

# Patent Law

(Federal Law of 1970, as last amended by the Law of May 23, 1984, amending the Patent Law and the Law Introducing Patent Treaties)\*

## TABLE OF CONTENTS\*\*

Sections

### 1. General Provisions

Patentable Inventions.....	1
Exceptions to Patentability .....	2
Novelty .....	3
Right to a Patent .....	4 and 5
Employees' Inventions .....	6 to 19
Right of the Inventor to be Named .....	20
Representatives.....	21
Effect of a Patent .....	22 to 26
Relationship of Co-Patentees .....	27
Duration of the Patent.....	28
Expropriation.....	29
Patentee's Obligation to Comply with the Law .....	30 to 32
Transfer.....	33
Liens .....	34
Voluntary Licenses .....	35
Compulsory Licenses .....	36
Transfer of Licenses .....	37
Abuse of Patent Rights .....	38 to 42

---

\* *German title:* Patentgesetz 1970.

*Entry into force* (of the last amending law): December 1, 1984; see also the Additional Provisions of the Law of May 23, 1984, at the end of this text.

*Source:* Bundesgesetzblatt für die Bundesrepublik Österreich (BGBl.)

Nos. 259/1970, 581/1973, 349/1977, 526/1981, 201/1982, 126/1984 and 234/1984.

\*\* Added by WIPO.

Entry in the Patent Register .....	43
Charges .....	44
Entries Relating to Disputes .....	45
Expiry .....	46
Revocation .....	47
Declaration of Nullity .....	48
Declaration of Lack of Title .....	49
Declaration of Dependence .....	50
Right of Retaliation .....	51
Time Limits .....	52 to 56

## **II. Patent Authorities and Institutions**

Scope of the Patent Office's Activity .....	57
Services and Information Provided by the Patent Office .....	57a and 57b
Location and Composition of the Patent Office .....	58 and 59
Structure of the Patent Office .....	60 and 61
Decisions in the Sections .....	62 to 66
Official Dress .....	67
Business Routine .....	68 and 69
Appeals against Decisions of Sections .....	70 to 73
Supreme Patent and Trademark Chamber ( <i>Obersier Patent-und Markensenat</i> ) .....	74 and 75
Reasons for Exclusion .....	76
Representatives of the Parties .....	77
Prohibition of Unauthorized Legal Representation ( <i>Winkel-schreiberei</i> ) .....	78
Patent Gazette .....	79
Patent Register, Patent Documents .....	80
Access to Documents .....	81
Samples of Deposited Microorganisms .....	81a
Administrative and Disciplinary Penalties ( <i>Ordnungs- und Mutwillensstrafen</i> ) .....	82 to 84

Service of Documents.....	85 and 86
---------------------------	-----------

### **III. Procedure**

#### **A. GRANT OF PATENTS**

Filing of an Application.....	87
Disclosure .....	87a
Unity .....	88
Requirements of the Application.....	89 to 92
Division of the Application .....	92a
Priority.....	93 to 98
Preliminary Examination.....	99
Rejection of Applications .....	100
Publication and Laying Open for Public Inspection.....	101
Opposition .....	102
Procedure for Opposition .....	103
Assessment of the Evidence and Decision .....	104
Costs .....	105
Application for a Patent by Opponent .....	106
Grant of Patent Without Opposition Proceedings .....	107
Appeals .....	108
Letters Patent—Publication.....	109
Patents of the Federal Authorities .....	110
Refusal.....	111

#### **B. REPORTS**

Requirements for Applications and Processing Thereof.....	111a
---	------

#### **C. CHALLENGE OF A PATENT**

Making an Application .....	112
Immediate Rejection.....	113
Form and Contents of the Application .....	114

Third Party Intervention .....	114a
Procedure for Applications Challenging a Patent .....	115
Preliminary Proceedings.....	116
Termination of Proceedings Without a Hearing.....	117
Public Notice of the Hearing .....	118
The Hearing .....	119
Evidence and the Taking of Evidence .....	120
Deliberation and Vote.....	121
Costs .....	122
Contents of the Decision .....	123
Announcement of the Decision .....	124
Record.....	125
Assistance of the Courts .....	126
Reopening of Proceedings .....	127 and 128
Restoration of Rights .....	129 to 136
Execution.....	137
Appeals .....	138 and 139
Proceedings before the Supreme Patent and Trademark Chamber .....	140 to 146

#### **IV. Violation of Patents and Obligation to Provide Information**

Action for Restraint .....	147
Action for Elimination.....	148
Publication of the Judgment .....	149
Monetary Claims .....	150
Accounting .....	151
Employer Liability.....	152
Liability of Several Persons.....	153
Prescription.....	154
Process Patents .....	155

Preliminary Questions .....	156
Treatment of Prejudicial Proceedings by the Nullity Section and the Supreme Patent and Trademark Chamber .....	157
Provisional Patent Protection .....	158
Willful Patent Violation .....	159
Actions under Private Law .....	160
Characteristics of Criminal Prosecution .....	161
Jurisdiction .....	162
Application for Declarations .....	163
Infringing Objects Exempted from Elimination and Withdrawal .....	164
Obligation to Provide Information Regarding Patent Protection .....	165

## **V. Fees**

Application Fee and Annual Fee .....	166
Fee for Amendments of the Description .....	167
Procedural Fees .....	168
Method of Payment of Fees.....	169
Stamp Duty .....	170
Exemption from Payment of Fees .....	171 and 172

## **VI. Implementation..... 173**

### **Additional Provisions of the Law of May 23, 1984**

## **I. General Provisions**

### *Patentable Inventions*

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

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

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

4. computer programs.

(3) Subsection (2) shall exclude patentability of the subject matter or activities referred to therein only to the extent to which protection is sought for such subject matter or activities as such.

### *Exceptions to Patentability*

2. Patents shall not be granted:

1. for inventions the publication or exploitation of which would be contrary to public policy or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law;

2. for methods for treatment of humans by surgery or therapy and diagnostic methods practiced on humans; this shall not apply to products, in particular substances or compositions, for use in any of these methods;

3. for plant or animal varieties (animal races) or essentially biological processes for the production of plants or animals.

### *Novelty*

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

(2) The patentability of substances that are comprised in the state of the art shall not be excluded by subsection (1) for use in a method referred to in Section 2.2, or in such a method in respect of animals, provided that its use for any such method is not comprised in the state of the art.

(3) For the application of subsection (1), a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months preceding the filing of the application and if it was due to, or in consequence of:

1. an evident abuse in relation to the applicant or his legal predecessor or

2. the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognized, international exhibition falling within the terms of the Convention on International Exhibitions, BGBl. No. 445/1980, in its currently applicable version.

(4) Subsection (3)2 shall only apply if the applicant states, when filing the application, that the invention has been shown at such exhibition and also submits within four months of filing a confirmation issued by the organizers of the exhibition. Such confirmation must state the date of opening of the exhibition and the date of first disclosure where this did not take place on the same day. The confirmation shall be accompanied by a representation of the invention bearing a certification by the organizers of the exhibition.

### *Right to a Patent*

4.— (1) Only the inventor or his successor in title shall have a right to the grant of a patent. Until otherwise proved, the first person to apply for a patent shall be regarded as the inventor. No subsequent application shall give a right to a patent if the invention is already the subject of a patent or of an earlier application which leads to the grant of a patent. If these circumstances apply only in part, the later applicant shall only have a right to the grant of a patent made subject to corresponding restrictions.

(2) Where an improvement or other extension of an invention which is already protected by a patent or for which a patent has been applied for and is eventually granted is the subject of an

application by the original patentee or by his successor in title, the patentee or his successor in title may apply either for an independent patent for such improvement or extension or for a patent of addition dependent on the original patent.

(3) Where the industrial application of an invention for which a patent has been applied for entails the full or partial use of an invention already patented, the patent applied for shall, at the request of the earlier patentee (Section 102(5)), be issued with the statement that the patent is dependent on the earlier patent, which must be clearly specified (declaration of dependence). This statement shall also be included in the publication regarding the grant of the patent and in the letters patent.

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

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

### *Employees' Inventions*

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

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

7.— (1) Agreements between employers and employees under which any future inventions of the employee are to belong to the employer or which grant the employer a right to use such inventions shall be valid only if the invention is a service invention (subsection (3)). To be valid, the agreement must be in writing; this requirement shall be satisfied if the agreement is included in a collective agreement (Section 2(1) of the Law on the Organization of Labor, BGBl. No. 22/1974, in its currently valid form).

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

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

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

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

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

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

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

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

(a) the economic importance of the invention for the enterprise;

(b) the possible exploitation of the invention in Austria or abroad;

(c) the role which the suggestions, experience, preparatory work or resources of the employer's enterprise or service instructions have played in bringing about the invention.

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

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

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

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

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

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

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

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

(2) Where the employee fails to make such notification, he shall be liable to the employer, without prejudice to the employer's right to the invention, for damages in respect of the loss, which



shall also include loss of earnings. Where the employer fails to claim the invention or expressly does not claim it, the invention shall belong to the employee.

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

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

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

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

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

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

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

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

**14.** Where an employer who has paid remuneration to an employee for a service invention finds that another of his employees had in fact made the invention or had contributed to it, the employer shall be under no obligation to pay the remuneration to the rightful claimant—either in its entirety or in proportion to the rightful claimant's share in the invention, provided that the employer has made payment in good faith and that the invention also belongs to him under his legal relationship with the rightful claimant.

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

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

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

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

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

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

**19.** Claims of employers and employees under Sections 7 to 15 shall be statute-barred after three years.

### *Right of the Inventor to be Named*

**20.**—(1) The inventor shall be entitled to be named as such.

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

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

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

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

(a) for claims against the applicant or patentee, within one year of the notification of the grant of the patent in the Patent Gazette (Section 109); or, where the inventor has transferred the patent, for claims against the transferee, within one year from the Patent Office's receipt of the application to have the transfer recorded (Section 43);

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

(6) The claim (subsection (5)) shall be dealt with in accordance with the procedural law relating to disputes as to title. The issue of the patent shall not be suspended in consequence. Where a final decision allowing the claim has been given, action under subsection (3) shall be taken, if the rightful claimant so requests.

## *Representatives*

**21.**—(1) Anyone acting as a representative before the Patent Office or before the Supreme Patent and Trademark Chamber shall be resident in Austria. He shall evidence his authority by producing the original written power of attorney or a certified true copy thereof. If several persons are so authorized, each one of them may act as a representative.

(2) If a representative acts without a power of attorney, the action taken by him in the proceedings shall be valid only if he submits a regular power of attorney within the time limit prescribed therefor.

(3) Persons having neither residence nor establishment in Austria may claim rights under this Law before the Patent Office and before the Supreme Patent and Trademark Chamber only if they are represented by a representative as defined in Section 77.

(4) The locality in which the representative is resident, or in the absence of a representative, the locality in which the Patent Office is established shall, in matters concerning the patent, be deemed the residence of a patentee not resident in Austria.

(5) For each application, a separate power of attorney shall be submitted. This shall also apply where a representative is empowered to act in respect of a patent already granted.

(6) Where an attorney at law or a patent attorney has been authorized to act as a representative before the Patent Office, his power of attorney shall entitle him as of right to exercise all rights deriving from this Law before the Patent Office and before the Supreme Patent and Trademark Chamber. In particular, he may file an application for a patent, restrict or withdraw such application, file opposition, lodge and withdraw applications or appeals to be dealt with by the Nullity Section, conclude friendly settlements, accept service of documents of every kind, receive payment of official fees and of the cost of proceedings and representation from the adverse party and appoint a representative.

(7) The power of attorney under subsection (6) may be limited to a particular right or to representation in particular proceedings. The power of attorney shall not, however, expire on the death of the principal or as the result of a change in his legal capacity.

(8) If the representative is, in addition, to have power to surrender, in whole or in part, a patent granted, he must be expressly authorized to do so. A power of attorney for the transfer of a patent application or a patent itself must be publicly certified.

### *Effect of a Patent*

**22.**—(1) A patent shall vest exclusive authority in the patentee to produce the subject of the invention industrially, to put it on the market, to offer it for sale or to work it.

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

**22a.** The extent of the protection conferred by a patent or a published application (Section 101(2)) shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims. In so doing, the Protocol on the Interpretation of **Article 69** of the European Patent Convention, BGBl. No. 350/1979, shall be applied *mutatis mutandis* in its currently applicable version.

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

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

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

(4) The prior user may request written recognition of his right by the patentee. If such recognition is refused, the Patent Office shall, on application, determine the claim in accordance with the procedure for disputes as to title. Recognition of the right shall be entered in the Patent Register at the request of the claimant.

**24.**—(1) The military authorities shall have the right, in agreement with the Federal Minister of Commerce, Trade and Industry, to use for their needs, or to arrange for their agents to use, inventions necessary for national defense relating to military weapons, explosives or ammunition, fortifications or warships and no rights under a patent shall be effective against them.

(2) If no agreement on fair compensation is reached between the patentee and the military authorities with the assent of the Federal Minister of Finance, a decision on the matter shall be taken by the Federal Minister of Finance in agreement with the Federal Minister of Commerce, Trade and Industry and the military authorities.

(3) The exercise of the military authorities' right of use shall not be affected by the course of the above negotiations.

25. To the extent that the subject matter of a patented invention is covered by a monopoly of the Federal Republic, the patent shall not be effective against the monopoly administration. The monopoly administration may work the invention for its own needs in its own plant or workshops or in those of others.

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

### *Relationship of Co-Patentees*

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

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

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

### *Duration of the Patent*

28.—(1) A patent shall be valid for 18 years as from the date of publication of the filed invention in the Patent Gazette (Section 101), but not for more than 20 years as from the filing date.

(2) Patents of addition shall expire at the same time as the principal patent. A patent of addition may, however, be expressly maintained as an independent patent where the principal patent is revoked, annulled or surrendered. A patent of addition that has become independent shall replace the principal patent as regards its term and the due date and amount of the annual fees.

### *Expropriation*

29.—(1) If the interest of the armed forces or of public welfare or any other compelling federal interest requires an invention in respect of which a patent has been applied for or granted to be used in whole or in part by the federal authorities or to be made accessible for general use, the federal authorities may expropriate either such patent or the right to the use of the invention in whole or in part pursuant to a decision of the competent *Landeshauptmann* and on payment of fair compensation. The federal authorities shall use the invention, or render it accessible for general use, in accordance with the decision approving expropriation. The *Landeshauptmann* of the *Land* in which the applicant or patentee is resident (or established) (Section 21(4)) shall be competent to take such decision. Where several *Länder* are involved, the authority applying for expropriation shall have freedom of choice.

(2) In the event of imminent danger, the federal authorities may, with the provisional consent of the competent *Landeshauptmann*, immediately use the invention or make it accessible for general use on the basis of an application for expropriation, subject to a subsequent decision approving expropriation.

(3) The Federal Republic shall pay fair compensation to the patentee and to persons entitled to use the invention, where such right is withdrawn.

(4) With regard to the amount of compensation, every endeavor shall be made to reach agreement with the applicant for a patent or the patentee and the persons entitled to its use, if any. If no agreement is reached, the decision in any action for compensation shall be rendered by the courts, if necessary after hearing expert opinion. The patentee shall have the right to choose one of the experts. In all cases, the amount of compensation shall be determined solely on the basis of the effects of the expropriation of the patent arising in Austria.

(5) The negotiations over the amount of compensation shall have no delaying effect on the exercise of the rights claimed by the federal authorities with regard to the invention, in favor of itself or the general public.

(6) Where expropriation of a patent is applied for, interested parties whose names are entered in the Patent Register shall be immediately notified by the Patent Office.

### *Patentee's Obligation to Comply with the Law*

**30.** A patent shall not release the patentee from the obligation to comply with the law.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

### *Transfer*

**33.**—(1) The rights arising from a patent application or the patent itself shall be inheritable. Such rights shall not pass to the State.

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

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

### *Liens*

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

### *Voluntary Licenses*

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

### *Compulsory Licenses*

**36.**—(1) The patentee of an invention of considerable commercial or industrial significance which cannot be worked without the use of an invention patented earlier (the earlier patent) may apply for a license to work the earlier patent. Where such license is granted, the earlier patentee may demand a license to work the later patent, to the extent that the two inventions are in fact connected.

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

(3) If a license for a patented invention is required in the public interest, any person may apply for such license for the purposes of his business.

(4) A license (subsections (1) to (3)) may not be applied for until four years after the filing of the application, or three years after publication of the grant, relating to the patent for which the license is sought, whichever period expires last. If the patentee refuses to grant a license on reasonable terms, the Patent Office shall, at the request of the applicant for the license, determine the matter under the procedure relating to disputes as to title. If the license is granted, the Office shall fix the royalty, the security which may be required and any other terms governing use, having regard to the nature of the invention and the circumstances of the case.

(5) Subsections (1) to (3) shall not apply to patents of the federal authorities.

### *Transfer of Licenses*

**37.** A license granted by a patentee or by the Patent Office may not, without the consent of the patentee, be transferred *inter vivos* by the licensee except with the business for which it was granted. The license shall not pass on death to the licensee's successor in title unless he continues the same business.

### *Abuse of Patent Rights*

**38.** Where an agreement relating to the grant of a license to work a patented invention or to the obligation to grant such license contains a term — or where there is a collateral term — preventing the licensee from exercising a given activity, or limiting such activity, which does not relate solely to the manner or the extent of working the invention, the Federal Minister of Commerce, Trade and Industry may declare such term to be wholly or partially invalid if the interests of the national economy, national defense, public safety or other general interest are prejudiced thereby.

**39.** Section 38 shall apply in particular to agreements prohibiting the licensee from manufacturing, putting on the market, offering for sale or using products for the manufacture of which the patented invention is not needed or from employing a process not covered by the patent, and to agreements requiring the licensee to manufacture products in such a way as to permit or to render impossible or difficult the use of other products or requiring the licensee to refrain from putting on the market, offering for sale or using products not corresponding to such conditions of manufacture.

**40.** Section 38 shall not apply where, apart from a restriction of the kind referred to in Section 38, the licensee is not subject to any additional contractual payment.

**41.** The Federal Minister of Commerce, Trade and Industry may revoke a declaration of invalidity under Section 38 if the grounds on which it was made subsequently cease to exist. In his decision he shall determine the date on which the annulled term again becomes valid.

**42.** Where a contractual term is declared invalid under Section 38, the rest of the agreement relating to the grant of a license, referred to in Section 38, or to the obligation to grant a license, shall not be affected. A declaration shall not give grounds for requesting the rescission or amendment of the agreement, even where such a request can be made under the contract by one or both of the parties.

### *Entry in the Patent Register*

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

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

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

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

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

(6) An application for such entry shall be accompanied by the instrument on which the entry is to be based. For *inter vivos* transactions, the instrument shall contain the essential particulars relating to the legal act and a declaration of the person alienating his right that he consents to the entry in the Patent Register. An instrument other than a public instrument shall bear the duly certified signature of the person alienating his right. In place of the original, a duly certified copy of the instrument may be submitted.

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

### *Charges*

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

### *Entries Relating to Disputes*

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

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

### *Expiry*

**46.—** (1) A patent shall expire:

1. not later than completion of the maximum duration if the annual fees are paid in time;
2. if the annual fee is not paid in time;
3. if it is surrendered by the patentee.

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

(3) Expiry shall take effect at the end of the day following completion of the maximum duration in the case set out in **subsection (1)1** following the expiry of the last year of validity in the case set out in **subsection (1)2** and following notification of surrender to the Patent Office in the case set out in **subsection (1)3**.



## *Revocation*

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

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

(3) Subsection (1) shall not apply to patents of the federal authorities.

## *Declaration of Nullity*

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

1. the subject matter is not patentable under Sections 1 to 3,
2. the invention is the subject matter of a patent belonging to a prior applicant,
3. the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art,

4. a microorganism deposited under Section 87a(2)1 was not constantly available at either the original depository authority within the meaning of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of April 28, 1977, BGBl. No. 104/1984, in its currently applicable version (Budapest Treaty) or another depository authority to which it has been transferred under that Treaty, unless the patentee proves that

- (a) he has made a new deposit of the microorganism, which is to be treated, in accordance with **Article 4** of the Treaty, as if it had been made on the date on which the original deposit was made, or
- (b) that he has been prevented from making such new deposit by an unforeseen or unavoidable event and has subsequently made such deposit within two months of the cessation of the impediment.

(2) Where the grounds for nullity apply only in part, the declaration of nullity shall take the form of a corresponding limitation of the patent.

(3) The final declaration of nullity shall be retroactive in the cases set out in **subsection (1)1 to 3** to the date of filing, and in the case set out in subsection (1)4, to the day on which the depository authority first determined that it was not in a position to furnish samples of the microorganism. In the case set out in subsection (1)2, however, rights under a license lawfully granted by the later applicant and acquired in good faith by third parties, which have been on the patent register for one year, shall, provided that they are not the subject of a well-founded entry relating to a dispute (Section 45), be unaffected by such retroactive effect, without prejudice to any claims for compensation which may be made against the later applicant.

## *Declaration of Lack of Title*

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

1. that the patentee was not entitled to the grant of the patent (Sections 4(1), 6 and 7);

2. that the essence of the application had been usurped from the descriptions, drawings, models, implements or installations of a third person or from a process used by him.

(2) Where one of the conditions referred to (subsection (1)1. and 2.) applies only in part, the patentee shall be declared only partially lacking in title.

(3) In the first case, only the person entitled to the grant of the patent shall have a right to a declaration of lack of title; in the second case, only the injured person. A claim against a bone fide patentee shall become statute-barred after three years from the entry of the patent in the Patent Register.

(4) Claims to compensation and reimbursement arising from a declaration of lack of title shall be governed by the civil law and be the object of civil proceedings.

(5) Where the applicant's claim is allowed, he may, within a month of the decision becoming final, request transfer of the patent to himself.

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

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

### *Declaration of Dependence*

**50.** Any patentee may apply to the Patent Office for a declaration that the industrial application of a patented invention entails the full or partial use of his invention. Such application shall be dealt with by the Patent Office under the procedure relating to disputes as to title.

### *Right of Retaliation*

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

### *Time Limits*

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

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

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

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

(3) Where a time limit is expressed in weeks, months or years, the period shall end with the end of the day of the last week or the last month which in name or number corresponds to the date

on which time began to run. Where there is no such day in the last month, the period shall end at the end of the last day of that month.

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

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

(3) In the case of submissions posted in Austria, the days during which such documents are in the post shall not be counted for the purposes of the time limit. This shall not apply in cases where the day of receipt of the submission by the Patent Office is the operative date (Sections 102(1) and 129(3)).

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

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

## **II. Patent Authorities and Institutions**

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

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

(2) It may be agreed, in the interests of international cooperation in the field of industrial property, that the Patent Office provide, to States or international inter-governmental or non-governmental organizations dealing with matters in that field, technical or legal assistance free of charge or on reimbursement of reasonable costs. Provision of services free of charge may only be agreed where this is in the public interest, or is for the purposes of development aid or incurs only insignificant costs.

### *Services and Information Provided by the Patent Office*

**57a.** The Patent Office shall, on request, furnish written reports

1. on the state of the art in relation to a specific technical problem (searches) and
2. on the patentability of an invention under Sections 1 to 3 in relation to the state of the art as announced by the applicant or to be assessed by the Patent Office.

**57b.**— (1) The Patent Office shall develop the services and information it provides and shall, in particular, exploit its documentation in order to make it more accessible and shall furnish to the public improved information in all relevant areas.

(2) The President of the Patent Office shall lay down the fees for the provision of services and information by the Patent Office in a schedule of charges based on the principle of cost coverage. In those cases in which the service provided is primarily in the public interest, a lower charge or no charge may be provided for.

(3) The schedule of charges and any amendments thereto shall be notified in the Patent Gazette (Section 79).

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

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

(2) The Patent Office shall consist of the President, his deputies and the required number of legally qualified and technically qualified members.

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

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

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

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

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

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

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

(2) The technically qualified temporary members shall have completed a course at a technical university or a course in mathematics or science in the philosophy faculty of a university, and shall have held, for not less than five years, a position for which completion of such a course was required. In addition, they must have special knowledge of a particular technological subject.

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

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

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

(6) Temporary members who are not civil servants shall take the following oath before the President prior to exercising their duties: "I solemnly promise that I shall perform my duties conscientiously and impartially and that I shall observe secrecy on anything that may come to my

knowledge in the course of my official duties.” This oath shall be signed. Where an official is reappointed, it shall be sufficient to remind him of the oath he has taken.

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

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

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

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

### *Structure of the Patent Office*

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

(a) Technical Sections and at least one Legal Section,

(b) at least one Appeal Section,

(c) at least one Nullity Section,

(d) at least one President’s Section,

(e) a Library,

(f) an Accounts Section.

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

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

(a) the Technical Section shall be responsible for the procedure for the grant of patents and for the furnishing of written reports in accordance with Section 57a, and the Legal Section for matters relating to the transfer of the right arising from an application, to other forms of alienation of such right, to patents granted, and to applications for restoration of rights, to the extent that the Appeal or Nullity Section is not responsible;

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

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

(d) the President’s Section shall be responsible for matters reserved to the President.

(4) For the discharge of the Patent Office’s functions, the President shall also establish the necessary sub-offices.

(5) The President may place a sub-office directorate in charge of sub-offices.

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

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

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

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

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

(6) The allocation of activities in the Technical Section and Legal Section shall be determined by the President for every year in advance on the advice of the Section head. Short-term changes in the allocation of business necessitated by illness or other events preventing attendance shall be arranged by the head of the Technical Section or Legal Section.

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

### *Decisions in the Sections*

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

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

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

(4) The legally qualified member assigned to the Technical Section shall participate in the decision under subsection (3) with the right to vote or, where a decision may be taken by the examiner alone (subsection (1)) he shall first obtain the opinion of the legally qualified member, in the following cases:

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

2. where opposition is based on Section 102(2)6 or 7;
3. where a decision is to be taken on applications to be dealt with under Section 110;
4. where a decision is to be taken on priority rights claimed on the basis of international agreements and the legal foundations of such claims are in doubt or are contested;
5. where witnesses or experts have been heard or an inspection has been carried out;
6. where a decision is to be taken regarding an administrative or disciplinary penalty.

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

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

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

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

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

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

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

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

**64.**— (1) Decisions of the board shall be taken by a simple majority. The chairman shall have the deciding vote.

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

(3) All decisions of the Patent Office shall be taken in the name of the “Austrian Patent Office,” with the addition of the Section or sub-office; in matters reserved to the President, the words “the President” should be included. Written communications shall be dated and signed. Collective decisions shall be signed by the President. The signature may be replaced by an official certification to the effect that the copy delivered is a true copy of the document in question and that the original contains the signature required. Further particulars shall be settled by order.

(4) Communications issued with automated aids need not be signed or certified.

**65.**— (1) The instructions required to prepare the decision to be adopted by the Technical Section shall be issued by the examiner. Except insofar as merely formal defects in submissions or

the description submitted are to be corrected, a record shall always be taken where parties, witnesses or experts are heard.

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

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

(4) If there is no unanimity in the board regarding the decision or the reasons given for it, a record shall be taken showing the views of the members of the board and the result of the vote taken. Otherwise an entry regarding the vote signed by all members of the board shall be sufficient.

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

### *Official Dress*

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

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

### *Business Routine*

**68.** The business routine in the Sections and sub-offices shall be regulated by an order of the President of the Patent Office, having regard to the need for orderly and rapid work and to the tasks of the Patent Office. The order shall also determine how applications may be made direct to the Patent Office and when they are deemed to have reached the Office. Care shall be taken to ensure that the time of receipt of the application is precisely identified by day, hour and minute.

**69.** Against the decisions of the President falling within his responsibility under this Law, an appeal shall lie only if it is expressly provided for in this Law. **Section 2(2)** of the Law on Administrative Procedure (BGBl No. 54/1958) shall not, however, be affected.

### *Appeals Against Decisions of Sections*

**70.—** (1) The decisions of the Technical Section and Legal Section shall be subject to appeal.

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

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

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

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



**71.**— (1) The appeal shall contain a formal application and shall be lodged with the Patent Office within two months from the date when the decision was served; it shall be substantiated not later than one month after the expiration of this period.

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

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

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

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

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

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

**73.**— (1) The chairman may order a hearing in the appeal. He shall order a hearing if the applicant or any adverse party so requests. The hearing shall not be in public. Section 119(2) shall apply.

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

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

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

(5) The Appeal Section shall reach its own decision, having complete discretion as to its evaluation of the facts and evidence submitted. The Appeal Section may substitute its opinion for that of the Technical Section or Legal Section, both as to the decision and to the reasons given. It may accordingly amend the decision appealed against in any way.

(6) The Appeal Section shall deliberate and vote in camera. Section 65(3) and (4) shall apply *mutatis mutandis*. Decisions to stay proceedings may be taken in writing by circular on condition that no member is opposed.

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

### *Supreme Patent and Trademark Chamber*

#### *(Oberster Patent- und Markensenat)*

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

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

(3) The legally qualified members shall have completed a university course in law and political science and shall have held, for not less than 10 years, a position for which completion of such a course was required. In addition, they shall have engaged in research or practical work in the field of the protection of industrial property. At least three members shall be judges; at least three members shall be lawyers of Group A in the Federal Ministry of Commerce, Trade and Industry or legally qualified permanent members of the Patent Office.

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

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

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

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

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

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

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

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

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

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

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

(c) registrars shall receive 3 to 10 percent

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

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

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

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

### *Reasons for Exclusion*

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

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

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

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

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

5. in appeals against a decision in which they have taken part;

6. for any other major reason likely to place their complete impartiality in doubt.

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

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

1. in proceedings concerning applications for a declaration of nullity of a patent if they have taken part in the decision regarding the publication or the grant of the patent;

2. in proceedings concerning all other applications within the responsibility of the Nullity Section in the circumstances referred to in paragraph (1) where the proceedings are based on a situation which was the subject of a decision in proceedings before the Technical Section or the Legal Section or the Appeal Section.

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

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

### *Representatives of the Parties*

77. Only attorneys at law, patent attorneys and officials of the *Finanzprokurator*<sup>1</sup> may represent parties professionally before the Patent Office and before the Supreme Patent and Trademark Chamber.

### *Prohibition of Unauthorized Legal Representation*

#### *(Winkelschreiberei)*

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

1. prepares written documents or drawings for proceedings before Austrian or foreign authorities,

2. gives information,

3. represents parties before Austrian authorities, or

4. offers to conduct any of the activities referred to in items 1 to 3, without being authorized in Austria to represent parties professionally in such matters, shall be

---

<sup>1</sup> An authority under the Federal Ministry of Finance dealing with legal business relating to State property.

guilty of unauthorized legal representation and shall be liable to a fine not exceeding 3,000 schillings imposed by the district administrative authority.

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

### *Patent Gazette*

**79.**—(1) The Patent Office shall issue periodically a Patent Gazette (*Patentblatt*) containing the public notices provided for in this Law and the orders issued by the President of the Patent Office, except where they are solely intended for the sections and sub-offices of the Patent Office. Unless otherwise provided, these orders shall take effect on the day after the issue of the Patent Gazette containing the notice concerned.

(2) The preparation and publication of the Gazette shall be regulated by an order of the Federal Minister of Commerce, Trade and Industry.

### *Patent Register, Patent Documents*

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

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

(3) Any person may inspect the Patent Register.

(4) The Patent Office shall publish the descriptions, claims, drawings and abstracts of granted patents, on condition that they are open to public inspection, in separate printed copies (patent specifications). The specification shall state the citations that the Patent Office has taken into consideration in assessing the patentability of the filed invention.

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

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

### *Access to Documents*

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

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

(3) Third parties may not inspect the files relating to unpublished patent applications without the consent of the applicant. The consent of the applicant shall not be required for any person who can prove that the applicant has invoked the rights under the application against him. After the publication of a separate application (Section 92a), any person may inspect the files of the unpublished earlier application without the consent of the applicant.

(4) Files relating to patents under Section 110 may only be inspected by third parties with the consent of the patentee and files relating to reports (Section 57a) may only be inspected with the consent of the petitioner.

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

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

(7) Records of deliberations and parts of files relating solely to internal administrative transactions shall not be accessible to the public.

### *Samples of Deposited Microorganisms*

**81a.** Any person shall be entitled to a sample of a microorganism deposited in accordance with Section 87a(2)1, as from the date of publication of the application (Section 101(1)), on condition that he guarantees the applicant or patentee that the deposited microorganism or a microorganism derived therefrom will not be made available to third parties before

1. the application is withdrawn or refused (Sections 100 and 104) or is deemed to be withdrawn (Section 166(6)), or

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

### *Administrative and Disciplinary Penalties*

#### *(Ordnungs- und Mutwillensstrafen)*

**82.—**(1) The person who is in charge of deliberations or an examination or who is taking evidence or hearing a witness shall ensure that order and propriety are maintained.

(2) Persons who disrupt official proceedings or violate the rules of propriety by misconduct shall be reprimanded; if the reprimand is not needed, they may, after a prior warning, be deprived of the right to speak, or removed and ordered to appoint a representative, or sentenced to a fine of 1,000 schillings and, in default, to detention not exceeding three days. In aggravating circumstances, the sentence of detention may be substituted for the fine or imposed in addition.

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

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

(5) Disciplinary penalties against public authorities who, in the exercise of their duties, act as representatives and are not subject to disciplinary regulations may not take the form of detention. Where public authorities and representatives authorized to act for parties on a professional basis are

subject to disciplinary regulations, no disciplinary penalty shall be imposed but the case may be reported to the disciplinary authority in question.

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

**83.** Persons who avail themselves of the services of the Patent Office or the Supreme Patent and Trademark Chamber in an obviously frivolous fashion or make incorrect statements in order to obstruct the proceedings may be sentenced to a fine not exceeding 1,000 schillings and, in default, to detention not exceeding three days. In proceedings where the decision is taken by a board, the board shall decide on the disciplinary penalty.

**84.**—(1) The fines referred to shall be made over to the Federal Republic **Sections 12, 54 and 67** of the Law on Administrative Penalties, 1950, shall apply to the penalties referred to.

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

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

### *Service of Documents*

**85.** The documents drawn up by the Patent Office and the Supreme Patent and Trademark Chamber shall be served, unless otherwise provided in Section 86 of this Law, in accordance with the provisions of the Law on Administrative Procedure (BGBl. No. 200/1982).

**86.** In case of doubt, where an application has been made by two or more persons not all of whom live in Austria, the Austrian resident whose signature first appears on the application shall be deemed to be authorized to act on behalf of all the interested parties.

## **III. Procedure**

### **A. GRANT OF PATENTS**

#### *Filing of an Application*

**87.**—(1) Applications for patents shall be filed at the Patent Office in the written form prescribed. Filing may be effected by hand or by post. There shall be an application fee (Section 166(1)).

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

#### *Disclosure*

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

(2) If an invention concerns a microbiological process or the product of such process and involves the use of a microorganism which is not available to the public and which cannot be

described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in subsection (1) if

1. a culture of the microorganism has been deposited with a depositary authority under the Budapest Treaty not later than the filing date of the application,

2. the application as filed gives such relevant information as is available to the applicant on the characteristics of the microorganism, and

3. the depositary authority and the file number of the culture deposit are notified to the Patent Office before the decision to publish (Section 101(1)) is taken.

### *Unity*

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

### *Requirements of the Application*

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

1. the name and place of business or place of residence of the applicant and, where appropriate, of his representative in Austria;

2. the request for the grant of a patent;

3. a short, relevant designation of the claimed invention (title);

4. a description of the invention;

5. one or more claims (Section 91(1));

6. any drawings required to understand the invention;

7. an abstract (Section 91(2)).

(2) Those parts of the application referred to in subsection (1) 4 to 7, shall be filed in duplicate. They may also be written in the English or French languages.

**90.** Where the application is made through a representative, his power of attorney shall be attached.

**91.**—(1) The claims shall define in an exact and differentiated manner the matter for which protection is sought. They shall be supported by the description.

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

(3) The description, the claims, the drawings and the abstract may be amended until such time as the decision to publish (Section 101(1)) is taken. Where amendments affect the essence of the invention, they shall be taken out of the application and, if the applicant wishes to obtain protection for them, separate applications must be filed (Section 92a).

**91a.**—(1) If parts of the application are written in the English or French languages (Section 89(2)), a translation into German shall be filled within three months of the filing date of the application, the correctness of which shall be certified by a sworn court interpreter in Austria, by a representative of the parties referred to in Section 77 or by the applicant, where the latter has his place of business or place of residence in Austria. The preliminary examination procedure shall be based on such translation; errors of translation may not be corrected.



(2) Where no translation is filed within the time limit, the application shall be deemed to have been withdrawn.

**92.** The form and content of applications shall be governed in detail by ordinance. Consideration shall be paid thereby to optimum practicality and simplicity and to the comprehensibility of the patent specification and also to the needs of printing and publication.

### *Division of the Application*

**92a.**—(1) The applicant may voluntarily divide the application up to such time as the decision to publish (Section 101(1)) or the decision to reject (Section 100(1)) is taken. Where the part that is removed is not applied for separately at the time of revision, the applicant shall be given a time limit for so doing if he so requests at the time of division.

(2) Where the application lacks unity (Section 88) or has been inadmissibly amended (Section 91(3)), the applicant shall be given prior notification with an invitation to divide the application and a time limit shall be notified to him for filing a separate application in respect of the part to be divided.

(3) At the request of the applicant, the lack of unity (Section 88) of the application shall be determined by decision. At the same time, the applicant shall be given a time limit, beginning when the decision becomes legally valid, for dividing the application and for filing a separate application for the part to be divided.

(4) Where the application is rejected in whole or in part on the grounds that it has been inadmissibly amended (Section 91(3)) and, despite the invitation to do so, has not been divided or because opposition based on Section 102(2)4, has been successful, a time limit for filing a separate application for the inadmissible amendments, beginning when the decision becomes legally valid, shall be notified to the applicant at the same time as the decision.

(5) Where the separate application is filed at the same time as the division of the original application (subsection (1)) or subsequent to division but within the time limit (subsections (1) to (4)) laid down for separate application, its filing date shall be the day on which the original application was filed with the Patent Office or on which the amendment was notified to the Patent Office in the proceedings concerning the original application.

### *Priority*

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

(2) From such date he shall have priority over every similar invention the subject of a later application.

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

**94.**—(1) Separate priority for separate parts of the subject matter of the application (partial priorities) may be claimed only on the basis of international agreements. Such partial priorities shall also be admitted where the date of receipt of the application by the Patent Office is decisive for the priority of a characteristic of the subject matter of the application. More than one priority may be claimed for each patent claim.

(2) The application fee shall be the single fee multiplied by the number of all priorities of the application. Where proof of payment of the full fee is not established within the applicable time limit (Section 158(3)), priority of the application shall be determined according to the date of its

receipt by the Patent Office (Section 93). The amount by which the partial fee may exceed the single application fee shall be refunded.”

**95.**—(1) The right of priority granted in **Article 4** of the Paris Convention for the Protection of Industrial Property in its currently applicable form (BGBl. No. 369/1973) must be expressly claimed. The date and country of the application, the priority of which is claimed, shall be indicated (declaration of priority), as well as the serial number of that application.

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

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

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

**96.** [Repealed]

**97.** [Repealed]

**98.** [Repealed]

### *Preliminary Examination*

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

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

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

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

(5) If, within the period laid down, neither a statement of the case in reply to the preliminary decision nor an application for an extension of the period is submitted (subsections (2) and (3)), the application shall be deemed withdrawn. This legal consequence shall not take effect if, within four months of the expiry of the period (subsections (2) and (3)), the statement of the case in reply to the preliminary decision is made, if a fee equal to the application fee is paid and if proof (Section 168(3)) of payment of the fee is submitted. If proof of payment is not submitted in time, a period of one month, which may not be extended, shall be prescribed for the applicant.

(6) The President of the Patent Office may issue guidelines on the principles governing the preliminary examination and on the procedure for such examination by the members of the Technical Section. In particular, he may determine the time limits to be laid down by the Office. In

this connection, he shall take account of the need for as rational and careful a preliminary examination as possible and for uniformity in the treatment of applications.

### *Rejection of Applications*

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

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

### *Publication and Laying Open for Public Inspection*

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

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

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

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

### *Opposition*

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

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

1. that the subject matter of the published application is not patentable under Sections 1, 2 and 3;

2. that the invention is, in whole or in part, already the subject matter of a patent or of an earlier publication which is pending with a view to the grant of a patent;

3. that the published application does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

4. that the subject matter of the published application

(a) extends beyond the content of the application as filed, or

(b) in the case of a separate application under Section 92a or an application under Section 106, extends beyond the content of the earlier application as filed;

5. that the microorganism deposited under Section 87a(2)1 was not constantly available at the original depositary authority under the Budapest Treaty or at another depositary authority to which it had been transferred under that Treaty, unless the applicant proves

(a) that he has made a new deposit of the microorganism and that the deposit is to be dealt with in accordance with **Article 4** of that Treaty as if it had been made on the day of the original deposit, or

(b) that such new deposit had been prevented by an unforeseen or unavoidable event and that it was subsequently made within two months of the cessation of that impediment;

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

7. that the essence of the application which is opposed has been usurped from the descriptions, drawings, models, implements or installations of a third party or from a process used by that party without its consent.

(3) Opposition under subsection (2)6 may only be raised by the person who has claim to grant of the patent and opposition under subsection (2)7 may only be raised by the injured party.

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

(5) Within the period prescribed for opposition (subsection (1)), a declaration of dependence (Section 4(3)) may be applied for by an earlier patentee. The provisions concerning opposition shall apply to such application.

### *Procedure for Opposition*

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

(2) The Law on the Scale of Fees, 1975 (*Gebührenanspruchsgesetz*), BGBl. No. 136/1975, in its currently applicable form, shall be applicable. However, witnesses may only claim reimbursement of costs if their place of residence is in Austria.

### *Assessment of the Evidence and Decision*

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

### *Costs*

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

### *Application for a Patent by Opponent*

**106.** Where, in the cases provided for in Section 102(2)6 and 7, opposition results in the withdrawal or rejection of an application, the opponent may, if he files an application within one

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

### *Grant of Patent Without Opposition Proceedings*

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

### *Appeals*

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

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

### *Letters Patent—Publication*

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

### *Patents of the Federal Authorities*

**110.**—(1) If the invention is one filed by the federal authorities in the interests of the equipment of the armed forces or in some other federal interest or one concerning which the federal authorities have exercised their right of expropriation (Section 29), the patent shall, at the request of the federal authorities, be granted by a decision without any publication. In this case, there shall also be no laying-open for public inspection of the application (Section 101(3)) or printing of the specification and no entry of the subject of the invention in the public Patent Register. Publication and complete entry may, however, be subsequently requested by the federal authorities.

(2) The duration of such unpublished patents shall be 18 years from the final decision to grant, but with a maximum of 20 years from the date of filing.

(3) The first annual fee shall be payable before any decision regarding the grant of the patent is taken and within two months after the official notice asking for payment has been served. If no payment is made, the application shall be deemed withdrawn.

(4) The second and subsequent annual fees shall be payable for each year in advance from the day of the final decision. Payment of these fees shall be governed by the rules which are otherwise applicable regarding payment of annual fees.

### *Refusal*

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

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

## **B. REPORTS**

## *Requirements for Applications and Processing Thereof*

**111a.**—(1) A request for search under Section 57a.1 may relate to one specific technical problem only. The request may also ask that the research extend back to an earlier date. The request shall be accompanied by a precise and clear description and, where necessary, a brief summary of the specific technical problem, and by drawings.

(2) The request for a report under Section 57a.2 shall be accompanied by the description of the invention, the claims and, where necessary, drawings. Section 91(1) shall apply *mutatis mutandis*. Where the applicant does not state the prior art on which the report is to be based, the report shall be based on the prior art known by the Patent Office at the time it receives the request. The request may also ask that the report extend back to an earlier date.

(3) Requests for a report under Section 57a, together with their annexes (subsections (1) and (2)) shall be filed in writing and in duplicate. The description, the claims and the summary may also be in the English or the French languages, in which case the Patent Office shall be entitled to require a German translation.

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

(5) Where the request or an annex is defective, the applicant shall be called upon to remedy the defect within a specified time limit. Where the defect is not remedied, the request shall be rejected by decision. The decision to reject may be appealed from.

## **C. CHALLENGE OF A PATENT**

### *Making an Application*

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

(2) Applicants not resident in Austria shall provide security for the costs of proceedings if the defendant so requires. Such request must be made within 14 days of notification of the application, failing which security may no longer be demanded.

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

### *Immediate Rejection*

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

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

(3) Such decisions shall be final.

## *Form and Contents of the Application*

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

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

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

(4) [Repealed]

## *Third Party Intervention*

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

(2) In all other cases, [Sections 18 to 20](#) of the Code of Civil Procedure shall apply *mutatis mutandis*.

## *Procedure for Applications Challenging a Patent*

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

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

## *Preliminary Proceedings*

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

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

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

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

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

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

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

(8) After the reply has been received or the period laid down for its submission has expired and also, if applicable, after the preliminary proceedings have been held, the rapporteur shall submit the files to the chairman with a written statement of the facts and of all points of fact and law relevant to the decision, as well as his conclusions (report). The legally qualified rapporteur shall report on legal questions and the technically qualified rapporteur on technical questions. The chairman may request a rapporteur or other voting member to supplement the report.

### *Termination of Proceedings Without a Hearing*

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

### *Public Notice of the Hearing*

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

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

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

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

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

### *The Hearing*

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

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

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



## *Evidence and the Taking of Evidence*

**120.**—(1) Unless otherwise provided by this Law, **Sections 266 to 283** of the Code of Civil Procedure shall apply *mutatis mutandis* to the taking of evidence.

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

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

(4) The Law on the Scale of Fees, 1975, BGBl. No. 136/1975, in its currently applicable form, shall be applicable. However, witnesses may only claim reimbursement of costs if their place of residence is in Austria.

(5) Disciplinary penalties imposed pursuant to **Sections 313, 326, 333 and 354** of the Code of Civil Procedure shall not exceed 1,000 schillings or a three-day detention in default of payment. While evidence is taken during a hearing, disciplinary penalties shall be imposed by the board; during the preliminary proceedings, they shall be imposed by the rapporteur (Section 116(1)). Section 84(1) and (3) shall apply.

## *Deliberation and Vote*

**121.** The Nullity Section shall deliberate and vote *in camera*, Decisions to stay proceedings may be taken in writing by circular on condition that no member is opposed.

## *Costs*

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

(2) Where an application is withdrawn, the applicant shall reimburse the defendant's costs.

## *Contents of the Decision*

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

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

## *Announcement of the Decision*

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

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

## *Record*

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

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

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

## *Assistance of the Courts*

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

## *Reopening of Proceedings*

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

1. where a document on which the decision is based has been forged or falsified;

2. where the decision is based on a false deposition of a witness or expert or on a perjurious statement of the defendant made during the hearing;

3. where the decision was obtained through fraud, amounting to a crime, on the part of the representative of the party or the defendant or his representative;

4. where a member who has taken part in the decision or in an earlier decision on which the decision is based has, to the party's detriment, committed a violation of his official duties amounting to a crime;

5. where the decision was based on a finding made during criminal proceedings which has subsequently been upset in a judgment that has become final.

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

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

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

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

**128.** If the Patent Office has mistakenly entered a patent in the Register as invalid, it shall, after ascertaining the mistake, order the entry to be removed and the removal to be published. Rights of third parties which have in the meantime been acquired in good faith shall be safeguarded in this case as in that of the reopening of proceedings.

## *Restoration of Rights*

**129.**—(1) Any person who is prevented by an unforeseeable or unavoidable event from observing a time limit, and is thus prejudiced by the application of a rule relating to the protection of inventions, may apply for restoration of rights. A failure to comply implying a lesser degree of oversight shall not prevent restoration of rights.

(2) Restoration shall not be granted:

1. where the time limit for the application for restoration (Section 131(1)) and the time limit for appeal in relation to such application have not been observed;

2. where the time limits for submission of a statement of the case (Section 99(5)), for opposition (Section 102(1)) and for the opponent's appeal (Section 71(1)) are not observed;

3. where the time limit for lodging a claim in the ordinary courts has not been observed.

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

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

(2) In matters within the responsibility of the Nullity Section of the Patent Office, decisions shall be taken by the chairman of the Section, from whom an appeal shall lie to the Supreme Patent and Trademark Chamber in accordance with the relevant provisions. For all other matters within the responsibility of the Patent Office, the other provisions in force shall apply to the manner in which the decision is taken and in which it may be contested.

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

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

(3) A copy of the application for restoration and its attachments shall be supplied to any adverse party in the case.

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

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

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

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

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

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

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

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

(3) Any acceptance of restoration shall be published in the Patent Gazette to the extent that it relates to a protected right the extinction of which requires official publication.

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

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

**135.** With the acceptance of restoration, the legal consequences resulting from non-observance of the time limit shall cease to have effect. The authority shall issue appropriate instructions to give effect to the decision.

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

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

### *Execution*

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

(2) The Patent Office shall *ex officio* make the necessary entries and deletions in its registers to give effect to its own final decisions and to those of the Supreme Patent and Trademark Chamber. In the case of collective decisions of the Patent Office, the President shall issue the necessary instructions; in the case of decisions of the Supreme Patent and Trademark Chamber, this shall be done by the chairman of the Nullity Section. This provision shall also apply to reimbursement of the fees under Section 168(5).

## *Appeals*

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

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

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

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

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

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

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

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

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

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

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

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

(3) If the Supreme Patent and Trademark Chamber finds that the Nullity Section has infringed procedural provisions thereby preventing a decision according to law or if the Chamber considers further evidence essential, it shall refer the case back to the Nullity Section.

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

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

1. where the formal defects of the appeal have not been remedied within the period prescribed under Section 141;

2. where the appellant is not entitled to lodge the appeal;

3. where the appeal ought to have been dismissed by the Nullity Section (Section 139(3));

4. where the appeal is against decisions under Sections 113 and 139(3);

5. where the appeal is against a decision regarding an application for restoration (Section 130(2));

6. where the appeal is solely against a decision regarding reimbursement of costs (Section 122);

7. where the appeal is solely based on the claim that an infringement of procedural provisions has prevented a decision according to law or where the documents in the file show that the case must be referred back to the Nullity Section because of the infringement of such procedural provisions.

(2) Where no final decision regarding an appeal is to be rendered, a decision may also be taken internally without a meeting of the Chamber if the president regards a meeting as unnecessary because of the simplicity of the case. If, in these circumstances, a member of the Supreme Patent and Trademark Chamber expresses an opinion differing from the rapporteur's proposal, a meeting shall in any event be held.

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

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

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

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

**144.** The appeal may be withdrawn before the end of the hearing. If the appeal is withdrawn before the hearing, the adverse party shall, if necessary, be allowed a period in which to substantiate a claim to reimbursement of his costs. If no costs are recorded, the rapporteur shall terminate the proceedings. In all other cases, decisions regarding the close of proceedings and the claim to reimbursement of costs, if any, shall be taken *in camera*.

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

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

(3) The rapporteur shall draw up the decision to be issued on the basis of the decisions taken. If his views were those of the minority, the chairman may assign the preparation of the text or parts

thereof to another member of the board. The chairman shall check the decision prepared to ensure its conformity with decisions taken.

146. [Repealed]

## IV. Violation of Patents and Obligation to Provide Information

### *Action for Restraint*

147.—(1) Any person who has suffered a violation of one of the rights belonging to him under a patent or has to take action against such a violation may apply for an injunction.

(2) Injunctions may be issued even where the conditions specified in **Section 381** of the Code of Dstraint are not met. Where reasonable grounds exist, the court may withdraw an injunction it has issued if the defendant provides adequate security.

### *Action for Elimination*

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

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

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

### *Publication of the Judgment*

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

(2) Publication shall comprise the judgment. At the request of the successful party, however, the court may decide to publish a text with a content that differs from the judgment in extent or wording or which supplements it. Such request shall be made at the latest four weeks after the judgment becomes legally valid. If the request is not made until after completion of the oral

hearing, the decision shall be taken by the first instance court once the judgment has become legally valid.

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

### *Monetary Claims*

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

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

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

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

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

### *Accounting*

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

### *Employer Liability*

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

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

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

### *Liability of Several Persons*

**153.** Where the same monetary claim (Section 150) is brought against more than one person, those persons shall be jointly and equally liable.

### *Prescription*

**154.** **Section 1489** of the Civil Code shall apply to all monetary claims (Section 150) and to claims to the presentation of accounts (Section 151). The period of limitation in respect of all such claims shall be interrupted by a petition for the presentation of accounts or by an application for declaration (Section 163).



## *Process Patents*

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

## *Preliminary Questions*

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

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

(3) Where a judgment is contingent on whether the patent is valid (Section 48), the court shall suspend the proceedings unless nullity is obviously to be rejected. If the defendant does not, within a month from the notification of the decision to suspend, prove that he has filed a nullity application with the Patent Office, that a nullity declaration procedure between the parties to a dispute is already pending, or that he has engaged in such a proceeding in the capacity of intervening third party, the court shall resume the proceedings at the request of the plaintiff. In that case, the court shall decide without regard to the claim of nullity, provided that any decision of the Nullity Section pronounced before the completion of the oral proceedings shall be taken into consideration.

(4) Where the court proceeding has been interrupted on account of a procedure pending before the Patent Office, the court shall, after the decision on the preliminary question has come into full force, continue the proceeding at the request of one of the parties on the basis of the decision on the preliminary question.

(5) Where the validity or effectiveness of a patent has been assessed by the Patent Office or the Supreme Patent and Trademark Chamber in a way that differs from that of the court hearing the dispute, this shall give grounds for a request for a new hearing (Section 530(1) of the Code of Civil Procedure); Section 532(2) of the Code of Civil Procedure shall apply *mutatis mutandis* in respect of jurisdiction and Section 544(1) of the Code of Civil Procedure shall apply *mutatis mutandis* to interruption of appeal proceedings; the time limit for appeal (Section 534(1) of the Code of Civil Procedure) shall be calculated from the day on which the decision as to the validity or effectiveness of the patent becomes legally valid.

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

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

1. The procedure shall be handled rapidly.

2. The receiving department shall immediately confirm to the party having filed a suspension decision, by means of the certifying copy of the relevant notification (Halbschrift), that he has initiated a proceeding before the Nullity Section, has engaged in a pending proceeding in the capacity of intervening third party, or has filed a decision to suspend in relation to a proceeding in progress.

3. The reply (Section 115(2)) shall be filed within a period of one month, which may not be extended.

4. Proof of statements that has not been submitted to the Patent Office and communicated to the opposing party two weeks at the latest before the oral proceedings may only be taken into consideration if the opposing party has no objection thereto.

5. The periods for appeal (Section 138) and for rebuttal shall be one month and may not be extended.

### *Provisional Patent Protection*

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

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

### *Willful Patent Violation*

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

(2) The same penalty shall be imposed on the owner or director of an enterprise who does not prevent the violation of a patent committed by a person working for him or on his behalf in the course of the activities of the enterprise. Where the owner of the enterprise is a legal entity, this provision shall apply to the bodies of the enterprise that have made themselves liable to the serving of an injunction. The enterprise shall be jointly and equally liable with the guilty party for the fines inflicted on the bodies.

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

### *Actions under Civil Law*

**160.** The assertion of claims under Section 150 shall be subject to the provisions of **Title XXI** of the Code of Criminal Procedure, 1975, BGBl. No. 631/1975, in its currently applicable form. Both parties shall be entitled to appeal against the decision on the claim for compensation.

### *Characteristics of Criminal Prosecution*

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

## *Jurisdiction*

**162.**—(1) The Commercial Court of Vienna shall have exclusive jurisdiction for actions and injunctions under this Federal Law. Decisions shall belong to the Chamber (Section 7(2), first sentence, Section 8(2) of the Jurisdictional Rules) irrespective of the value at dispute. This shall also apply to injunctions.

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

## *Application for Declarations*

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

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

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

(4) The application for a declaration may relate to only one patent, including any patent of addition. The application shall be accompanied by an accurate and clear description of the object or process, and drawings where necessary, in four copies. One copy of the description, and of the drawings if any, shall be attached to the final decision.

(5) When assessing the extent of protection under a patent that is the subject matter of declaration proceedings, the Patent Office shall take into consideration the contents of the grant file and of the prior art evidenced by the parties.

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

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

## *Infringing Objects Exempted from Elimination and Withdrawal*

**164.**—(1) Infringing objects (Section 148(1)) manufactured in fulfillment of a contract with the military authorities and means prepared for their manufacture may, insofar as the military authorities prove the filing of an expropriation request within a period to be specified by the court (Section 29), neither be eliminated under [Section 148](#) nor withdrawn under [Section 26](#) of the Criminal Code (*StGB*).

(2) The damages caused by such infringing objects to the party having suffered the expropriation shall be taken into consideration for the overall compensation.

## *Obligation to Provide Information Regarding Patent Protection*

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

## **V. Fees**

### *Application Fee and Annual Fee*

**166.**—(1) For every patent and for every patent of addition, an application fee of 600 schillings shall be payable on filing.

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

(3) The annual fee shall be:

	<i>Schillings</i>
for the first year.....	800
in addition to a fee of 350 schillings for the sixth and every subsequent page of the description and claims displayed and of 350 schillings for the third and every subsequent sheet of the drawings attached to that description,	
for the second year .....	800
for the third year.....	900
for the fourth year .....	1,000
for the fifth year .....	1,100
for the sixth year .....	1,300
for the seventh year.....	1,600
for the eighth year .....	2,200
for the ninth year.....	2,700
for the tenth year .....	3,300
for the eleventh year.....	4,400
for the twelfth year.....	5,500
for the thirteenth year.....	6,500
for the fourteenth year.....	9,500
for the fifteenth year.....	12,000
for the sixteenth year.....	15,000
for the seventeenth year .....	19,000
for the eighteenth year .....	24,000

(4) For patents of addition which are not declared independent patents (Section 28), a single annual fee shall be paid for the entire period of validity; this fee shall be 2,000 schillings in addition to 350 schillings for the sixth and every subsequent page of the description displayed and 350 schillings for the third and every subsequent sheet of the drawings attached to that description and claims.

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

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

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

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

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

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

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

**167.** A fee of 370 schillings shall be payable in respect of any request for amendment of the description, the claims, the drawings or the abstract (Section 91(3)) not made as a result of an official invitation.

### *Procedural Fees*

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

	<i>Schillings</i>
1. For the filing of opposition (Section 102) .....	600
2. For the filing of an appeal (Section 70)	
Where there is no adverse party .....	700
Where there is an adverse party .....	2,200
3. For any application to be dealt with by the Nullity Section ..	2,400
4. For an appeal (Section 138) .....	3,600
5.(a) For an application for entry of the right of prior user (Section 23(4)), an application for entry of a transfer (Section 33(2) and (3)), in the case of transfer <i>inter vivos</i> , an application for entry of a license or the transfer of a license (Sections 35 to 37) or an application for any of the entries in the Patent Register provided for in Section 43. ....	600
(b) for an application for an entry relating to a dispute in the Patent Register (Section 45) .....	250
(c) for an application for an extension of the time limit set for the submission of a case in reply to the preliminary decision (Section 99(4)) .....	120

(d)	for an application for suspension of publication and laying open of a patent application (Section 101(4)), where the duration of suspension requested exceeds three months, for every subsequent three-month period, periods of less than three months being counted as full three-month periods.....	600
6(a)	for a request for the carrying out of a search under Section 57a.1 .....	2,000
(b)	for a request for the preparation of a report under Section 57a.2 where the state of the art is indicated by the applicant	2,000
(c)	for a request for the preparation of a report under Section 57a.2 where the state of the art has to be assessed by the Patent Office .....	3,000

(2) The fees laid down in subsection (1)1 to 5 shall be paid for each application and for each patent that is the subject of an appeal or a request.

(3) Payment of the fees due to the Patent Office, with the exception of annual fees (Section 166(3) and (4)) shall be proved by submission of the original receipt for payment or remittance, or if necessary by duplicate receipts.

(4) If the proof of payment is not submitted within the period prescribed, the application shall be refused; Sections 99(5) and 171(1) shall not be affected.

(5) The fee for an appeal (subsection (1)2) shall be refunded if the appeal is essentially successful and if the proceedings have been conducted without an adverse party. Half of the fees provided for in subsection (1)3 and 4 shall be refunded if the application to be dealt with by the Nullity Section or the appeal is dismissed or the procedure is terminated without any hearing. Half of the fees provided for in subsection (1)5 shall be refunded if the application is withdrawn before a decision is taken. If, in the case of subsection (1)5(d), suspension is not granted for the entire duration applied for and if an amount less than that paid is due for the duration approved, the excess amount shall be refunded. The amount of 1,500 schillings shall be refunded on the fee fixed in subsection (1)6(a) and (b) and 2,500 schillings shall be refunded on the fee fixed in subsection (1)6(c) if the application is rejected or withdrawn before the date of issue of the search report.

(6) Special fees for official copies, publications, confirmations, certifications and extracts from the register may be laid down by ordinance. In the determination of the fees for each particular case, which shall not exceed 270 schillings, account shall be taken of the labor and material required for the official service involved. To the extent to which fees depend on the number of pages or sheets, Section 166(10) shall apply.

(7) Where fees are laid down by an order issued under subsection (6), official documents and documents in confirmation or certification may be prepared and issued only after payment of the relevant fee. Applications for official publication and applications which may be accepted only after official publication under this Law shall be refused if the relevant fees are not paid in time. Subsection (3) shall apply *mutatis mutandis*.

### *Method of Payment of Fees*

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

## *Stamp Duty*

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

## *Exemption from Payment of Fees*

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

(2) The President of the Patent Office shall cancel the fees provided for in Sections 167 and 168(1)1 to 4 and 5 (c) and (d) if the applicant proves that he is without means and if the application or the remedy for which the fee would be payable is not clearly frivolous or without prospect of success.

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

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

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

**172.** The privilege under Section 171 may be granted also to citizens of foreign States which, according to a notice to be published by the President of the Patent Office in the Patent Gazette, grant essentially the same privilege to Austrian citizens. Where such a State grants the privilege to Austrian citizens to a smaller extent than that provided for in Section 171, a corresponding restriction may be ordered for citizens of such State.

## **VI. Implementation**

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

1. in the case of Section 51, the Federal Government;
2. in the case of Sections 18, 29(4) (insofar as it relates to the determination of the request for compensation), 42, 49(4) and 147 to 156, and also Sections 158 to 162, 164 and 165, the Federal Minister of Justice;
3. in the case of Section 24(2), the Federal Minister of Finance in agreement with the Federal Minister of Commerce, Trade and Industry and the Federal Minister of National Defense;

4. in the case of Section 74(2) and (3) (insofar as it relates to the appointment of judges) and also in the case of Section 126, the Federal Minister of Commerce, Trade and Industry and the Federal Minister of Justice;

5. [repealed;]

6. in the case of Sections 56 and 170, the Federal Minister of Commerce, Trade and Industry and the Federal Minister of Finance;

7. in the case of Section 168(6), the Federal Minister of Commerce, Trade and Industry in agreement with the Federal Minister of Finance;

8. in the case of Section 57(2), the Federal Minister of Commerce, Trade and Industry, in agreement with Federal Minister of Foreign Affairs;

9. in the case of all other provisions of this Federal Law, the Federal Minister of Commerce, Trade and Industry.

## **Additional Provisions of the Law of May 23, 1984**

### **I. and II.\***

**III.** Where data are processed by automatic means for the purpose of establishing the registers kept by the Patent Office on the basis of statutory requirements or to satisfy the duty of the Patent Office to provide information to all persons, **Sections 11 and 12(2)2** of the Data Protection Law (BGBl. No. 565/1978), in its currently applicable version, shall not apply to the acquisition, processing, transmission, correction and cancellation of such data.

**IV.—(1)** To the extent and for as long as the Austrian reservation under **Article 167(2)(a)** of the European Patent Convention (BGBl. No. 350/1979), remains effective, patents shall not be granted for inventions concerning chemical products as such, food products for human consumption as such or pharmaceutical products as such, except where the invention concerns a process of manufacture or use of a food product for human consumption or a pharmaceutical product.

**(2)** Following the entry into force of this Federal Law (**Section VII(1)**), patents granted contrary to **paragraph (1)** shall be declared null and void on request.

**V.—(1)** Patents granted prior to the entry into force of this Federal Law (**Section VII(1)**) shall be declared null and void on request, should it transpire that their subject matter was not patentable under **Sections 1 to 3** of the Patent Law 1970 (BGBl. No. 259/1970), or that the invention constitutes the subject matter of a patent belonging to a prior applicant.

**(2)** Priority rights within the meaning of **Sections 96 to 98** of the Patent Law 1970 (BGBl. No. 259/1970), as amended by the Patent Law Amending Law 1977 (BGBl. No. 349/1977), claimed prior to the entry into force of this Federal Law, shall remain valid.

**VI.** **Sections 28, 46(1)1 and (3), and Section 110(2)** of the Patent Law 1970 (BGBl. No. 259/1970), shall continue to apply in respect of the duration and expiry of patents based on applications filed prior to the entry into force of this Federal Law (**Section VII(1)**).

**VII.—(1)** This Federal Law shall enter into force, subject to paragraphs (2) and (3), at the start of the sixth month following publication.

---

\* Section I enumerates the amendments to the Patent Law of 1970; these have been incorporated in the above text. Section II enumerates the amendments to the Federal Law on the Introduction of the European Patent Convention and the Patent Cooperation Treaty (Law Introducing Patent Treaties), of December 16, 1978 (see *Industrial Property Laws and Treaties*, AUSTRIA — Text 2-002)



(2) **Section I.15**, where it concerns Section 57b of the Patent Law, **Section I.16, 17, 20, 21, 47, 48, 50 to 59 and 65, Section II.4,5,6 and 9**, as also **Section III** shall enter into force at the start of the second month following publication.

(3) Section I.1, insofar as it concerns the second sentence of Section 2(2) and Section 3(2) of the Patent Law, shall enter into force on the day on which the Austrian reservation under **Article 167(2)(a)** of the European Patent Convention (BGBl. No. 350/1979), expires.

(4) Orders based on the Patent Law as amended by this Federal Law may be issued as from the day following its publication. However, they may not enter into force until this Federal Law enters into force.

VIII. The following shall be responsible for implementing this Law:

1. with respect to **Section I.14**, insofar as it concerns Section 57(2) of the Patent Law, the Federal Minister for Commerce, Trade and Industry, in consultation with the Federal Minister for Foreign Affairs;

2. with respect to **Section I.50 to 55 and 57**, the Federal Minister for Justice;

3. with respect to **Section I.65**, the Federal Minister for Commerce, Trade and Industry, in consultation with the Federal Minister for Finance,

4. with respect to all other provisions, the Federal Minister for Commerce, Trade and Industry.

---