

## **Bundesgesetz vom 7. Juni 1990 über den Schutz von Mustern (Musterschutzgesetz 1990 – MuSchG), zuletzt geändert BGBl. I Nr. 37/2018**

### **Long title**

Federal Act of 7 June 1990 on the Protection of Designs (Design Protection Act 1990 MuSchG) StF: Federal Law Gazette No. 497/1990 (NR: GP XVII RV 1141 AB 1342 p. 146. BR: AB 3910 p. 531.)

### **Modifications**

BGBl. No. 772/1992 (NR: GP XVIII RV 665 AB 784 P. 88. BR: AB 4366 P. 561.) BGBl. I No. 143/2001 (NR: GP XXI RV 800 AB 845 P. 83. BR: AB 6521 S. 682.) BGBl. I No. 81/2003 (NR: GP XXII RV 65 AB 169 S. 27. BR: AB 6839 S. 700.) [CELEXNr.: 31998L0071] BGBl. I No. 149/2004 (NR: GP XXII RV 621 AB 770 p. 90. BR: AB 7197 p. 717.) Federal Law Gazette I No. 131/2005 (NR: GP XXII AB 1141 p. 125. BR: AB 7410 p. 727.) Federal Law Gazette I No. 151/2005 (NR: GP XXII RV 994 AB 1077 P. 122. BR: AB 7387 P. 725.) [CELEXNr. 32003L0006] BGBl. I No. 126/2013 (NR: GP XXIV RV 2358 and zu 2358 AB 2413 S. 206. BG: AB 9018 S. 822.) BGBl. I No. 71/2016 (NR: GP XXV RV 1144 AB 1204 p. 138. BR: AB 9633 p. 856.) Federal Law Gazette I No. 124/2017 (NR: GP XXV RV 1656 AB 1678 p. 190. BR: AB 9851 p. 870.) [CELEXNr.: 32015L2436] BGBl. I No. 37/2018 (NR: GP XXVI RV 108 AB 139 S. 23. BR: 9967 AB 9970 S. 880.) [CELEXNr.: 32017L2399, 32017L1572]

### **Text**

## **I. GENERAL PROVISIONS**

### **Subject matter of design protection**

**§ 1.** (1) For designs that are new and have individual character (§§ 2, 2a) and which do not violate § 2b, public order or morality, design protection can be acquired under this Federal Law. Designs falling under the prohibition of double protection (§ 3) are not protected.

(2) A design within the meaning of this Federal Act is the appearance of an entire product or a part thereof, which results in particular from the features of the lines, contours, colors, the shape, surface structure and/or the materials of the product itself and/or its decoration.

(3) A product within the meaning of (2) is any industrial or craft item, including - among other things - individual parts that are to be assembled into a complex product, packaging, equipment, graphic symbols and typographical typefaces; however, a computer program is not considered a product.

(4) A complex product within the meaning of (3) is a product made up of several components that can be replaced so that the product can be disassembled and reassembled.

(5) Design rights that are acquired on the basis of Regulation (EC) No. 6/2002 on Community Designs, OJ No. L 3 of January 5, 2002, S 1, are to be maintained in the same way as design rights acquired on the basis of this Federal Act, provided that nothing to the contrary emerges from Community law provisions relating to design. Otherwise, the provisions of Section VII apply.

### **Novelty and individuality**

**§ 2.** (1) A design is considered new if no identical design has been made available to the public before the day of filing the design for registration or, if priority is claimed, before the priority date. Designs are considered identical if their features differ only in insignificant details.

(2) A design has individual character if the overall impression it creates on the informed user differs from the overall impression that another design creates on this user, which was made available to the public before the day of application for registration or, if a priority is claimed, has been made available before the priority date.

(3) When assessing the individual character, the degree of creative freedom of the designer/creator in developing the design is taken into consideration.

(4) The design that is used in a product, that is a component of a complex product, or that is inserted into this product, is only considered new and has individuality only if the component, that is inserted into the complex product, remains visible during intended use of the latter and insofar as these visible features of the component themselves meet the requirements of novelty and individuality.

(5) Intended use within the meaning of (4) means use by the end user, with the exception of maintenance, servicing or repair measures.

**§ 2a.** (1) Within the meaning of § 2, a design is deemed to have been made available to the public if, after registration or in any other way, it was made known, exhibited, used in trade or disclosed for other reasons, except where this could not reasonably have become known in the normal course of business to specialized circles in the sector concerned operating in the European Economic Area, before the day of filing the application for registration or, if a priority is claimed, before the priority date. However, a design is not deemed to have been made available to the public if it has only been disclosed to a third party under the explicit or tacit condition of confidentiality.

(2) A disclosure is not taken into consideration when applying § 2 if the design is made available to the public not earlier than twelve months before the date of filing or, if priority is claimed, before the priority date, namely:

1. by the designer/creator or his legal successor or by a third party as a result of information or actions of the designer/creator or his legal successor or
2. as a result of an abusive act against the designer/creator or his legal successor.

### **Designs determined by technical function and designs of interconnections**

**§ 2 b.** (1) A right to a design does not exist in terms of appearance features of a product that are exclusively determined by its technical function.

(2) A right to a design does not exist in the appearance features of a product which inevitably have to be reproduced in their exact form and their exact dimensions so that the product, in which the design is incorporated or in which it is used, can be mechanically assembled with or connected to or attached to, on or around another product, so that both products fulfill their function.

(3) Regardless of (2), there is a right to a design under the conditions set out in § 2, which serves the purpose of enabling the assembly or connection of a large number of interchangeable parts within a modular system.

### **Prohibition of double protection**

**§ 3.** A design is excluded from design protection if it collides with an earlier design that was made available to the public after the date of filing or, if a priority is claimed, after the priority date and which is protected from a date prior to that date by a registered Community design or a or an application for a Community design or a design registered or applied for registration under this Federal law.

### **Effect of design protection**

**§ 4.** (1) The registration of a design confers its owner the exclusive right to use it and to prohibit third parties from using it without his or her consent. The use mentioned includes in particular the production, offering, placing on the market, importing, exporting or using a product in which the sample is incorporated or in which it is used, or the possession of the product for the stated purposes.

(2) The scope of protection from a right to a design extends to any design that does not create a different overall impression on the informed user.

(3) When assessing the scope of protection, the degree of creative freedom of the designer/creator in developing his or her design is taken into consideration.

(4) A registered design does not dispense the user from compliance with legal provisions.

### **Limitation of the rights conferred by a design right**

**§ 4a.** (1) The rights conferred by a registered design cannot be asserted for:

1. acts that are carried out in the private sphere for non-commercial purposes;
2. acts for experimental purposes;
3. reproduction for the purpose of quotation or for teaching purposes, provided that such actions are compatible with the practice of fair business dealings, do not unduly impair the normal exploitation of the design and the source is cited.

(2) The rights from a registered design can also not be asserted for:

1. equipment in ships and aircraft that are registered in another country and enter Austria temporarily;
2. the importation of spare parts and accessories for the repair of such vehicles domestically;
3. carrying out repairs on such vehicles.

### **Prior user right**

**§ 5.** (1) The effect of the design protection does not apply to anyone who in good faith has already used a design falling under the scope of protection of a registered design before the priority date in Austria or has taken the necessary events for this (prior user).

(2) The prior user may continue to use the design for the products covered by use for the needs of his own company in his own or third-party business premises.

(3) This authorization can only be inherited or sold together with the company.

(4) The prior user may demand that his authorization is recognized in writing by the owner of the design. The recognized authorization is to be entered into the Design register at the request of the prior user.

(5) If recognition is refused, the Patent Office shall decide upon request and, if applicable, order the authorization to be entered into the Design register.

## **Exhaustion of rights**

**§ 5a.** The rights arising from a registered design do not extend to actions relating to a product into which a design, falling under the scope of protection of the right to a design, is inserted or in which it is used, when the product has been placed on the market in the European Economic Area by the right holder or with his consent.

## **Term of protection**

**§ 6.** Design protection starts with the day the design is registered. The term of protection is five years starting on the day of filing of the application. The right holder may have the protection period extended four times by five years each up to a total of 25 years from the date of filing of the application by paying a renewal fee in time. For the payment of the renewal fee, the end of the term of protection is the last day of the month, which by its name corresponds to the month of the filing date.

## **Entitlement to design protection**

**§ 7. (1)** In principle, the designer/creator of the design or his/her legal successor has a right to design protection.

(2) If, however, the design created by an employee falls within the field of work of the company in which he is active, and if the activity that led to the design creation was part of the employee's official duties or if the design was created outside of an employment relationship by order and if nothing else has been agreed upon, the employer or the client or his legal successor shall be entitled to design protection.

## **Citation as designer/creator of the design**

**§ 8. (1)** The designer/creator of a design has the right to be cited as designer/creator in the Design register upon publication in accordance with § 17 and in the priority documents to be issued by the Patent Office.

(2) The entitlement can neither be transferred nor inherited. A waiver of the claim has no legal effect.

(3) The request for citation can be made by the designer/creator of the design, the applicant or the owner of the design. If more than one person is authorized to do this, proof of the consent of the other authorized persons must be provided if the request is not made jointly by all authorized persons. If someone else is to be named in addition to or to replace the already cited designer/creator, the consent of the previously cited designer/creator must also be proven.

(4) If the applicant, the design owner or the person already cited as the designer/creator refuse to give their consent, the Patent Office shall, upon request, decide on the right to be cited as designer/creator. On the basis of the final decision in favor of the request, the designer/creator is to be cited in accordance with (1).

### **Relationship between several design owners**

**§ 9.** The legal relationship of several design owners to one another is determined according to civil law. In case of doubt, the right to allow third parties to use a protected design is only available to the entire ownership; however, each individual owner is authorized to take action against violators of the design right.

### **Transmission**

**§ 10.** (1) The right stemming from the application of a design and the design right can be transferred for all or individual products of the list of goods in their entirety or in notional shares.

(2) There is no right of reversion (§ 760 ABGB).

## **II. REGISTRATION PROCEDURE AND DESIGN REGISTER**

### **Registration**

**§ 11.** An application for design protection shall be filed in writing with the Patent Office. The filing date is the day the application is received by the Patent Office.

**§ 12.** (1) The design must be disclosed upon application by submitting a design representation or a specimen of the design. If a design specimen is submitted, a representation of the design must always be submitted for publication (§ 17) and registration (§ 18 (1) no. 4), which reproduces the design specimen as clearly as possible but is not taken into account for disclosure.

(2) A description can be given to explain the design.

(3) The products for which the design is intended are to be listed according to the classification of the classes and sub-classes of the Locarno Agreement for the Establishment of an International Classification for Industrial Designs, Federal Law Gazette No. 496/1990 (list of goods).

**§ 13.** Designs belonging to the same class can be combined in a multiple application. The multiple application may not contain more than fifty designs. However, the option of § 14 can only be used jointly for all designs combined in a multiple application.

**§ 14.** The copy and the illustration of the design as well as the description can be presented openly or in a sealed envelope (secret design). The envelope must be opened:

1. at the request of the applicant;
2. at the request of a third party, provided that the latter can prove that the design applicant has invoked the design against him;
3. ex officio eighteen months after the priority date of the design.

**§ 15.** More detailed requirements of the description and the list of goods, the number of items to be submitted as well as the number, quality and dimensions of the images and copies of the design to be submitted are to be determined by the President of the Patent Office by ordinance, taking into account the requirements of the registration process, printing and publication of the design.

### **Legality examination**

**§ 16.** (1) The Patent Office shall examine every design application for legality, in the case of openly submitted designs after they have been received, in the case of design applications sealed, if this is not possible after they have been received, after opening the envelope (§ 14). However, an examination of the existence of the requirements of §§ 2 to 3 as well as whether the applicant is entitled to design protection (§ 7) does not take place in the registration process.

(2) If the examination reveals that there are concerns about the registration of the design, the applicant shall be requested to express his opinion within a reasonable period of time. If the inadmissibility of the registration is determined after a timely statement or after the deadline has expired, the design application shall be rejected.

(3) If there are no concerns about the registration of the design, its publication (§ 17) and registration (§ 18) have to be ordered.

### **Publication of the Design**

**§ 17.** The design is to be published on the day of its registration in the Austrian Design Gazette (§ 33). The content and scope of the publication of the sample are to be determined by ordinance of the President of the Patent Office, taking into account the public's need for information.

## Registration

**§ 18.** (1) When registering, the following are to be included in the Design register kept by the Patent Office:

1. the register number;
2. the date of filing and, if applicable, the priority claimed;
3. the beginning of the term of protection (§ 6);
4. the representation of the design;
5. if applicable, an indication that a copy of the design or a description has also been submitted;
6. the products for which the design is intended (list of products);
7. the name and place of residence (seat) of the owner of the design and, if applicable, of his representative;
8. if applicable, the named designer/creator (§ 8).

(2) The owner of the design receives an official confirmation (Design certificate) of the entries in the register according to (1).

(3) The Design register is open to everyone for inspection. A certified extract from the register shall be issued upon request.

## Priority

**§ 19.** On the day of the proper application of a design, the applicant acquires the right of priority.

**§ 20.** (1) The priority rights granted on the basis of intergovernmental agreements or § 20a must be expressly claimed. The date of the application, the priority of which is claimed, and the country in which this application was made must be specified (declaration of priority). The file number of the application must also be given.

(2) The declaration of priority must be submitted within two months of the receipt of the application at the Patent Office. The claimed priority may be corrected within this period.

(3) If the maintenance of the design right depends on whether the priority was rightly claimed, the priority right must be proven. By ordinance of the President of the Patent Office it is to be determined which documents are required in the proceedings before

the Patent Office and in appeal proceedings for this proof (priority documents) and when these documents are to be presented.

(4) If the declaration of priority is not submitted in time, the priority documents are not submitted in time or if the file number of the application, whose priority is claimed, is not disclosed in due time upon official request, the priority is determined by the day of the application in Austria.

**§ 20a.** Within a period of six months after the filing date of an earlier design application that was filed with a registration office that is not covered by the scope of an intergovernmental agreement on the recognition of priority, the applicant has the right to claim for a later design application in Austria relating to the same design the priority of the earlier design application if a corresponding reciprocity with this registration office has been established by an announcement to be published in the Federal Law Gazette by the Federal Minister for Transport, Innovation and Technology. The requirements and the effects of this priority right correspond to those of Article 4 of the Paris Convention for the Protection of Industrial Property, Federal Law Gazette No. 399/1973.

### **Entries in the Design register**

**§ 21.** In addition to the information mentioned in § 18 (1), data in regard to the end of design protection, the declaration of nullity, the transfer of design rights, liens and other rights in rem to design rights, license rights, prior user rights, restitution to the previous status, declaratory decisions and legal disputes as well as references to judgments communicated in accordance with § 36 shall be entered into the Design register.

**§ 22.** (1) Rights in rem to design rights as well as the design right itself in the event of its transfer (§ 10) are acquired with the entry in the design register.

(2) With the application for entry, the document the entry to be made is based on shall be submitted in the original or as a duly certified copy. If the document is not a public one, it shall be signed with the duly certified signature of the person disposing of his rights. In case of transfer of the design a corresponding declaration of the parties or their representatives may be submitted instead of a document.

(3) Form and content of the request, the document and the declaration are subject to examination by the Patent Office. In case of justified doubt the Patent Office may request originals or duly certified copies or other documents to be presented.

(4) Legal disputes relating to design rights shall be entered in the design register upon request (dispute note).

(5) Furthermore § 43 (2, 3, 4, 5 and 7) (entry in the Patent register), § 44 (encumbrances) and § 45 (2) (disputes) of the Patent Act 1970, Federal Law Gazette No. 259, shall apply accordingly.

(6) (2) and § 43 (5) and (7) of the Patent Act 1970 shall apply mutatis mutandis to the transfer of the right arising from the application for a design.

### **III. DECLARATION OF INVALIDITY AND DEPRIVATION**

#### **Invalidity of designs**

**§ 23.** (1) The design right is declared null and void upon request if

1. the design is not a design within the meaning of § 1 (2), or
2. the design does not meet the protection requirements of § 1 (1), first sentence, or
3. the design falls under the prohibition of double protection (§ 3), or
4. the holder of the design right is not entitled to design protection (§ 7).

(2) The reason for invalidity according to (1) No. 3 can only be asserted by the owner of the conflicting right.

(3) The reason for invalidity according to (1) No. 4 can only be asserted by the person who is entitled to the right to the design.

(4) If one of the grounds for invalidity of (1) only applies to part of the list of goods, the list shall be restricted accordingly.

(5) If one of the grounds for invalidity of (1) No. 2 applies only partially, the design may be partially declared invalid, provided it retains its identity. The partial annulment and retention of the design right can be made dependent on the submission of changed documents by the design owner, which can also include a voluntary restriction (disclaimer).

(6) The legally binding declaration of invalidity takes retroactive effect to the day on which the design has been registered. If the design right is declared null and void in accordance with (1) No. 3, the second sentence of § 48 (3) of the Patent Act 1970 shall apply mutatis mutandis.

(7) A right to a design can be declared null and void even after it has expired or has been waived.

## **§ 24. [Repealed]**

### **Deprivation and transfer of designs**

**§ 25.** (1) Anyone who claims to be entitled to the right to the design may, instead of a declaration of invalidity pursuant to § 23, (1) No. 4, request that the owner of the design will be deprived of the design right and the design right transferred to the applicant of the request. Until the decision becomes final, the owner of the design can only waive the design with the consent of the applicant.

(2) If the reason for deprivation (1) only applies to part of the list of goods, the design right is only partially revoked or transferred.

(3) Claims against the design owner in good faith shall expire within three years from the date of entry in the Design register. § 49 (4), (6) and (7) of the 1970 Patent Act shall apply mutatis mutandis.

## **IV. JURISDICTION AND PROCEDURE**

### **General**

**§ 26.** (1) Unless otherwise specified in this Federal Act, the Patent Office is competent for taking decisions and for other matters relating to design protection. In the Patent Office, the member of the legal department entrusted with these matters, is appointed to this end based on the plan for allocation of duties, unless matters are reserved for the President or the Cancellation Department.

(2) §§ 52 to 56, 57 (2), §§ 57b, 58, 60, 61, 64, 66 to 69, 76, 79, 82 to 86 and 126 to 137 of the Patent Act 1970 apply mutatis mutandis.

### **Authorized Employees**

**§ 27.** (1) By decree of the President, employees, who are not members of the Patent Office, may be authorized to deal with matters of the Legal Department which are to be designated according to the nature of the matter, provided this is expedient due to the simplicity of the execution and the training of the authorized employees provides a guarantee for proper execution. They are bound by the instructions of the responsible member of the Legal Department. The latter may reserve the right to carry out tasks at any time or draw them to itself.

(2) § 76 of the 1970 Patent Act shall apply mutatis mutandis to authorized employees.

(3) The decisions of the employees authorized according to (1) can be challenged like those of the responsible member.

## **§ 28. [Repealed]**

### **Proceedings before the Cancellation Department**

**§ 29.** (1) On requests for recognition of a previous user right (§ 5 (5)), naming as designer/creator (§ 8 (4)), annulment (§ 23), deprivation and transfer (§ 25) and determination (§ 39) the Cancellation Department decides through a legally qualified member.

(2) The Cancellation Department holds hearings in regard to the requests and claims mentioned in (1) in analogous application of §§ 112 (2) to 114a, § 115 (2) to (4), § 116 (2) to (5), §§ 117 to 120 and §§ 122 to 125 of the Patent Act 1970. Oral proceedings, however, are only to be scheduled, if they are deemed necessary by the responsible member or if requested by one of the parties.

(3) If the owner of the design does not submit a reply to a request for a complete declaration of nullity of the design (§ 23) within the period granted to him in accordance with (2) in conjunction with § 115 (2) of the Patent Act 1970, the Cancellation Department shall declare the design null and void.

## **§ 30. [Repealed]**

### **Inspection of files and data protection**

**§ 31.** (1) Those involved in a procedure are entitled to inspect the files relating to the procedure.

(2) Anyone may inspect files relating to registered designs.

(3) Third parties are only permitted to inspect files relating to non-registered designs with the consent of the applicant. Consent is not required for those against whom the applicant has referred to his design application.

(4) The right to inspect files also includes the right to make copies. These are to be certified by the Patent Office upon request.

(5) Information and official confirmations about when, by whom and, if applicable, by which representative a design was registered, whether it is a registration of a secret design, which file number the application carries, which priority is claimed, which file number the priority application carries, for which products the design is intended (list of goods), if applicable who is named as the creator, whether the application is still being processed, and whether and to whom the rights arising from it have been transferred, are to be given to everyone.

(6) Consultation minutes and parts of the files only relating to the internal course of business are excluded from inspection.

(7) Insofar as personal data is processed in the Design register or in electronic information services of the Patent Office accessible by the public there is no

1. right to information in accordance with Article 15(1)(c) of Regulation (EU) 2016/679 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing of Directive 95/46/EC (General Data Protection Regulation), OJ No. L 119 of 04.05.2016 p. 1 in the version of correction OJ No. L 314 of 22.11.2016 p. 72, (hereinafter: GDPR),
2. notification obligation according to Art 19 second sentence GDPR,
3. right to restriction of processing according to Art. 18 and no right to object in accordance with Art. 21 GDPR, whereby the persons concerned have to be informed about this in a suitable manner.

The right to receive a copy of this data according to Art. 15 (3) GDPR is fulfilled by the fact that the person concerned may inspect the Design Register or consult the publicly accessible electronic information services of the Patent Office.

## **Representatives**

**§ 32.** (1) Anyone who intervenes as a representative in matters of design protection before the Patent Office shall be domiciled in Austria; however, the professional regulations apply to lawyers, patent attorneys and notaries. The representative shall demonstrate his authorization by means of a written power of attorney, which has to be submitted in original or in a duly certified copy. If several persons are authorized, each individual is authorized to represent alone.

(2) If a lawyer, patent attorney or notary intervenes, the appeal to the authorization granted to him replaces its documentary evidence.

(3) If a representative intervenes without a power of attorney or, in the case of (2), without invoking the authorization granted to him, the procedural act performed by him is only effective on the condition that he submits a proper power of attorney or invokes the authorization granted to him.

(4) Anyone who has neither domicile nor branch office in Austria may only assert rights under this Federal Law before the Patent Office if he has a representative who meets the requirements of (1). He can only assert these rights before the Cancellation Department of the Patent Office if he is represented by a lawyer, patent attorney or notary. If the place of residence or branch is in the European Economic Area (EEA) the appointment of an authorized recipient resident in Austria is sufficient to assert rights

under this Federal Law. The requirement of main residence in Austria does not apply to citizens of EEA contracting states, if service is ensured by international treaties with the contracting state of the residence of the authorized recipient or in another way.

(5) The authorization granted to a lawyer, patent attorney or notary to represent before the Patent Office authorizes him by law to assert all rights under this Federal Law before the Patent Office and – insofar he/she is authorized to do so by law - before the appellate authorities, in particular to file and withdraw applications for designs, waive registered designs, to submit and withdraw requests to be dealt with by the Cancellation Department, as well as to conclude settlements, to accept notifications of all kinds as well as official fees and the procedural and representation costs to be reimbursed by an opponent and to appoint a substitute.

(6) The authorization pursuant to (5) may be limited to a specific property right and to representation in a specific procedure. However, it is not canceled either by the death of the principal or by a change in his or her ability to act.

(7) Should a representative who is not a lawyer, patent attorney or notary also be authorized to waive a registered design in whole or in part, he must be expressly authorized to do so.

### **Austrian Design Gazette**

**§ 33.** The Patent Office shall issue a periodically published official Design Gazette in which, in particular, publications pursuant to § 17, publications on the end of design protection, partial waivers, changes to the company name and the person of the design owner as well as those publications which are to be included in accordance with § 26 (2) in analogous application of §§ 128 and 133 (3) of the Patent Act 1970.

## **V. DESIGN RIGHT INFRINGEMENTS AND REQUESTS FOR DECLARATION**

### **Design Right Infringements**

**§ 34.** Anyone who has been violated in his design right has the right to omission, removal, publication of the judgment, reasonable remuneration, compensation, surrender of the profit, invoicing and the right to information about the origin and the distribution channel. Anyone who has to worry about such a violation has the right to omission. §§ 147 to 154 of the 1970 Patent Act apply mutatis mutandis.

**§ 35.** (1) Anyone who violates a design right is to be punished by the court with a fine of up to 360 daily rates. Anyone who commits the act on a commercial basis is punished with a prison sentence of up to two years.

(2) Likewise, the owner or manager of a company who does not prevent a design violation committed by an employee or agent in the company is to be punished.

(3) If the owner of the company according to (2) is a company, a cooperative, an association or another legal entity not belonging to physical persons, (2) shall apply to the organs if they are guilty of such an omission to have.

(4) (1) does not apply to employees or agents who have carried out the act on behalf of their employer or client, provided that they could not be expected to refuse to carry out these acts due to their economic dependency.

(5) The persecution only takes place at the request of the injured party.

(6) §§ 148, 149 and 160 of the Patent Act 1970 apply mutatis mutandis to criminal proceedings.

**§ 36.** The court of first instance shall send the Patent Office a copy of every judgment in which the validity or effectiveness of a design right has been assessed, with the confirmation of the status “legally binding” for integration in to the design files. Such a judgment must be indicated in the Design register (§ 21).

**§ 37.** Anyone who designates products in a manner that is suitable to create the impression that they enjoy design protection must, on request, provide anyone with information on which design right the designation is based on.

**§ 38.** (1) The Commercial Court of Vienna is exclusively competent for lawsuits and interim injunctions under this Federal Law.

(2) Jurisdiction in criminal matters according to this Federal law is vested in the Regional Court for Criminal Matters Vienna.

### **Requests for declarations**

**§ 39.** (1) Anyone who manufactures, markets, sells or uses a product or intends to take such measures, by opposing the owner of a protected design or the owner of an exclusive license at the Patent Office, may request a declaration that the product does not fall under the design right, neither in whole nor in part.

(2) The holder of a protected design or an exclusive license may apply to the Patent Office for a declaration that the product is wholly or partially covered by the design right

against someone who manufactures, markets, sells or uses a product or who intends to take such measures.

(3) Requests pursuant to (1) and (2) shall be rejected if the respondent proves that infringement proceedings previously pending between the same parties, which concern the same design right and the same product, are still pending or have been concluded legally binding.

(4) The application can only refer to a single design right. A picture of the product in four pieces must be submitted with the application; a copy is to be attached to the final decision.

(5) The costs of the proceedings are to be borne by the applicant if the opponent has not given cause for filing the request by his behavior and has recognized the claim within the deadline set for him to reply.

## **VI. THE HIGHER REGIONAL COURT VIENNA AND THE SUPREME COURT AS APPEAL INSTITUTIONS**

### **A. Appeal (recourse) against decisions of the Legal Department of the Patent Office**

#### **Appeal (recourse)**

**§ 40.** (1) Decisions/resolutions of the Legal Department may be contested by appeal (recourse) to the Higher Regional Court of Vienna.

(2) No legal remedy is admissible against preparatory acts of the competent member in preparation of a decision/resolution of the Legal Department.

#### **Proceedings**

**§ 41.** The provisions of the Ausserstreitgesetz (AussStrG), Federal Law Gazette I No. 111/2003 shall apply to the appeal procedure, with the exception of Sections 44 and 49 AussStrG and the following special features:

1. References in the AussStrG to the court of first instance apply as references to the Legal Department.
2. The appeal period and the period for responding to the appeal are two months; they are not extendable.
3. New facts or evidence may only be presented to support or refute the facts and evidence presented in good time in the first instance.

4. If an appeal submitted in good time shows deficiencies, the competent member must set the appellant a deadline for improvement. Appeals submitted belatedly or appeals that are not corrected within the specified period shall be rejected by the competent member. Appeals against decisions of the authorized employee are to be rejected by the competent member.
5. Resolutions in accordance with § 50 of the AussStrG are to be adopted by the competent member having adopted the contested resolution. If the resolution/decision has been made by the authorized employee, the competent member has to adopt a decision.
6. § 51 (1) AusStrG is to be applied with the proviso that the files relating to the matter are to be submitted with an explanatory report, if necessary.
7. The parties have to bear the costs of the proceedings themselves.
8. Appeal decisions of the appeals court are to be served by the appeals court.

## **Revision appeal**

**§ 42.** (1) A revision appeal is permissible in accordance with § 62 of the AussStrG against a decision of the appeals court issued in the course of the appeal proceedings.

(2) The provisions of the AussStrG apply mutatis mutandis to the revision appeals procedure with the following special features:

1. The revision appeal period and the deadline for responding to a revision appeal are two months; they are not extendable.
2. The revision appeal and, if applicable, the application for admission are to be submitted to the appeals court; the rejection according to § 67 AussStrG takes place by the appeals court. Except in the case of § 68 (4) No. 2 AussStrG, the revision appeal response must also be submitted to the appeals court.
3. The parties have to bear the costs of the proceedings themselves.

## **B. Appeal against resolutions and decisions of the Cancellation Department of the Patent Office**

### **Appeal**

**§ 43.** (1) The final decisions of the Cancellation Department of the Patent Office may be contested by appeal to the Higher Regional Court of Vienna.

(2) The provisions of the Zivilprozessordnung (ZPO) apply mutatis mutandis to the appeal procedure, with the exception of § 461 (2) ZPO and the following special features:

1. References in the ZPO to the court of first instance apply as references to the Cancellation Department.

2. The deadline for appeal and the deadline for responding to the appeal are two months; they are not extendable.
3. If an appeal submitted in good time shows deficiencies, the competent legal member of the Cancellation Department must set the appeal applicant a deadline for improvement. If the deficiencies are corrected within the deadline, the appeal is deemed to have been submitted in good time.
4. Appeal decisions of the court of appeal are to be served by the court of appeal.

## **Recourse**

**§ 43a.** (1) No legal remedy is permitted against preparatory acts of the competent legal member. Subject to (2), there is no separate legal remedy against the resolutions of the Cancellation Department made in the course of the preliminary proceedings or the hearing; they can only be challenged with an appeal, provided that they had an influence on the final decision.

(2) An appeal to the Higher Regional Court of Vienna is admissible against interruption resolutions, resolutions rejecting an appeal, resolutions pursuant to § 130 (2) and resolutions on claims under the Gebührenanspruchsgesetz (Fee Claims Act). Resolutions of the appellate court may be contested by appeal to the Supreme Court in accordance with § 519 ZPO.

(3) The provisions of the ZPO apply mutatis mutandis to the appeal procedure with the following special features:

1. References in the ZPO to the court of first instance apply as references to the Cancellation Department.
2. Appeals in accordance with (2), first sentence, are to be submitted to the Cancellation Department, appeals in accordance with (2), second sentence, are to be submitted to the Court of Appeal.
3. If an appeal submitted in good time according to (2), first sentence, shows deficiencies, the competent legal member of the Cancellation department, must set the appellant a deadline for improvement. If the deficiencies are corrected within the deadline, the appeal is deemed to have been filed on time.
4. Appeal decisions of the appeals court are to be served by the appeals court.

## **Revision and revision appeal**

**§ 43b.** (1) Revision against judgments of the appellate court is permissible in accordance with § 502 ZPO, against resolutions of the revision court revision appeal in accordance with § 528 ZPO.

(2) The provisions of the ZPO apply to the revision procedure with the following special features:

1. The revision deadline and the deadline for the revision response are two months; they are not extendable.
2. The revision is to be submitted to the court of appeal. The references to the trial court of first instance are deemed to be references to the court of appeal, with the exception of those relating to the remittal to the first instance. Except in the case of § 507a, (3), Item 2 of the ZPO, the revision response must also be submitted to the appellate court.
- (3) The provisions of the ZPO apply mutatis mutandis to the revision appeal procedure, with the proviso that the revision appeal must be submitted to the appeals court.

## **C. Common Provisions**

### **Legal aid support**

**§ 43c.** Legal aid support for an appeal procedure according to this main part is to be applied for at the Patent Office. The Cancellation Department has to decide on the application for approval of legal aid support through a resolution by one of the chairpersons. § 7 (2) AussStrG, § 63, 64, 66 to 73 ZPO and § 45 RAO, RGBI. No. 96/1868, are to be applied with the proviso that references to the court count as references to the Cancellation Department. Instead of the appointment of a lawyer, the appointment of a patent attorney for the appeal proceedings before the Higher Regional Court of Vienna can also be granted. Appeals against the decision can be filed within two weeks.

### **Delivery, representation, entry into the proceedings, inspection of files**

**§ 43d.** (1) The delivery of documents by the Patent Office in appeal proceedings under this main part takes place in accordance with §§ 85 and 86 of the Patent Act 1970.

(2) Patent attorneys and notaries are also authorized to represent in proceedings before the Vienna Higher Regional Court. Appeal to the power of attorney replaces its documentary evidence.

(3) In multi-party proceedings, the acquirer of a right in dispute can also enter the proceedings without the consent of the opponent.

(4) § 31 shall apply mutatis mutandis to the inspection of files in appeal proceedings under this main part.

### **Composition of the Senates**

**§ 43e.** § 146 (1) and (4) auf the Patent Act 1970 shall apply mutatis mutandis to the composition of senates at the Higher Regional Court of Vienna.

## VII. COMMUNITY DESIGNS

**§ 44a.** Applications for Community designs can be submitted to the Patent Office in accordance with Article 35 (1) (b) of Regulation (EC) No. 6/2002. The Patent Office notes the date of receipt on the application and forwards the documents unchecked to the *European Union Intellectual Property Office (EUIPO)* in Alicante within the period of two weeks provided for in Art. 35 (2) of this regulation.

**§ 44b.** (1) The Community Design Court of First Instance within the meaning of Article 80 (1) of Regulation (EC) No. 6/2002 is the Vienna Commercial Court. In cases in which the Community Design Court has jurisdiction over actions, it also has exclusive jurisdiction over interim injunctions.

(2) Jurisdiction in criminal matters pertaining to community designs is vested in the Regional Court for Criminal Matters Vienna.

## VIII. TRANSITIONAL AND FINAL PROVISIONS

### Transitional provisions

**§ 44c.** (1) §§ 1, 2, 3, 12 (1), §§ 24, 25, 29 and §§ 1, 2, 3, 12 (1), §§ 24, 25, 29 and 44 (3) in the version applicable before Federal Law Gazette I No. 81/2003 came into force continue to apply to applications for designs and registered designs, having a date of application before the aforementioned Federal Law came into force. §§ 2a and 23 in the version of the aforementioned federal law do not apply to these design applications and registered designs.

(2) For proceedings for the official declaration of cancellation which were initiated before the aforementioned federal law came into force, § 23 in the version applicable before the aforementioned Federal Law came into force shall continue to apply.

(3) If actions could not be prevented prior to the entry into force of the Federal Law, Federal Law Gazette I No. 81/2003 on the basis of §§ 4 and 5 in the version applicable before the entry into force of the aforementioned Federal Law, rights from the design in accordance with the Sections 4 to 5 in the version of the aforementioned federal law are not asserted in order to prevent a continuation of such actions by a person who began these actions before the date on which the aforementioned federal law came into force.

**§ 44d.** (1) § 150 (3) of the 1970 Patent Act in the version that was in effect before Federal Act Gazette I No. 149/2004 came into force shall continue to apply mutatis mutandis to legal actions deposited before the aforementioned Federal Act came into force.

(2) For applications submitted before the Federal Act, Federal Law Gazette I No. 149/2004, came into force, § 40 in the version applicable before the aforementioned Federal Law came into force shall continue to apply.

(3) For applications submitted before the Federal Law Gazette I No. 149/2004 came into force, Section 42 Paragraphs 1, 2 and 3 first sentence in the version applicable before the Federal Law came into force shall continue to apply. For requests for reinstatement submitted before the entry into force of the aforementioned Federal Law, § 132 (1) and (3) of the Patent Act 1970 in the version applicable before the cited federal law came into force shall continue to be applied mutatis mutandis.

(4) For designs whose term of protection ends before the Federal Law Gazette I No. 149/2004 comes into force, § 41 shall continue to apply in the version applicable before the aforementioned Federal Law came into force. This also applies to designs whose term of protection ends after the aforementioned federal law comes into force, but for which the renewal fee is duly paid before the aforementioned federal law comes into force.

(5) § 176b of the Patent Act 1970 and § 4 Verwaltungsgerichtsbarkeits-Übergangsgesetz, Federal Law Gazette I No. 33/2013 apply mutatis mutandis.

## **Final provisions**

**§ 45.** The federal statutory provisions named in this federal act are to be applied in their currently valid version.

**§ 45a.** For all personal designations used in this federal act, the chosen form applies to both genders.

**§ 46.** (1) This Federal Act comes into force on January 1, 1991.

(2) Ordinances on the basis of this federal law in its respective version may already be issued from the day following the publication of the federal law to be implemented; however, they may not come into force before the statutory provisions to be implemented.

(3) With the entry into force of this federal law, the following expire:

1. the Design Protection Act 1970, Federal Law Gazette No. 261,

2. the ordinance of the Federal Ministry for Trade and Reconstruction of November 11, 1959 on certain requirements for the deposit of designs, Federal Law Gazette. No. 255,
3. the ordinance of the Federal Minister for Trade, Commerce and Industry of November 11, 1969 on the establishment of design depository offices and on proof of the right of priority (design ordinance), Federal Law Gazette No. 387.
- (4) The legal provisions repealed in accordance with (3) shall, however, continue to be applied to designs that were deposited before January 1, 1991.
- (5) § 40 (1), Article 41 (1), § 42 (1) and § 43 (1) as amended by Federal Law Gazette I No. 143/2001 come into force on January 1, 2002.
- (6) § 1, the heading of § 2, §§ 2, 2a, the heading of § 2b, §§ 2b, 3, 4, the heading of § 4a, §§ 4a, 5 (1), the heading of § 5a, §§ 5a, 6, the heading of § 11, §§ 11, 12, 16 Paragraph 1, §§ 17, 20 Paragraphs 1 and 2, §§ 20a, 21, the heading of § 23, § 23, the heading of § 25, § 25 (1), § 26 (2), §§ 29, 31 (2) and (3), § 32 (1), (4), (5) and (7), § 41 (1) of Section VII, the designation of Section VIII, §§ 46a and 48 in the version of the Federal Law, Federal Law Gazette I No. 81/2003, come into force on the day following the publication of the aforementioned Federal Law. At the same time, the heading of § 12, § 24 including the heading and § 44 (3) are no longer in force.
- (7) The ordinance of the Federal Minister for Economic Affairs on the establishment of design registration offices (Design Registration Office Ordinance MASTV), Federal Law Gazette No. 715/1990, ceases to apply when Federal Law Federal Law Gazette I No. 81/2003 comes into force. However, the legal provisions are still to be applied to designs that were registered before the aforementioned federal law came into force.
- (8) § 20 (2), § 25 (3), § 26 (2), the heading of § 27, §§ 27, 28 (1 to 7), § 30 (2), (4) and (5), § 32 (2), §§ 34, 35, the heading of Section VIII, the heading of § 44c, §§ 44c, 44d, the heading of § 45, §§ 45a and 47 item 3 in the version of the Federal Law, Federal Law Gazette I No. 149/2004 come into force at the beginning of the seventh month following the publication of the aforementioned federal law. At the same time, § 28 (5), Section VI and § 47 no.3 in the version currently in force no longer apply.
- (9) § 35 (3) as amended by Federal Law Gazette No. 151/2005 comes into force on January 1, 2006.
- (10) §§ 26, 27 (2), the heading of § 29, § 29 (2), § 32 (1) and (4) to (5), the heading of Section VI, §§ 40 to 43e with headings, § 44d (5) and § 47 No. 2 in the version of the Patent and Trademark Law Amendment Act 2014, Federal Law Gazette I No. 126/2013 come into force on January 1, 2014. At the same time § 28 with heading and § 30 in the version currently in force no longer apply.

(11) § 20 (3) and § 22 in the version of Federal Law, Federal Law Gazette I No. 124/2017, enter into force on the day following the publication of the aforementioned Federal Law.

(12) The heading of § 31 and § 37 (2) in the version of Federal Law, Federal Law Gazette I No. 37/2018 (2. Materien-Datenschutz-Anpassungsgesetz) enter into force on May 25, 2018.

**§ 46a.** § 20 (3) as amended by Federal Law Gazette I No. 131/2005 comes into force on January 1, 2006.

**§ 46b.** § 26 (2) as amended by Federal Law, Federal Law Gazette I No. 71/2016 comes into force with the first day of the tenth month following the publication of the aforementioned Federal Law.

**§ 47.** The following persons are entrusted with the implementation of this Federal Act:

1. with regard to § 25 (2) in conjunction with § 49 (4) of the Patent Act 1970 and with regard to §§ 34 to 38 in conjunction with §§ 148 to 154 and 160 of the Patent Act 1970 the Federal Minister of Justice,

2. with regard to § 26 (2) in conjunction with § 126 of the Patent Act 1970 and with regard to §§ 40 to 43e the Federal Minister for Traffic, Innovation and Technology and the Federal Minister of Justice,

3. with regard to all other provisions of this Federal Law, the Federal Minister for Economic Affairs.

**§ 48.** This federal law implements Directive 98/71 / EC of the European Parliament and of the Council of October 13, 1998 on the legal protection of designs, OJ No. L 289 of October 28, 1998, page 28.