

Trademark Protection Law, 1970

1. General Provisions

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

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

2. — Anyone desiring the exclusive right to the use of a mark shall obtain registration of the mark in the Trademark Register in accordance with the provisions of Part II of this Law.

3. — The exclusive right to the use of a registered word mark shall cover not only use of the mark in the pictorial form registered, but also its use in any presentation reproducing, in whole or in part, the protected word or words in other characters, colors or sizes.

4. — (1) The following shall not be registered: signs

(i) which consist exclusively

(a) of national armorial bearings, national flags or other State emblems or of the armorial bearings of Austrian provincial or local authorities;

(b) of official signs indicating control or warranty which are used in Austria or — pursuant to a notice to be published in the *Bundesgesetzblatt* (Section 6 (2)) — in a foreign State, for the same goods or services as those for which the mark is intended or for similar goods or services;

(c) of signs of international organizations in which a country member of the Paris Union for the Protection of Industrial Property is represented, in so far as such signs have been notified by the Federal Minister of Commerce, Trade and Industry in the *Bundesgesetzblatt*. Such notice shall identify the sign clearly; if the sign does not consist exclusively of figures, letters or words, the notice shall include a reproduction of the official presentation of the sign;

(ii) which consist exclusively of words solely giving particulars as to the place, time or manner of manufacture, or the nature, purpose, price, quantity or weight of merchandise or the place or time of a service or the method of performance; nature, purpose, price or scope of a service;

(iii) which are in general commercial use for the designation of certain kinds of goods or services;

(iv) which contain matter liable to cause annoyance or otherwise infringing public order or contain inscriptions or statements that are inaccurate and liable to mislead the public.

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

5. — Marks containing a distinctive sign or any other of the signs referred to in Section 4(1)(i) as one of their features may, in so far as the use of such sign is subject to statutory

restrictions, be registered only after the right to the use of such distinctive or other sign has been proved.

6. — (1) The national armorial bearings, the national flag or any other State emblems or the armorial bearings of an Austrian provincial or local authority may not without authorization be used in trade as marks of goods or services or as features of such marks. Nor may the signs referred to in Section 4(1)(i)(c) be used without the consent of the competent authority. Similarly, signs indicating control or warranty may not, without the consent of the authority issuing such signs, be used for the marking, or as a feature of such marking, of goods or services for which the sign has been introduced or of similar goods or services.

(2) Subsection (1) shall apply to foreign armorial bearings, flags or other State emblems or signs indicating control or warranty only in the event of an international agreement or of reciprocity and provided that the foreign sign subject to the prohibition has been notified in the *Bundesgesetzblatt*. Where such notice does not include a reproduction of the official presentation of the sign, it shall indicate how the public may have access to such reproduction.

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

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

8. Registration of a mark shall not prevent anyone from using his name, his trade name, the special designation of his enterprise, particulars of his residence or place of business and descriptive particulars (Section 4(1)(ii)), even in abbreviated form, for the marking of goods or services, provided that this is not done in a manner likely to give rise to confusion in trade.

9. — Use of a registered mark shall as a rule be optional, but the Federal Minister of Commerce, Trade and Industry may order that certain kinds of goods may not be put on the market until a mark registered in accordance with this Law has been affixed to them in a manner to be determined by order.

10. — The exclusive right to a mark shall not preclude another enterprise from using the same mark for other kinds of goods or services.

11. — (1) The right to a mark shall be vested in the enterprise for which the mark is intended; it shall lapse if the enterprise ceases to exist and pass to the new owner on change of ownership.

(2) If the enterprise is not continued under the same name, the new owner shall execute a transfer of the mark. Until such transfer has been recorded in the Trademark Register, the new owner may not assert his right to the mark and all official communications regarding the mark that are served on the registered owner of the mark or his registered agent shall be treated as service on the new owner.

12. — No one may, without the consent of the person authorized, use the name, trade name or special designation of the enterprise of another person for distinguishing goods or services.

13. — Use of a mark for goods or services shall mean not only use of the mark on the goods themselves or on articles for which a service has been or is to be performed or which are to be

employed for the provision of services, but also use of the mark on containers, wrapping or packaging and in advertisements and commercial stationery.

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

15. — Existing regulations regarding special designations required for certain goods, particularly regulations on hallmarks, shall not be affected by this Law.

II. Registration, Transfer and Cancellation of Marks

1. *Registration*

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

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

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

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

17. — (1) When a mark is registered, the following shall, in addition to the mark, be entered in the Trademark Register:

- (a) the serial registration number;
- (b) the date of the application and the priority claimed, if any;
- (c) the name of the registered owner of the mark and his representative, if any;
- (d) the objects of the enterprise;
- (e) the goods and services for which the mark is intended;
- (f) the beginning of the period of protection;
- (g) where appropriate, an indication that the mark was registered on the basis of proof that it is in use.

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

(3) The registered owner shall receive official confirmation of entries in the Register under subsections (1) and (2) except those regarding the representative and the nature of the business.

(4) The mark shall be published after registration. The printing block, if any, used for this purpose (Section 16(2)) shall be returned to the registered owner.

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

18. — (1) When registration of a mark is applied for, an application fee of 300 schillings shall be payable together with a class fee of 40 schillings for the first three classes or subclasses of the classification and of 100 schillings for the fourth class or subclass and for each additional class or subclass.

(2) Before a mark is registered, a fee of 400 schillings covering the period of protection shall be paid on demand, together with a contribution to the cost of printing for the publication prescribed (Section 17(4)). The amount of such contribution shall depend on the size of the publication and shall be laid down by order (Section 70(1)).

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

(4) In the case of applications for international registration (renewal) of a mark pursuant to the Madrid Agreement, an Austrian fee of 400 schillings shall be payable in addition to the international fee.

(5) Where application is made for information in writing — which is provided without any guarantee — concerning the result of a search into whether a particular sign is identical or similar (Section 14) to a mark registered earlier for the same or similar goods or services and still in force, a fee of 200 schillings shall be payable.

19. — (1) The period of protection shall begin on the day that the mark is accepted for registration (Section 20(2)). It shall end ten years after the end of the month in which such acceptance took place. The period may be extended by further periods of ten years provided that renewal of registration is applied for in time (subsections (2) and (3)). Further periods of protection shall, irrespective of the day of renewal, date from the end of the preceding period.

(2) The fee for renewal of registration shall be two and a half times the fee for the first period of protection (Section 18(2)).

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

20. — (1) Every application for registration of a mark shall be examined for compatibility with the Law.

(2) If such examination reveals obstacles to registration of the mark, the applicant shall be invited by a preliminary decision, which shall not be subject to a separate appeal, to submit his observations within a specified period. If, after the applicant's submission has been received in time or the time limit has expired, registration is found not to be admissible, the application shall be rejected by a final decision. If however the application is found to be admissible, registration shall be granted after an examination for similarity (Section 21) and payment of the fee prescribed in Section 18(2) and of the contribution to the cost of printing.

21. — In addition, for every mark filed, an examination shall be made for identicalness or similarity to a mark filed earlier, and still in force, for the same or similar goods or services (Section 14). Where such marks are discovered, the applicant shall be notified accordingly and shall

be informed that the mark filed will be registered if registration is admissible (Section 20(2)) unless he withdraws his application within the period laid down by the Patent Office.

22. — After registration of the mark, the registered owners of identical or similar marks referred to in Section 21 shall be notified. Such notification shall be without prejudice to any decision which the Nullity Section of the Patent Office may take. Moreover, failure to make such notification shall in no way affect that decision.

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

(2) The applicant's exclusive right to the use of the mark shall date from the day that the mark is accepted for registration (Section 20(2)).

24. — (1) The right of priority granted in Article 4 of the Paris Convention for the Protection of Industrial Property must be expressly claimed. For that purpose, the date and country of the application for which priority is claimed shall be indicated (declaration of priority), as well as the serial number of the application.

(2) The declaration of priority shall be submitted to the Patent Office within two months of the arrival of the application at the Patent Office. Within that period, an amendment to the declaration of priority may be requested. For such request, a fee amounting to half the fees charged on filing the mark shall be payable.

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

(4) If the declaration of priority is not made in time, if evidence of priority is not submitted in time, or if the serial number of the application for which priority is claimed is not notified on official demand within the periods laid down (subsections (1) to (3)), priority shall be determined in accordance with the time of filing in Austria.

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

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

26. — (1) Protection shall be accorded only if the Federal Minister of Commerce, Trade and Industry has granted the exhibition the privilege of priority for marks used to distinguish goods displayed.

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

(3) The authorities shall have a discretion to grant or refuse the application, unless an international obligation to grant protection exists.

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

27. — (1) The priority of a mark arising from such protection shall date from the day that the goods marked were brought to the exhibition premises, provided the mark is filed in accordance with the applicable regulations within three months from the day on which the exhibition closed.

The application for registration may only comprise the goods on which the mark was used during the exhibition.

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

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

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

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

2. *Transfer*

28. — (1) In order to have the transfer of the right to a mark recorded in accordance with Section 11, the applicant shall submit evidence that he has acquired the enterprise concerned.

(2) A fee shall be payable for the transfer, equal to the application fee (Section 18(1)), as well as a contribution to the cost of printing for publication, the amount of which shall be determined by order (Section 70(1)). The transfer shall be entered both in the certificate issued to the party concerned and in the Trademark Register (Section 17) and shall be published.

3. *Cancellation*

29. — (1) A mark shall be cancelled:

- (a) at the request of the owner of the mark;
- (b) where registration has not been renewed in time in accordance with Section 19;
- (c) where the right to a mark has lapsed for reasons other than those referred to under (a) and (b);
- (d) (*repealed*);
- (e) under a decision made by the Patent Office pursuant to Section 37 concerning an application for cancellation of a mark (Sections 30 to 33).

(2) Cancellation shall be entered in the Trademark Register (Section 17) and shall be published.

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

(2) Anyone having acquired rights to a mark abroad, by registration or use, may apply for the cancellation of an identical or similar mark filed later for identical or similar goods or services if the owner of such mark is or was under a duty to protect the business interests of the applicant and had had the mark registered without the latter's consent and without proper justification.

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

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

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

33. — Anyone may apply for the cancellation of a mark on any of the grounds for cancellation *ex officio*.

34. — In the cases referred to in Sections 30 to 32, the decision as to cancellation shall have retroactive effect to the date of registration of the mark concerned. This shall apply also in the case of Section 33 if the mark is cancelled on the ground that it ought not to have been registered.

4. *Authorities and Proceedings*

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

(2) Sections 58, 59, 60(1), (2), (4) and (5) and 61(2) to (4), (6) and (7) of the Patent Law, 1970¹, shall apply *mutatis mutandis*.

(3) By order of the President of the Office, employees who are not members of the Patent Office may be empowered to deal with matters — whose nature shall be clearly defined — in the legal Application Section, other than the rendering of decisions, in so far as this is expedient in view of the simplicity of the matters in question and to the extent that the employees are qualified to deal with such matters. The employees so empowered shall comply with the instructions of the member of the legal Application Section responsible in accordance with the allocation of business. Such member may at any time reserve or take over matters for his own decision.

36. — The decisions of the Application Section shall be subject to appeal. There shall be no ordinary legal remedy against the decisions of the Appeal Section.

37. — Applications for the cancellation of a registered mark (Section 29(1)(e)) and for declarations (Section 58) shall be dealt with by the Nullity Section.

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

(2) Preliminary decisions by the rapporteur shall not be subject to appeal, but an application for their review may be made to the section concerned. Nor shall interim decisions be subject to

¹ Published in *Industrial Property*, June 1971, p. 146.

appeal, except interim decisions of the Application Section finding registration admissible subject to the provisions of Section 1(2) or 4(2).

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

(2) The Supreme Patent and Trademark Chamber shall deliberate and take decisions under the chairmanship of its president or — if he is unable to attend — of the vice-president in boards consisting of five members: the chairman, three legally qualified members (Section 74(3) of the Patent Law, 1970) and a technically qualified member (Section 74(4) of the Patent Law, 1970). 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 so joint rapporteurs.

(3) Section 75(2) of the Patent Law, 1970, shall apply.

40. — (1) For appeals against the decisions of the Application Section, a fee of 300 schillings shall be payable in respect of every filed or registered mark to which the appeal relates. For applications to the Nullity Section (Section 37), a fee of 1,000 schillings shall be payable and for appeals under Section 39, a fee of 1,500 schillings for every mark to which the appeal relates.

(2) The fee for an appeal (subsection (1), first sentence) shall be refunded if it is essentially successful and if the proceedings have been conducted without an adverse party. Half the fee for applications to the Nullity Section or for the corresponding appeal shall be refunded if the application or the appeal is dismissed before the hearing takes place.

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

(2) Members of the Patent Office may not take part in the work of the Appeal Section where they have taken part in the decision as to registration of the mark concerned (Section 20) or in the examination for similarity relating to the mark (Section 21) within the Application Section.

(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:

- (i) in the case of proceedings for the cancellation of a mark under Section 30, if they have taken part in the examination for similarity (Section 21) in the Application Section;
- (ii) in the case of proceedings for the cancellation of a mark under Section 33, if they have taken part in the decision as to registration in the Application Section or the Appeal Section;
- (iii) in the case of proceedings for a declaration, where the sign concerned has been filed or registered as a mark, if they have taken part in the examination for similarity of that mark (Section 21).

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

42. — (1) In all other cases and unless otherwise provided hereunder, Sections 52 to 56, 64, 66 to 73, 79, 82 to 86, 112 to 128, 137 to 145 and 169 of the Patent Law, 1970, shall apply *mutatis mutandis* to the proceedings.

(2) Payment of the fees due to the Patent Office, with the exception of the fee under Section 19(2), shall be proved by the submission of the original receipt for payment or remittance of a copy thereof. Where such proof is not produced within the period prescribed, the application shall be rejected.

(3) Publication as provided for in Sections 17(4), 28(2), 29(2) and 47(3) shall be made in the *Österreichischer Markenzeiger* (Trademark Bulletin).

(4) If the registered owner of the mark for which cancellation is sought does not contest the application in writing within the period prescribed, the Nullity Section shall, without more, order cancellation of the mark or restriction of the goods or services.

43. — (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 marks, may apply for restoration of rights.

(2) Restoration shall not be granted:

- (i) where the time limit for the application for restoration (Section 45(1)) and the time limit for appeal in relation to such application have not been observed;
- (ii) where the time limit for lodging a claim in the ordinary courts has not been observed.

44. — (1) The application shall be heard by the authority before which the action omitted should have taken place.

(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.

45. — (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 twelve 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.

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

- (a) where payment of a fee or any other 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 45(2), second sentence) shall be paid at the rate applicable at the time the application for restoration is made.

47. — (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 the Trademark Register, the application and the manner in which it has been dealt with shall be entered in the Register.

(3) Any acceptance of restoration shall be published in the *Österreichischer Markenanzeiger* (Trademark Bulletin), to the extent that the right to the mark is thereby restored.

48. — (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 45(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.

49. — 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.

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

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

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

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

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

III. Infringements of the Right to a Mark

51. — Anyone who intentionally and in a manner likely to give rise to confusion in trade:

- (i) uses without authorization a registered mark or a sign similar (Section 14) to such mark to distinguish goods or services for which the mark has been registered or similar goods or services, or
- (ii) offers for sale or puts on the market goods thus marked shall be guilty of an offense and liable to detention for a term not exceeding one year or to a fine not exceeding 250,000 schillings, or to both.

52. — The same penalties shall be applicable to anyone who intentionally and in a manner likely to give rise to confusion in trade:

- (i) uses, without authorization, the name, trade name or special designation of an enterprise or a sign similar (Section 14) to such designation to distinguish goods or services, or

- (ii) offers for sale or puts on the market goods so marked

53. — (1) The imposition of penalties under Section 51 or 52 shall not preclude the imposition at the same time of penalties under other penal provisions, particularly those relating to fraud.

(2) The proceedings referred to in Sections 51 and 52. shall be instituted only upon formal complaint of the injured person.

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

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

(3) Instead of damages under the civil law, a fine payable to the injured party, the amount to be determined at the discretion of the court in the light of all relevant circumstances and not exceeding 120,000 schillings, may be imposed in addition to the penalty at the request of the injured party. Persons sentenced to such a fine shall be jointly and severally liable. This subsection shall apply even where punishment under a more serious provision of the Criminal Code is imposed.

55. — (1) The injured party may, even before judgment is passed, request seizure or other safekeeping of the articles referred to in Section 54 (1) and also any other measures necessary to prevent a repetition of the offense.

(2) The criminal court shall immediately take a decision on such request. The court may also, if it sees fit, authorize the seizure or safekeeping or any other measures requested on the condition that the injured party furnishes security.

56. — In an action for damages, in respect of one of the offenses referred to in Sections 51 and 52, the civil court shall decide on both the existence and the extent of the damage, having regard to all relevant circumstances.

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

58. — (1) Anyone entitled to acquire the right to a mark may apply to the Patent Office for a declaration certifying that a sign intended for distinguishing goods or services does not conflict with the rights arising from a particular registered mark under this Law (application for a declaration).

(2) The application shall state the goods or services (subsection (1)). If the subject of the declaration is a figurative mark, the application shall also include a drawing of the sign in four copies. One such copy shall be attached to each of the copies of the decision on the application for a declaration.

(3) The proceedings may not be continued if the defendant proves that an action for infringement of the same mark brought by him against the applicant before the application for a declaration was made is still pending before the courts.

(4) The proceedings shall be governed by the rules of procedure relating to the Nullity Section. The costs of the proceedings and of legal representation shall always be borne by the applicant, if the registered owner of the mark has not provoked the application by his conduct and has recognized the validity of the claim within the period set for his reply.

(5) A final declaration that the sign concerned does not conflict with the rights arising from the defendant's mark under this Law shall be binding on the courts.

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

IV. Marks and Other Distinctive Signs of Foreign Enterprises

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

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

V. Representatives

61. — (1) Anyone acting as a representative before the Patent Office or before the Supreme Patent and Trademark Chamber shall be resident in Austria. 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 not resident in Austria may claim rights under this Law before the legal Application Section only if they are represented by an agent resident in Austria. Before the Appeal Section, the Nullity Section and the Supreme Patent and Trademark Chamber, they may claim such rights only if they are represented by an attorney-at-law, a patent attorney or a notary resident in Austria.

(4) Where an attorney-at-law, patent attorney or notary has been authorized to act as a representative before the Patent Office, his power of attorney shall entitle him to claim all rights under this Law before the Patent Office and the Supreme Patent and Trademark Chamber. In particular, he may file a mark, restrict or withdraw applications, renounce rights to a mark, lodge and withdraw applications and 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.

(5) The power of attorney under subsection (4) 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.

(6) If a representative other than an attorney-at-law, patent attorney or notary resident in Austria is to be empowered to request cancellation of registered marks in accordance with Section 29(1)(a), he must be expressly authorized for that purpose.

VI. Collective Marks

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

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

(3) The provisions of this Law shall apply *mutatis mutandis* to collective marks unless otherwise provided in Sections 63 to 68. In particular, the legal effects provided for in Sections 4(2) and 31 of this Law and in **Section 9(3)** of the Federal Law of September 26, 1923, against Unfair Competition² shall be applicable, in favor of unregistered marks, where the mark is recognized in the trade concerned as distinctive of the goods or services of the members of an association.

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

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

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

- (i) addition of the words “collective mark” under the registration number;
- (ii) replacement of the objects of the enterprise by the statutes and their date.

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

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

- (i) where the association for which the mark has been registered no longer exists;

² See *La Propriété industrielle* 1924, pp. 3 and 17.

- (ii) where the association permits or tolerates the use of its mark in a manner contrary to the objects of the association or to its statutes. In particular, use of the mark in a manner likely to mislead trade circles or toleration of the use of the mark by persons who are not members of the association shall be regarded as such misuse.

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

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

VII. Prohibition of Unauthorized Legal Representation or Opinions (Winkelschreiberei)

69. — (1) Anyone who, in matters relating to the protection of marks, professionally prepares written submissions or documents for proceedings before Austrian or foreign authorities, provides opinions in the field concerned, represents parties before Austrian authorities or offers, in word or writing, to perform such services, having no authorization to represent parties professionally in such matters, shall be guilty of an administrative offense and liable to a fine not exceeding 1,000 schillings or to detention for a term not exceeding two weeks. Punishment shall be imposed by the district administrative authority, or by the Federal Police authority — in places where such authority exists.

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

VIII. Special Fees

70. — (1) Special fees may be provided for by order, concerning the issue of official documents and the contribution to the cost of printing, official publication and attestations and official certificates and extracts from official registers. In the determination of any fee, which shall not exceed 800 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, Section 166(10) of the Patent Law, 1970, shall apply *mutatis mutandis* to the assessment.

(2) Where fees are laid down by an order issued under subsection (1), official documents may be prepared and issued only after payment of the relevant fee. Applications for official publication and applications which may be accepted only after publication under a provision governing the right to a mark shall be refused if the relevant fee or contribution to the cost of printing has not been paid.

IX. Implementation

71. — The following shall be responsible for the implementation of this Law:

- (i) in the case of Sections 8, 10, 12 to 14, 23 and 57, the Federal Minister of Commerce, Trade and Industry and the Federal Minister of Justice;
- (ii) in the case of Section 6(2), the Federal Minister of Commerce, Trade and Industry in agreement with the Federal Minister of Foreign Affairs;
- (iii) in the case of Sections 51 to 56, 58(5) and 67, the Federal Minister of Justice;

- (iv) in the case of Section 70(1), the Federal Minister of Commerce, Trade and Industry in agreement with the Federal Minister of Finance;
 - (v) in the case of all other provisions of this Law, the Federal Minister of Commerce, Trade and Industry.
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