deceptive use of the mark has been proved.

4. Authorities and Proceedings

35.–

(1) In the Patent Office, the member of the Legal Division within whose responsibility the particular matter falls shall have the power to take decisions as to registration and as to any other matters relating to the protection of marks, unless such decisions are reserved to the President of the Office, Appeal Division or the Nullity Division.

(2) Sections 58 to 61 of the Patents Act, 1970, as amended, shall apply *mutatis mutandis*.

(3) By order of the President of the Office, employees who are not members of the Patent Office may be empowered to deal with matters – whose nature shall be clearly defined – in the Legal Division, insofar as this is expedient in view of the simplicity of the matters in question and to the extent that the employees so empowered are qualified to deal with such matters. Such employees may not be empowered to take decisions as to the admissibility of lists of goods and services. The employees so empowered shall comply with the instructions of the member of the Legal Division responsible in accordance with the allocation of work. Such member may at any time take over matters or reserve them to himself.

(4) A reasoned representation against the decision of an employee so empowered may be made to the competent member of the Legal Division within one month. Where such representation is made in time, the decision of the employee so empowered shall be suspended.

36.–

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

37.–

Petitions for the cancellation of a registered mark (Sections 30 to 33c) and applications for transfer (Section 30a) shall be dealt with by the Nullity Division.

38.–

(1) For decisions of the Appeal Division and the Nullity Division three members shall be present, one of whom shall preside. The chairman and one other member shall be legally qualified.

(2) Preliminary decisions by the rapporteur (*Referent*) and interim decisions shall not be subject to separate appeal, but an application for their review may be made to the Division concerned.

39.–

(1) Against the final decisions of the Nullity Division an appeal shall lie to the Supreme Patent and Trademark Chamber as the highest authority. Section 74 of the Patents Act, 1970, shall apply.

(2) The Supreme Patent and Trademark Chamber shall deliberate and take decisions under the chairmanship of its President or – if he is unable to attend – of the Vice-President in boards consisting of five members: the chairman, three legally qualified members (Section 74(3) of the Patents Act, 1970) and one technically qualified member (Section 74(4) of the Patents Act, 1970). The chairman shall ensure that the board

includes one legally qualified civil servant of Group A and at least one judge. The legally qualified civil servant shall be the rapporteur; if necessary, the chairman may appoint further members of the board as joint rapporteurs.

(3) Section 75(2) of the Patents Act, 1970, as amended, shall apply.

40.–

(1) For appeals against the decisions of the Legal Division, a fee of 900 schillings shall be payable in respect of every filed or registered mark to which the appeal relates. For petitions to the Nullity Division (Section 37), a fee of 2,900 schillings shall be payable, and for appeals (Section 39) a fee of 4,400 schillings for each mark to which the petition (appeal) relates.

(2) The fee for an appeal (subsection(1)) shall be refunded if the appeal is essentially successful and if the proceedings have been conducted without an adverse party. Half the fee for petitions to the Nullity Division or for the corresponding appeal shall be refunded if the petition or the appeal is dismissed before the hearing takes place.

41.–

(1) In the cases provided for in Section 76(1) of the Patents Act, 1970, members of the Patent Office and of the Supreme Patent and Trademark Chamber may not take part in the proceedings.

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

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

1. in the case of proceedings for the cancellation of a mark under Section 30, if they have taken part in the examination for similarity (Sections 21 and 22);
2. in the case of proceedings for the cancellation of a mark under Section 33, if they have taken part in the decision as to the admissibility of the registration.

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

42.–

(1) In all other cases and unless otherwise provided hereunder, Sections 52 to 56, 57 b, 58 a, 58 b, 64, 66 to 73, 79, 82 to 86, 112 to 126, 127(1), (2), (4) and (5), Sec. 128 first sentence, Sec. 129 to 133(2), Sec. 134, 135, 137 to 145, 169 and 172 a(1) of the Patents Act 1970, Federal Law Gazette No. 259, as amended, shall apply *mutatis mutandis*; the procedural fee provided for in Sec. 132(1) para. b of the Patents Act 1970 shall correspond to the application fee (Sec. 18(1)).

(2) Publications as provided for in Sections 17(4), 28(6) and 29(2) shall be made in the *Österreichischer Markenanzeiger* (Trademark Bulletin). The authorization for restoration shall be announced in the *Österreichischer Markenanzeiger* if the effect thereof is to reinstate the right to the mark.

(3) If the registered owner of the mark for which cancellation is sought does not contest the petition in writing within the period prescribed, the Nullity Division shall, without further proceedings, order cancellation of the mark or restriction of the list of goods or services.

50.–

(1) The parties to proceedings may inspect the relevant documents and make copies. Other persons shall have that right with the consent of the parties or on showing a legal interest.

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

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

(4) The text or the reproduction of the mark filed and the list of goods or services shall be communicated to anyone so requesting. Information and official certificates as to the date of an application, the name and representative (if any) of the applicant, any priority claimed, and the serial number of the application on which priority is based, as well as information on whether the application is still pending and whether and to whom rights resulting from it have been transferred, shall be supplied to anyone so requesting.

(5) Records of deliberations and parts of files relating solely to internal administrative transactions may not be inspected.

III. INFRINGEMENTS OF DISTINCTIVE SIGNS

51.–

Anyone who in a manner likely to give rise to confusion in trade:

1. uses without authorization a registered mark or a sign similar (Section 14) to such mark to distinguish goods or services for which the mark has been registered or similar goods or services; or
2. offers for sale or puts on the market goods thus marked, shall be punishable by the courts and liable to a fine of up to 360 times the per diem rate for calculating fines.

52.–

The same penalties shall be applicable to anyone who in a manner likely to give rise to confusion in trade:

1. uses, without authorization, the name, trade name or special designation of an enterprise or a sign similar (Section 14) to such designation to distinguish goods or services; or
2. offers for sale or puts on the market goods so marked.

53.–

(1) The offences referred to in Sections 51 and 52 shall be prosecuted only upon formal complaint of the injured person.

(2) The criminal procedure shall be heard by a judge of the court of first instance sitting alone.

54.–

(1) At the request of the injured person, an order shall be made that tools and devices used solely or mainly for the imitation or the unauthorized affixing of the mark or designation shall be made unserviceable for such purpose, that any existing stocks of counterfeit marks or of designations prepared without authorization shall be destroyed and that marks and designations which have been affixed without authorization shall be removed from articles in the possession of the person convicted even if this results in the destruction of the article concerned.

(2) The injured person shall also be authorized to publish the conviction of the guilty party at the latter's expense. The manner of publication and the time limit prescribed for that purpose shall be specified in the judgment, regard being had to the wishes of the injured party.

55.–

An injunction based on a mark which has been registered for more than five years may only be issued when it has been proved that grounds for cancellation under Section 33a do not exist.

56.–

Claims of a person injured in his mark rights for appropriate compensation, damages and surrender of gain shall be governed, *mutatis mutandis*, by Sections 150 and 151, 152(2) and (3), 154 and 161 of the Patents Act, 1970, Federal Law Gazette No. 259, as amended.

57.–

Where, in the course of judicial proceedings, it becomes clear that the decision depends on the preliminary question as to whether the right to the mark alleged to have been infringed exists in accordance with this Act and where the court has stayed the proceedings until the preliminary question has been finally determined by the Patent Office, to which it has been submitted before or during the judicial proceedings, such decision shall form the basis of the judgment.

59.–

Anyone infringing the provisions of an order issued pursuant to Section 9 shall be punished by the district administrative authority by a fine not exceeding 1,000 schillings or with detention for a term not exceeding one month. In aggravating circumstances these penalties may be imposed concurrently. On conviction, confiscation of the goods concerned shall always be ordered.

IV. MARKS AND OTHER DISTINCTIVE SIGNS OF FOREIGN ENTERPRISES

60.–

(1) Marks of enterprises with head offices abroad shall enjoy the protection of this Act provided that and so long as marks of enterprises established in Austria enjoy, in the foreign State concerned and under that State's law, the same protection as marks of enterprises established in the foreign State and reciprocity is provided for by an international agreement or by a notice to be published by the Federal Minister of Economic Affairs in the Federal Gazette.

(2) Subsection (1) shall also apply to the names, trade names or special designations of enterprises established abroad.

V. REPRESENTATIVES

61.–

(1) Anyone acting as a representative before the Patent Office or before the Supreme Patent and Trademark Chamber shall be resident in Austria; however, professional laws and regulations 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. 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 producing documentary evidence.

(3) If a representative acts without a power of attorney or, in the event of subsection (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 only if he is represented by a representative who complies with the requirements of subsection (1). He may claim such rights before the Appeals Division and before the Nullity Division of the Patent Office and before the Supreme Patent and Trademark Chamber only if he is represented by an attorney at law, patent attorney or notary.

(5) 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 trademark applications, to withdraw applications, to waive trademark rights, to file and withdraw petitions or appeals to be dealt with by the Nullity Division, to 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 to appoint an agent.

(6) The authorization pursuant to subsection (5) may be limited to a particular protective 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.

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

VI. COLLECTIVE MARKS

62.–

(1) Associations having legal personality and pursuing economic purposes may, even if they do not own an enterprise intended for the trading of goods or the provisions of services, file marks which are to serve for the identification of goods or services in the enterprise of their members (collective marks).

(2) Public legal entities shall be in the same position as the associations referred to in subsection (1).

(3) The provisions of this Federal Act shall apply *mutatis mutandis* to collective marks unless otherwise provided in Sections 63 to 68. In particular, the legal effects provided for in Sections 4(2) and 31 of this Act and in Section 9(3) of the Federal Act of 1984 Against Unfair Competition, Federal Law Gazette No. 448 as amended, shall be applicable in favour of unregistered marks where the mark is recognized in the trade concerned as distinctive of the goods or services of the members of an association.

63.–

(1) The application for a collective mark shall be accompanied by statutes stating the name, headquarters, objects and representatives of the association, the persons authorized to use the collective mark, the conditions governing such use, withdrawal of the right of use if the collective mark has been misused and the rights and duties of the members where the collective mark is infringed. Subsequent amendments shall be communicated to the Patent Office. They shall be binding on third parties only as from the day following such communication. The statutes and any amendments thereto shall be submitted in duplicate. Anyone may inspect the statutes.

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

64.–

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

1. addition of the words “collective mark” under the registration number;
2. reference to the statutes and their date.

65.–

The rights derived from filing or registration of the collective mark shall not be transferable.

66.–

Without prejudice to other provisions governing cancellation of marks (Section 62(3)), a collective mark shall be cancelled:

1. where the association for which the mark has been registered no longer exists;
2. where the association permits or tolerates the use of the collective mark in a manner contrary to the objects of the association or to its statutes. In particular, use of the collective mark in a manner likely to mislead trade circles or toleration of the use of the mark by persons who are not members of the association shall be regarded as such misuse.

67.–

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

68.–

Sections 60 and 61 shall apply *mutatis mutandis* to collective marks of associations established abroad and of foreign public legal entities (foreign collective marks).

VII. PROHIBITION OF UNAUTHORIZED REPRESENTATION

69.–

- (1) Anyone who, in matters relating to the protection of trademarks, professionally
1. prepares written petitions or documents 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 ATS 60,000.

VIII. SPECIAL FEES

70.–

(1) Contributions to the cost of printing as well as special fees for official documents, publications, certificates and attestations as well as for extracts from the register may be provided for by ordinance. In the determination of any fee, which shall not exceed ATS 1,200, 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) of the Patents Act 1970, Federal Law Gazette No. 259, as amended, shall apply *mutatis mutandis*.

(2) Petitions for official publications and petitions which may be accepted only after official publication under a regulation governing trademark law shall be refused if the relevant fees or contributions to the cost of printing have not been paid.

IX. IMPLEMENTATION AND ENTRY INTO FORCE

71.–

The following shall be responsible for implementing this Act:

1. with respect to Sections 10, 10a, 12 to 14, 23 and 57 the Federal Minister of Economic Affairs and the Federal Minister of Justice,
2. with respect to Section 6 (2) the Federal Minister of Economic Affairs in agreement with the Federal Minister of Foreign Affairs,
3. with respect to Sections 51 to 56 and Section 67 the Federal Minister of Justice,
4. with respect to Section 70 (1) the Federal Minister of Economic Affairs in agreement with the Federal Minister of Finance,
5. with respect to all other provisions the Federal Minister of Economic Affairs.

72.–

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

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