

Federal Law
on the Introduction of the European Patent Convention and the
Patent Cooperation Treaty (Law Introducing Patent Treaties)

(of December 16, 1978)*

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* *German title:* Bundesgesetz über die Einführung des Europäischen Patentübereinkommens und des Vertrages über die internationale Zusammenarbeit auf dem Gebiet des Patentwesens (Patentverträge-Einführungsgesetz-PatV-EG).

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Definitions

1. For the purposes of this Federal Law:

1. “EPC” means the Convention on the Grant of European Patents (European Patent Convention) signed at Munich on October 5, 1973;¹
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;²
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. “Patent Law” means the Patent Law (*Patentgesetz*) of 1970,³ published in the *Bundesgesetzblatt*, No. 259/1970, as most recently revised.

¹ See *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES, Texts 2-008 to 2-010.

² See *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES, Texts 2-006 and 2-007.

Patent Applications and Patents Under the EPC

Filings 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 to 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 101\(1\)](#) and [\(3\)](#) of the Patent Law 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 protection 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 (Patent Law, 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 thereof shall be submitted within six months following the start of the period provided for the payment of the fees for grant and printing (EPC, [Article 97\(2\)\(b\)](#)) and the publication fee (Section 22) paid. The Austrian Patent Office shall publish the translation in printed form.

³ See *Industrial Property Laws and Treaties*, AUSTRIA-Text 2-001.

(2) Paragraph (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) Where translations required under paragraph (1) or (2) are not submitted to the Austrian Patent Office in due time, where formal defects in the translation (Section 21) are not removed on request by the time limit set for their removal, or where payment of the fee is not proved as required (Patent Law, Section 168(3)) by the time limit set for subsequent filing of documents, the European patent shall be deemed never to have had effect *ab initio*. The request for the subsequent submitting of documents shall state the amount to be paid.

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 printed patent specification 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 within the country, or had made the necessary arrangements for such use (interim user [*Zwischenbenutzer*]). The rights of the interim user shall be determined by application, *mutatis mutandis*, of the provisions of Section 23(2) to (4), of the Patent Law. 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 (Patent Law, 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 paragraph (1) shall be determined pursuant to Section 166(3) of the Patent Law, subject, however, to the following amendments:

1. for the third year of the currency 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 currency 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 to the Austrian Patent Office 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 to be 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 (Patent Law, Section 99) to do the following within three months:

- (a) pay the application fee (Patent Law, 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 Patent Law.

(4) Annual fees under Section 166 of the Patent Law shall be paid for the patent granted on the basis of the converted patent application. The patent shall lapse in any event, however, notwithstanding the provisions of Section 46(1)(i) of the Patent Law, after 20 years following the application date.

Grounds for Revocation

10.-(1) European patents may be revoked on the grounds specified in **Article 138(1)(a) to (d)** of the EPC 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 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 or pharmaceutical product.

(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 Patent Law has been suspended the defendant may, instead of 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 two parties.

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 (Patent Law, Section 166(1)). Section 168(3) and (4) of the Patent Law shall apply.

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.

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 Patent Law may also be claimed.

(2) For every application under paragraph (1), a transmittal fee in the same amount as the application fee (Patent Law, Section 166(1)) shall be paid not later than on the filing date. Section 168(3) and (4) of the Patent Law shall apply *mutatis mutandis*.

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 20 months following the priority date and, if the Austrian Patent Office is not also the receiving Office, pay a fee in the same amount as the application fee (Patent Law, 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 (Patent Law, Section 166(1)) is paid, and where applicable a German translation of the international application filed, in due time.

(4) An additional time limit of two months shall be set for the subsequent filing of documents relating to the payment of fees under paragraphs (2) and (3). Section 168(3) of the Patent Law shall apply.

Elected Office

17.-(1) Where, under **Article 31(4)(a)** of the PCT, the Republic of Austria is named in the international application 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 **paragraphs (2)** and **(3)** shall apply.

(2) Where the election is made before expiry of the nineteenth month from the priority date, the period of 20 months provided for in Section 16(2) shall be extended to 25 months. 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 European Patent Convention, 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 57(2)(a) of the Patent Law.

(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 that they 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 a report under Section 57(2)(b) of the Patent Law 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 that they constitute a single general inventive idea.

(6) Payment of fees under paragraphs (1) to (5) shall not be deemed to have been made until it has been proved in accordance with Section 168(3) of the Patent Law.

(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 Section 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 Patent Law 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.

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 Law, shall be specified in detail by an Order issued by the President of the Austrian Patent Office. Consideration shall be given insofar as possible 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) For every publication of a translation or correction thereof provided for in this Federal Law, a publication fee in the same amount as the annual fee for the first year (Patent Law, Section 166(3)) shall be paid.

(2) In the calculation of fees, the corresponding pages and sheets of the translation filed shall take the place of the sixth and every subsequent page of the description supplied for inspection and of the third and every subsequent sheet of the drawings attached to that description. Section 166(10) of the Patent Law shall apply.

(3) Payment of the publication fee shall be proved in accordance with Section 168(3) of the Patent Law. The publication fee shall not be deemed to have been paid until such proof has been provided.

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 Law, by application *mutatis mutandis* of the provisions of the Patent Law.

(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, 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 [*Formal Prüfer*]) 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 Patent Law 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 Section and state the reasons therefor in his report to it.

Complementary Application of Patent Law

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 Patent Law, in addition to the provisions of the EPC, the PCT and this Federal Law.

Final and Transitional Provisions

Entry into Force

25. For European patent applications and patents this Federal Law shall enter into force on the entry into force of the EPC for the Republic of Austria (EPC, [Article 169](#)),⁴ and for international applications on the entry into force of the PCT for the Republic of Austria (PCT, [Article 63](#)).⁵

Repeal and Transitional Provisions

26.-(1) (Constitutional provision) This Federal Law 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 Law 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 1973 (*Bundesministeriengesetz*), *Bundesgesetzblatt* No. 389.

⁴ May 1, 1979 (*Editor's note*).

⁵ April 23, 1979 (*Editor's note*).