

Austrian Trade Mark Protection Act 1970

Federal Law Gazette 1970/260 as amended by Federal Law Gazette 1977/350, 1981/526, 1984/126, 1987/653, 1992/418, 1992/773, 1993/109, I 1999/111, I 1999/191, I 2001/143, I 2004/149, I 2005/131, I 2005/151, I 2006/96, I 2007/81 and I 2009/126

CHAPTER I

General provisions

1. Trade marks may mean all signs that can be shown graphically, especially words including personal names, designs, letters, numerals and the shape of goods or of their packaging, to the extent that such signs are capable of distinguishing goods and services of one undertaking from those of other undertakings.

2. (1) The acquisition of the trade mark right shall require registration of the trade mark in the Trade mark Register.

(2) This Federal Act shall apply *mutatis mutandis* to trade mark rights acquired on the basis of intergovernmental agreements for the territory of Austria. Moreover, such trade marks shall be examined for their legality (section 20).

(3) Trade mark rights acquired by virtue of the Regulation (EC) No. 40/94 on the Community trade mark, Official Journal No. L 11, dated 1/14/1994, page 1, as amended by Regulation (EC) No. 3288/94 for the Implementation of the Agreements entered into as part of the Uruguay Round, Official Journal No. 349, dated 12/31/1994, page 83, shall be considered equivalent to trade mark rights acquired by virtue of this Federal Law, unless the provisions under Community law concerning trade mark matters state otherwise. In other respects, the regulations of chapter VIII shall apply.

3. (*Cancelled; Federal law Gazette I 111/1999*)

4. (1) Excluded from registration shall be signs that

1. exclusively consist of

- a) national armorial bearings, national flags or other state emblems or armorial bearings of an Austrian provincial or local authority,
- b) official control or guarantee signs introduced in Austria or, pursuant to a notice to be published in the Federal Law Gazette (section 6 (2)), in a foreign state for the same goods or services as those for which the trade mark is intended, or for similar goods or services,
- c) signs of international organisations, to which a member state of the Paris Convention for the Protection of Industrial Property belongs, provided such signs were notified in the Federal Law Gazette. The last sentence of section 6 (2) shall apply to such notification;

2. cannot be registered as a trade mark pursuant to section 1;

3. are devoid of any distinctive character;

4. consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or the rendering of the service, or to designate other characteristics of the goods or services;

5. consist exclusively of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services;

6. consist exclusively of the shape which results from the nature of the goods themselves, or of the shape of goods which is necessary to obtain a technical result, or of the shape which gives substantial value to the goods;

7. are contrary to public policy or accepted principles of morality;

8. are of such a nature so as to deceive the public for instance as to the nature, the quality or geographical origin of the goods or service;

9. include geographic information or consist of such information by which wines are labeled and which are intended for wines that do not have such origin, or by which spirits are labeled and which are intended for spirits that do not have such origin.

(2) Registration shall however be admissible in the cases referred to in subsection 1, number 3, 4 and 5, where the sign before the application in the trade concerned has acquired a distinctive character in Austria following the use which has been made of it

5. Trade marks containing a distinction or any of the signs referred to in section 4 (1) 1 as one of their features may, insofar as the use of such signs is subject to statutory restrictions, be registered only after the right to the use of such distinction or sign has been proven.

6. (1) It shall be prohibited to use in trade, without authorization, the national armorial bearings, the national flag, or any other state emblem, or the armorial bearings of an Austrian provincial or local authority to designate goods or services, or as part of the designation of goods and services, or use, without consent of the authorized person, the signs referred to in section 4 (1) 1 (c). It also shall be prohibited to use a test or guarantee sign without consent of the agency awarding the test or guarantee sign for the designation, or as part of it, of such goods or services for which the sign was introduced or for similar goods or services.

(2) Subsection 1 shall apply to foreign state emblems and official examination and guarantee signs only, if an intergovernmental agreement or reciprocity exists, and if the foreign sign was promulgated in the Federal Law Gazette. If the publication includes no reproduction of the official embodiment of the sign, it shall be stated where such a reproduction is publicly available.

(3) Anyone infringing this prohibition (subsection 1) shall be punished by the district administrative authority with a fine of up to € 218 or to detention not exceeding one month. In case of aggravating circumstances, these penalties may also be imposed concurrently.

7. Section 4 (1) 1 and sections 5 and 6 shall also apply to representations that resemble the official embodiment of the distinction or the sign. However, distinctions and signs of the kind identified in section 4 (1) 1, whose use is authorized, may also be features of trade marks (section 5) and used to designate goods and services, even if they resemble other such distinctions or signs (section 6).

8. (*Cancelled; Federal Law Gazette 350/1977*)

9. If it is necessary to more easily determine the origin of goods of a certain kind for their quality, especially their hazardous nature, or for economic reasons, the Federal Minister of Transport, Innovation and Technology can order that such goods may only be marketed if they are provided with a registered trade mark in a way to be identified by the order.

10. (1) Subject to safeguarding prior rights, the registered trade mark shall grant its proprietor the exclusive right to enjoin third parties, without his consent, in trade, from

1. using (section 10a) a sign identical with the trade mark in relation to goods or services, which are identical with those for which the trade mark was registered;
2. using (section 10a) a sign identical with or similar to the trade mark for identical or similar goods or services, if there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark.

(2) The proprietor of the registered trade mark shall also be permitted to enjoin third parties from using (section 10a) in trade, without his consent, a sign identical or similar to the trade mark for goods or services which are not similar to those for which the trade mark was registered, if the latter is known in Austria, and where use of the sign without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark. The reputation of the earlier trade mark shall have existed on the day the later trade mark was filed, at the latest, if need be on the day giving rise to a right of priority or seniority, or at the time the later other right came into existence.

(3) The registered trade mark shall not grant its proprietor the right to enjoin a third party from using in trade

1. his name or his address,
2. information about the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or the rendering of the service, or about other features of the goods or the service,
3. the trade mark, if necessary, as a reference to the intended purpose of a product, especially as an accessory or spare part, or a service,

provided this is in compliance with the proper customs in trade or industry.

10a. The following shall especially be seen as using a sign to designate goods or services:

1. affixing the sign to goods, to their packaging or to items, to which the service is rendered or is to be rendered,
2. offering the goods, putting them on the market or stocking them for these purposes, or offering or rendering services under the sign,
3. importing or exporting goods under the sign,
4. using the sign on business documents, announcements or in advertising.

10b. (1) The trade mark shall not grant its proprietor the right to enjoin a third party from using the trade mark for goods that were brought into circulation in the European Economic Area under this trade mark by their proprietor or with his consent.

(2) Subsection 1 shall not be applicable if justifiable reasons warrant that the proprietor opposes the further distribution of the goods, especially if the condition of the goods has changed or deteriorated after being brought into circulation.

11. (1) Independent of a transfer of the undertaking, the trade mark may be assigned for some of the goods or services for which it was registered. If the trade mark right belongs to an undertaking, the trade mark right including any licensing rights thereto shall pass to the new proprietor, unless stipulated otherwise in the event the transfer affects the entire undertaking.

(2) If the request to transfer or the documents submitted in this connection show in an apparent way that the trade mark, as a result of the legal transfer, is capable of deceiving the public, especially about the kind, the quality or the geographical origin of the goods or services, the transfer request shall be rejected, unless the acquirer agrees to a restriction of the list of goods and services to eliminate the risk of deception.

(3) As long as the transfer of the trade mark has not been recorded, the trade mark right may not be asserted before the Patent Office, and all communication concerning the trade mark may be delivered to the person registered as the proprietor of the trade mark with effect against the acquirer.

12. Without the authorized person's consent no one may use the name, the firm name or the special designation of the undertaking of another person for designating goods and services.

13. (1) If the quotation of a registered trade mark in a dictionary, encyclopedia or similar reference book creates the impression as if it were a generic designation of the goods and services for which it was registered, the publisher of the work shall ensure upon request by the proprietor of the trade mark that the quotation of the trade mark is accompanied by a reference when the work is reissued, at the latest, that it is a registered trade mark.

(2) Subsection 1 shall also apply to reference books that were stored electronically and made available to the public via electronic networks. In this case any essential alteration of the contents of the reference book shall be deemed to be a reissue.

14. (1) The trade mark may be the subject of exclusive or non-exclusive licences for all or some of the goods and services for which it was registered, and for the entire federal territory or a part thereof.

(2) The proprietor of a trade mark may invoke the rights conferred by that trade mark against the licensee who in terms of

1. the duration of the licence,
2. the form covered by the registration in which the trade mark may be used,
3. the scope of goods or services for which the licence is granted,
4. the territory in which the trade mark may be used, or
5. the quality of the goods manufactured or of the services rendered by the licensee

contravenes any provision of the licensing agreement.

15. *(Cancelled; Federal Law Gazette 350/1977)*

CHAPTER II

Registration, transfer and cancellation of trade marks

1. Registration

16. (1) The Trade mark Register is kept by the Patent Office.

(2) An application for registration of the trade mark shall be filed with the Patent Office in writing. Unless the trade mark consists merely of numbers, letters or words without any graphic embodiment and no specific written form is claimed for this, a representation of the trade mark shall be submitted – in the case of sound marks also a representation of the trade mark in musical notation or sonogram including a sound rendition of the trade mark on a data medium. The number of the trade mark representations to be submitted, their quality and dimensions as well as the data media to be used for the sound rendition and details of the sound rendition, such as formatting, scanning rate, resolution and play time, shall be stipulated by order.

(3) The application shall list for which goods and services the trade mark is intended (list of goods and services); detailed requirements of the list of goods and services and the number of pieces to be presented shall be specified by order.

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

17. (1) On registration the following shall be entered into the Trade mark Register:

1. the trade mark,
2. the registration number,
3. the date of the application and the priority claimed, if any,
4. the proprietor of the trade mark and his representative, if any
5. the goods and services for which the trade mark is intended, arranged in accordance with the International Classification (Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Trade marks, Federal Law Gazette No. 401/1973 as amended),
6. the beginning of the period of protection,
7. if applicable, a reference that the trade mark was registered based on evidence of acquired distinctiveness.

(2) If the registration occurs due to a conversion request, a reference to this effect shall be included in the Register. Moreover, the following shall apply:

1. If the registration is based on a conversion request pursuant to Article 108 of the Regulation (EC) No. 40/94, the filing date within the meaning of subsection 1 number 3 shall be the filing date of the Community trade mark within the meaning of Article 27 of this Regulation. If applicable, the seniority owing pursuant to Article 34 or 35 of this Regulation shall also be entered into the Register.
2. If the registration is based on a conversion request pursuant to Article 9 *quinquies* of the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, Federal Law Gazette III No. 32/1999, the filing date within the meaning of subsection 1 number 3 shall be the date of the international registration within the meaning of Article 3 (4), or the date of the registration of the territorial extension within the meaning of Article 3 *ter* (2) of the Protocol. If applicable, the time precedence granted to the trade mark pursuant to Article 4 *bis* of the Protocol shall also be entered.

(3) Trade marks that merely consist of numbers, letters or words without any graphic embodiment, and for which no specific written form is claimed, shall be registered in capital letters or in Arabic numerals.

(4) The proprietor of the trade mark shall receive an official confirmation about entries in the Register pursuant to subsection 1.

(5) The trade mark shall be published following registration.

(6) Anyone shall have access to the Trade mark Register and the catalogues to be created about its content for inspection. Upon request, a certified copy of its entries shall be issued.

18. (*Cancelled; Federal Law Gazette I 149/2004*)

19. The trade mark right shall come into being on the day it is entered into the Trade mark Register (registration). The period of protection shall expire ten years after the end of the month in which the trade mark was registered. It may be extended for further periods of ten years by paying a renewal fee on time. The new period of protection shall be counted from the end of the immediately preceding period of protection, irrespective of the renewal date.

20. (1) Each trade mark application shall be examined for its legality.

(2) If this examination reveals that concerns exist against the admissibility of the trade mark's registration, the applicant shall be asked to comment within a certain time period. If the inadmissibility of the registration is determined after timely commenting or after the expiration of the time limit, the registration of the trade mark shall be rejected by decision.

(3) If concerns exist against the admissibility of the registration pursuant to section 4 (1) 3, 4 or 5, at the applicant's request, prior to the rejection, it shall be laid down by decision that the sign filed for registration can only be registered subject to the requirements of section 4 (2); such a decision may be appealed (section 36).

21. (1) Each trade mark application shall further be examined by the Patent Office within the scope of its partial legal capacity (section 58a (1) of the Austrian Patent Act 1970, Federal Law Gazette No. 259) as to whether it is identical or possibly similar to trade marks with earlier priorities, which were registered for goods or services of the same class (similarity search). The applicant shall be informed of identical or possibly similar trade marks together with the notice that the sign will be registered in case of admissibility (section 20 (2)), unless the application is withdrawn within the time period set by the Patent Office.

(2) The notification pursuant to subsection 1, or its omission, shall be irrelevant for the assessment of the scope of protection of the respective signs. It shall require no signature or official certification.

21a. International trade marks (section 2 (2)) for which protection in Austria is claimed, insofar as the technical and organisational conditions necessary for this exist, shall be examined for similarity within the time period open for notifying the refusal of protection. Section 21 shall apply *mutatis mutandis*.

22. Upon request, the Patent Office shall provide information in writing to anyone within the scope of its partial legal capacity (section 58a (1) of the Austrian Patent Act 1970, Federal Law Gazette No. 259), whether a specific sign is identical or possibly similar to trade marks whose goods and services fall under the classes specified in the request. Section 21 (2) shall apply to such information. If the sign is a registered trade mark, it shall be sufficient to indicate the registration number. Insofar as the technical and organisational conditions necessary for this exist, such a similarity search shall also comprise trade mark applications, Community trade marks and Community trade mark applications.

23. (1) On the day a trade mark is properly filed the applicant shall obtain the priority right.

(2) The list of goods and services of a filed or registered trade mark may later be extended. The provisions concerning the filing of trade marks shall apply to such an extension *mutatis mutandis*.

24. (1) The priority rights granted on the basis of intergovernmental agreements as well as priority rights pursuant to subsection 2 shall be expressly claimed. In this connection the filing date whose priority is claimed and the country in which this application was effected shall be indicated (priority declaration). Furthermore, the filing number of such application shall be given.

(2) The applicant shall enjoy the right of priority of a previous trade mark application for a subsequent application in Austria for a period of six months following the date of filing the previous trade mark filed with an application office not covered by the scope of an intergovernmental agreement on recognition of priority if the subsequent trade mark application refers to the same mark and if a respective mutuality with this application office is declared by a notice to be published by the Federal Minister of Transport, Innovation and Technology in the Federal Law Gazette. The requirements and the effects of such a priority right correspond to those of Article 4 of the Paris Convention for the Protection of Industrial Property, Federal Law Gazette No. 399/1973.

(3) The priority declaration shall be submitted to the Patent Office within two months after the application was received. Within such time period a correction of the priority declaration may be requested.

(4) If achieving or maintaining of the right of protection depends on whether the priority was lawfully claimed, it shall be necessary to prove the priority right. By order of the President of the Patent Office it shall be determined which type of proof shall be required in the proceedings before the Patent Office and before the Supreme Patent and Trade Mark Chamber to show such proof (priority documents) and when these documents will have to be submitted.

(5) If the priority declaration is not submitted in time, if the priority documents are not presented in time or if the filing number of the application whose priority is claimed is not disclosed, following an official request, within the period prescribed, the priority shall be determined based on the day of the application in Austria.

25. (1) Trade marks used to designate goods displayed at a domestic or foreign exhibition shall enjoy priority protection pursuant to the provisions of sections 26 and 27.

(2) The provisions of sections 26 and 27 shall apply in particular also to displays at design and product exhibitions.

26. (1) Protection shall exist only, if the Federal Minister of Transport, Innovation and Technology awarded the exhibition the priority protection treatment for those trade marks used for the designation of goods displayed there.

(2) The exhibition management shall request the award. This request shall include the information necessary for the decision concerning the claimed priority treatment.

(3) The request shall be granted, if awarding protection is necessary due to intergovernmental obligations or justified in light of the economic importance of the exhibition.

(4) Awarding priority protection treatment shall be published in the Official Journal (*Amtsblatt zur Wiener Zeitung*) and in the Austrian Patent Gazette at the expense of the exhibition management.

27. (1) The protection shall have the effect that the trade mark enjoys a priority right from the day the goods designated with the trade mark are brought into the exhibition space, provided an application for such a trade mark is filed with the Patent Office within three months after the day the exhibition closes. The application may only comprise the displayed goods designated with the trade mark at the exhibition.

(2) If identical or similar goods designated with identical or similar trade marks are brought into the exhibition space at the same time, the trade mark whose application was filed first shall have priority.

(3) The priority right shall be expressly claimed. For that purpose the exhibition and the day of bringing the goods designated with the trade mark into the exhibition space shall be specified (priority declaration). The provisions of section 24 (3) shall apply *mutatis mutandis*.

(4) The priority right shall be evidenced by a representation of the trade mark and a confirmation from the exhibition management as to which goods were displayed with the respective trade mark and when they were brought into the exhibition space (priority documents).

(5) If the priority declaration is not submitted on time or if the priority documents are not presented within the period prescribed following an official request, the priority date shall be determined by the filing date.

2. Changes in the Register

28. (1) Any record of transfer of a trade mark, registration and cancellation of licensing rights and liens shall take place at the written request of one of the parties involved and upon presentation of a document. If the document is not official, it shall be provided with the duly certified signature of the person disposing of his right. The entry and cancellation of liens shall also be effected at the request of the courts.

(2) Legal disputes concerning trade mark rights as well as cancellation proceedings (sections 30 to 34 and section 66), assignment proceedings (section 30a) as well as proceedings for the establishment *a posteriori* of the invalidity of a trade mark (section 69a) shall be recorded in the Trade mark Register upon request (entry relating to a dispute).

(3) In other respects, section 43 (3), (4) and (7) and section 45 (2) of the Austrian Patent Act 1970, Federal Law Gazette No. 259, shall apply *mutatis mutandis*.

(4) Upon request, the entries referred to in subsection 1 shall be noted in the official confirmation concerning the registration entry (section 17 (4)).

(5) Any transfer of the trade mark shall be published.

3. Cancellation

29. (1) The trade mark shall be cancelled:

1. at the request of the proprietor;
2. if the registration was not renewed on time (section 19);
3. if the right to the trade mark lapsed for reasons other than those stated under number 1 and 2;
4. following a legally binding decision, by means of which a registration was rescinded due to an opposition;
5. following a legally binding decision granting a petition for cancellation submitted to the Nullity Department.

(2) The cancellation shall be entered in the Trade mark Register (section 17) and published.

29a. (1) Within three months from the date the registration of the trade mark was published (section 17 (5)) the registration may be opposed. Such an opposition may be based on a trade mark only under the conditions of section 30 (1). This shall also apply to trade mark applications subject to their registration.

(2) If a trade mark is registered according to the Madrid Agreement concerning the International Registration of Marks, Federal Law Gazette No. 40/1973, and the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, Federal Law Gazette III No. 32/1999, the disclosure in the publication journal issued by the World Intellectual Property Organization (WIPO) shall supersede the publication referred to under subsection 1. The opposition period shall begin on the first day of the month, which follows the month listed as the issue month of the publication journal that includes the disclosure of the international trade mark.

(3) The well-founded opposition shall be received by the Patent Office no later than on the last day of the deadline. It and all of its attachments shall be submitted in writing in duplicate.

(4) If the fee to be paid for the opposition is not received within the opposition period, the opposition shall be deemed as not filed.

(5) No *restitutio in integrum* concerning the period to submit an opposition and to pay the opposition fee shall take place.

(6) The option to file a petition with the Nullity Department shall remain unaffected.

29b. (1) After the end of the opposition period the proprietor of the trade mark shall be informed about any oppositions received within the prescribed time period, and shall be granted adequate time, extendable for reasons worthy of consideration, to comment in writing. The first sentence of section 42 (3) shall apply *mutatis mutandis*, even if the opposition is based on an application that has not yet led to registration at the time of the decision. The provisions stated in section 42 (1) concerning challenges shall be applied in opposition proceedings, unless stipulated otherwise in the following.

(2) Following the trade mark proprietor's timely commenting, the member responsible pursuant to section 35 (1) shall make the relevant decisions regarding any necessary correspondence, the procurement of evidence offered by the parties as well as the collection of evidence. At the request of one party, or if the member deems it necessary in individual cases to decide on the opposition, he shall officially schedule oral proceedings. The member shall make a decision by freely assessing the available facts and evidence.

(3) Insofar as an opposition is based on a trade mark that has been registered for more than five years at the time the trade mark subject to opposition is published, it can only be upheld if, at the request of the proprietor of the trade mark, it is credibly shown within an adequate time period that there is no reason for cancellation pursuant to section 33a. If within a period of two months following delivery of the documents presented to credibly show the use of the trade mark, the proprietor of the trade mark files a petition for cancellation pursuant to section 33a against the opponent's trade mark with the competent authority and provides proof for this within an adequate time period, the opposition proceedings shall be suspended and, following a legally binding decision in these proceedings, resumed officially or by request.

(4) In addition, opposition proceedings may be suspended pursuant to section 190 ZPO [*Zivilprozessordnung* / Code of Civil Procedure] if the opposition is based on an application, the legality check (section 20) of an international registration involved in litigation has not legally concluded, the existence of one of the trade marks involved in litigation is challenged, or the trade mark substantiating the grounds for opposition is caught up in opposition proceedings itself, or several oppositions were filed against the same trade mark registration. In the last-mentioned case the emphasis, by way of a preliminary examination taking written comments into account, shall be placed on whether the trade mark registration will likely be rescinded due to one other or several other oppositions.

(5) The complete or partial rescission of a trade mark resulting from an opposition shall have retroactive effect to the beginning of the period of protection.

(6) Insofar as a trade mark was legally rescinded, or an international registration was legally denied protection as part of the legality check (section 20), or insofar as a trade mark was cancelled due to a legal binding decision, by means of which a request for cancellation filed with the Nullity Department was granted effective as of the beginning of the period of protection, pending opposition proceedings against this trade mark shall be deemed settled to the corresponding extent and the parties shall be informed about this. Similarly, opposition proceedings shall be terminated if during the proceedings the registration procedure relating to the application substantiating the opposition is concluded without registration, or the trade mark substantiating the opposition legally loses its protection for Austria.

(7) The parties shall bear the costs for the opposition proceedings themselves.

29c. (1) The responsible member shall open and conduct the oral proceedings. He shall verify the identity of the appeared and check their legal standing and any power of representation. He shall conduct the oral proceedings without permitting digressions and circuitousness in such a way that the parties' right to be heard is preserved. As the person conducting the oral proceedings the member shall determine the order in which the parties shall be heard, the evidence is taken and the results of earlier evidence or findings shall be submitted or discussed. He shall decide on motions to take evidence and shall reject apparently immaterial motions. He shall also be entitled to suspend and adjourn the oral proceedings as and when required, and to determine the time for resuming the oral proceedings. A record of the oral proceedings shall be taken.

(2) The Law on the Scale of Fees [*Gebührenanspruchsgesetz*] (GebAG) shall apply.

30. (1) The proprietor of an earlier filed, still lawfully existing trade mark may request the cancellation of a trade mark if either

1. the two trade marks and the goods or services, for which the trade marks were registered, are identical, or
2. the two trade marks and the goods and services, for which the trade marks were registered, are identical or similar, so that there exists a likelihood of confusion on the part of the public, which includes the likelihood that the trade mark would be associated with the earlier trade mark.

(2) The proprietor of an earlier filed, still lawfully existing trade mark having a reputation in Austria, may also request the cancellation of a trade mark if the two trade marks are identical or similar, but are registered for non-identical goods or services, and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. The reputation of the earlier trade mark shall be required to have existed no later than on the day the later trade mark was filed, if need be, on the day giving rise to a priority or seniority right.

(3) Petitions pursuant to subsection 1 or 2 shall be dismissed, if the applicant has acquiesced the use of the later, registered trade mark for a period of five successive years being aware of such use. This shall apply only to goods or services for which the later trade mark was used and only if the application of the later trade mark was not filed in bad faith.

(4) If a petition for cancellation pursuant to subsection 2 is based on an earlier Community trade mark, evidence of reputation in the European Community shall be furnished instead of evidence of reputation in Austria.

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

30a. (1) Anyone who acquired rights to a sign abroad through registration or use may request the cancellation of an identical or similar trade mark filed later for the same or similar goods or services if its proprietor is or was committed to safeguard the petitioner's commercial interests and had the trade mark registered without the latter's consent and without proper justification.

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

(3) Instead of the cancellation pursuant to subsection 1 the petitioner may request the transfer of the trade mark to him.

31. (1) The cancellation of a trade mark may be requested by a person furnishing evidence that the unregistered sign used by him for identical or similar goods or services, already at the date of application of the contested trade mark being identical or similar to his unregistered sign, had been considered within the trade circles concerned as designation of his undertaking's goods or services, unless the trade mark has been used by its proprietor unregistered for at least as long as it has been used by the undertaking of the petitioner.

(2) The petition shall be dismissed if the petitioner has acquiesced for a time period of five successive years in the use of the registered trade mark while being aware of such use. This shall apply only to those goods and services for which the registered trade mark was used and only if the application of the registered trade mark was not filed in bad faith.

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

32. (1) An entrepreneur may request the cancellation of a trade mark if his name, his firm name or the specific designation of his undertaking, or any designation similar to such designations, was registered as a trade mark or as a component of a trade mark without his consent (section 12) and if the use of the trade mark could entail the likelihood of confusion in trade with one of the aforementioned corporate signs of the petitioner.

(2) The petition shall be dismissed if the petitioner has acquiesced for a time period of five successive years in the use of the registered trade mark while being aware of such use. This shall apply only to those goods and services for which the registered trade mark was used and only if the application of the registered trade mark was not filed in bad faith.

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

33. (1) Anyone may request the cancellation of a trade mark on any grounds for cancellation ex officio.

(2) If the trade mark is cancelled because it ought not to have been registered, the cancellation decision shall have retroactive effect to the beginning of the period of protection (section 19 (1)).

33a. (1) Anyone may request the cancellation of a trade mark registered in Austria or enjoying protection in Austria pursuant to section 2 (2) for at least five years, provided that such trade mark was not genuinely used in Austria (section 10a) for the goods or services for which it was registered for the last five years before the day the petition was submitted, neither by the proprietor of the trade mark nor with his consent by a third party, unless the proprietor of the trade mark can justify the non-use.

(2) Where trade marks have not been used because of legal restrictions in trade with the goods or services for which they were registered, they shall not be subject to cancellation pursuant to subsection 1 only if interests warranting trade mark protection in Austria shall be recognized due to the genuine use of the sign abroad or due to other circumstances worthy of consideration.

(3) However, the proprietor of a trade mark may not cite a trade mark's use that was only begun after

1. the proprietor of the trade mark or a licensee had invoked the trade mark right vis-à-vis the petitioner, or

2. the petitioner had informed the proprietor of the trade mark or a licensee of the non-use,

provided the petition for cancellation was submitted within three months after one of the acts referred to under 1 or 2 was first committed.

(4) Use of the trade mark in a form differing only in elements which do not alter the distinctive character of the trade mark shall be equivalent to the use of the trade mark in the form in which it was registered,.

(5) Such use (subsection 1) shall be proven by the proprietor of the trade mark.

(6) The cancellation decision shall have a retroactive effect of five years, calculated from the day the petition was filed, however at most until the end of the fifth year of the period of protection.

33b. (1) Anyone may request the cancellation of a trade mark if, after the time it was registered, it has in trade become the common name of a product or service for which it was registered, in consequence of acts or inactivity of its proprietor.

(2) The cancellation decision shall have retroactive effect to the date for which the completed development of the trade mark to a sign in general use (generic term) has been proven.

33c. (1) Anyone may request the cancellation of a trade mark if, after the time of its registration and in consequence of the use made of it by its proprietor or with his consent in respect of the goods and services for which it is registered it is liable to mislead the public, particularly as to the nature, quality or the geographical origin of these goods or services.

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

34. (1) Anyone may request cancellation of the trade mark if the applicant acted in bad faith when he filed the application for registration.

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

4. Authorities and proceedings

35. (1) At the Patent Office the member of the Legal Department entrusted with these matters and responsible according to the allocation of duties shall be assigned to make decisions and handle all other matters of trade mark protection as well as the protection of geographical indications and designations of origin pursuant to Chapter VII, unless they are reserved for the President, the Appeal Department or the Nullity Department.

(2) Sections 58 to 61 of the Austrian Patent Act 1970, Federal Law Gazette No. 259 shall apply *mutatis mutandis*.

(3) By order of the President employees that are not members of the Patent Office may be empowered to deal with matters of the Legal Department, to be defined according to their type, provided this is expedient in view of the simplicity of the matters in question, and to the extent that the training of the empowered employees offers a guarantee for proper handling. These employees shall not be authorized to issue decisions relating to the protectability of trade marks and the admissibility of lists of goods and services. They shall be bound by the instructions of the member of the Legal Department responsible according to the allocation of duties. This member may at any time reserve matters or take charge of them.

(4) The decisions of the employees empowered according to subsection 3, like those of the responsible member, may be appealed.

36. The decisions of the Legal Department may be appealed. The party that considers itself aggrieved by a final decision of the Appeal Department may file an appeal with the Supreme Patent and Trade Mark Chamber. Sections 145a and 145b of the Austrian Patent Act 1970 shall apply *mutatis mutandis*.

37. The Nullity Department shall decide on petitions for cancellation of a registered trade mark (sections 30 to 34 and section 66), on petition for assignment (section 30a), as well as on petitions for the establishment *a posteriori* of invalidity of a trade mark (section 69a).

38. (1) The Appeal Department and the Nullity Department shall decide by a panel of three members, one of whom presides. The chairperson and one other member shall be legally qualified.

(2) Preliminary orders of the referee and interim decisions – except suspension decisions of the Nullity Department – may not be appealed separately; however, their amendment may be requested from the respective department.

39. (1) Final decisions of the Nullity Department may be appealed to the Supreme Patent and Trade Mark Chamber as the highest instance. Section 74 of the Austrian Patent Act 1970 shall apply *mutatis mutandis*, provided it refers to the Supreme Patent and Trade Mark Chamber acting in matters concerning final decisions of the Nullity Department.

(2) The Supreme Patent and Trade Mark Chamber shall deliberate and make 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 chairperson, three legally qualified members (section 74 (3) of the Austrian Patent Act 1970) as well as one technically qualified member (section 74 (4) of the Austrian Patent Act 1970). The chairperson shall assemble the boards such that they include one legally qualified civil servant and at least one judge. The chairperson shall appoint one member of the board as a referee. If necessary, the chairperson may appoint additional members of the board as co-referees.

(3) The provision of section 75 (2) of the Austrian Patent Act 1970 shall apply.

40. (Cancelled; Federal Law Gazette I 149/2004)

41. (1) Members of the Patent Office and the Supreme Patent and Trade Mark Chamber shall be excluded from participation under the requirements of section 76 (1) of the Austrian Patent Act 1970.

(2) Members of the Patent Office shall be excluded from participating in the Appeal Department if the appeal concerns a trade mark in the examination for legality (section 20) or similarity (sections 21 and 22) of which they participated or in the examination of which they participated in opposition proceedings (sections 29a to 29c).

(3) Members of the Patent Office shall be excluded from participating in the Nullity Department and members of the Supreme Patent and Trade Mark Chamber from participating in the latter

1. in proceedings concerning petitions for cancellation of a trade mark pursuant to section 30 or for establishing *a posteriori* the invalidity of a trade mark pursuant to section 69a in conjunction with section 30, in the examination for similarity (sections 21 and 22) or in opposition proceedings of which they participated, provided the same trade marks concerned are involved (sections 29a to 29c).

2. in proceedings concerning petitions for cancellation of a trade mark pursuant to section 33 or for establishing *a posteriori* the invalidity of a trade mark pursuant to section 69a in conjunction with section 33 in the issuing of decisions on the admissibility of the registration of which they participated.

(4) The provisions of section 76 (3) and (4) of the Austrian Patent Act 1970 shall apply *mutatis mutandis*.

42. (1) In other respects, unless stipulated otherwise in the following, sections 52 to 56, 57b, 64, 66 to 69, 70 (4), sections 71 to 73, 79, 82 to 86, 112 to 115, 116 to 126, 127 (1), (2), (4) and (5), section 128 first sentence, sections 128a to 133 (2), sections 134, 135, 137 to 145 and 165 of the Austrian Patent Act 1970 shall apply to the proceedings *mutatis mutandis*.

(2) The publications provided for in section 17 (5), in section 28 (5) and in section 29 (2) shall be made in the Austrian Trade Mark Bulletin. The granting of *restitutio in integrum* shall be published in the Austrian Trade Mark Bulletin if this granting causes the trade mark right to be restored.

(3) If the proprietor of a contested trade mark does not submit a counterstatement within the time period set, the Nullity Department, without further proceedings, shall order as requested the complete or partial cancellation or transfer of the trade mark or establish *a posteriori* the complete or partial invalidity of the trade mark. Where both, the cancellation and the transfer of a trade mark, are requested in the same proceedings the Nullity Department shall order the transfer, unless stipulated otherwise in the petition.

43 to 49. (Cancelled; Federal Law Gazette 1977/350)

50. (1) The parties involved in proceedings shall be entitled to inspect the documents relating to the proceedings and to make copies. Other persons shall be entitled to do so with the approval of the parties involved, or if they credibly show that they have a legal interest.

(2) Anyone may inspect documents that concern a trade mark still lawfully existing, may duplicate them or have copies made of them.

(3) The copies shall be certified by the Patent Office on request.

(4) The text or the representation of a trade mark application and the list of goods and services at the time of the application shall be disclosed to everyone. Information and official certificates as to when, by whom and, if applicable, which representative filed an application for a trade mark, the file number of the application, any priority claimed, the file number of the application on which priority is claimed, whether the application is still pending, as well as whether and to whom the right resulting from the application has been transferred, shall be supplied to any person.

(5) Records of deliberations and parts of files relating solely to internal administrative transactions shall not be accessible to the public. On request, parts of files whose publication is not necessary for the public's information may also be exempted from inspection if a business or company secret or another reason meriting consideration is present.

CHAPTER III

Claims relating to civil law for trade mark infringements

51. Anyone whose rights from a trade mark were infringed, or who has to worry about such an infringement, may sue for injunctive relief.

52. (1) The infringer of the trade mark shall be obligated to eliminate the condition in conflict with the law.

(2) The injured party may demand in particular that the objects infringing the trade mark as well as any existing stocks of the imitated trade marks (infringing objects) be destroyed, and the implements, machinery and other means (means of infringement) having served solely or mainly for the manufacture of the infringing objects be rendered unusable for the intended purposes at the expense of the infringer, insofar as the rights *in rem* of third parties are not infringed thereby.

(3) If the infringing objects or infringing means referred to in subsection 2 contain parts of which the continued existence and use by the defendant do not infringe the plaintiff's right of exclusion, the court shall specify those parts in the judgment ordering the objects or means to be destroyed or rendered unusable. In the execution of the judgment these parts shall, as far as possible, be excluded from being destroyed or rendered unusable, if the obligor pays the costs associated therewith in advance.

(4) If it becomes apparent in the course of the execution proceedings that greater costs would be incurred by making the means of infringement unusable than by destroying them and if those costs have not been paid by the obligor in advance, the Court of Execution shall, after having heard the parties, order the destruction of the means of infringement.

(5) If the unlawful condition can be eliminated in a way different from the one referred to in subsection 2, which involves no or less destruction of assets, the injured party may request only measures of that kind. However, the mere elimination of the trade mark from the goods shall suffice only if a different approach would lead to undue hardship for the infringer.

(6) Instead of destroying the infringing objects or rendering unusable means of infringement the injured party may request that the infringing objects or means of infringement be surrendered by their owner in exchange for adequate compensation, not exceeding the costs of production.

53. (1) The party infringed by the unauthorized use shall be entitled to adequate compensation from the infringer.

(2) In case of culpable trade mark infringement the infringed party may, instead of adequate compensation, demand

1. damages including loss of profits, or

2. the surrender of the profits, which the infringer generated by infringing the trade mark.

(3) Irrespective of providing proof of any damage the injured party may demand double the compensation amount it is entitled to pursuant to subsection 1 if the trade mark infringement was caused by gross negligence or intent.

(4) The injured party shall also have a claim to adequate compensation for disadvantages not consisting of a damage in property which it suffered as a result of culpable trade mark infringement, provided this is justified by the specific circumstances of the case.

(5) To the extent that the same pecuniary claim is raised against several persons, they shall be jointly and severally liable.

54. (1) The proprietor of an undertaking may be sued for injunctive relief (section 51) if a trade mark infringement has been or is likely to be committed by an employee or an agent in the course of activities of his undertaking. He shall be obligated to eliminate the infringement (section 52) if he is the owner of the objects or means of infringement.

(2) If the trade mark infringement establishing a right to adequate compensation is committed in the course of activities of an undertaking by an employee or agent, the obligation to pay the compensation (section 53 (1)), draw up accounts (section 55) and provide information (section 55a) shall only affect the proprietor of the undertaking, unless the latter was neither aware nor derived any advantage from the trade mark infringement.

(3) If a trade mark infringement is committed in the course of activities of an undertaking by an employee or agent, the proprietor of the undertaking, irrespective of these persons' liability, shall be liable pursuant to section 53 (2) to (4) if he was aware, or should have been aware of the trade mark infringement.

55. In other respects section 119 (2) (exclusion of the public), section 149 (publication of the judgment), section 151 (accounting) and section 154 (limitation) of the Austrian Patent Act 1970, Federal Law Gazette No. 259, shall apply *mutatis mutandis*.

55a. (1) Anyone who has suffered an infringement of one of the rights arising from his trade mark may demand information about the origin and the distribution networks of the infringing goods and services, unless this would be disproportionate in comparison to the severity of the infringement and violate legal duties to maintain confidentiality; the infringer and the persons who were found to be commercially

1. in possession of infringing goods,

2. using the infringing services, or

3. providing services used in infringing activities,

shall be obligated to provide information.

(2) The obligation to provide information pursuant to subsection 1 shall, if appropriate, comprise

1. the names and addresses of the producers, distributors, suppliers and the other previous holders of the goods or services as well as the intended wholesalers and retailers,

2. the quantities produced, delivered, received or ordered, as well as the price obtained for the goods or services in question.

56. (1) With reference to rights to demand an injunction, elimination, adequate compensation, damages and surrender of the profit under this act preliminary injunctions may be issued to safeguard the claim itself as well as to secure evidence. However, a preliminary injunction which is based on a trade mark registered for more than five years may only be issued if it is credibly shown that the grounds for cancellation pursuant to section 33a are not present.

(2) To safeguard claims for adequate compensation, damages and surrender of profits preliminary injunctions may be issued in the case of commercially committed infringements if it is likely that the fulfillment of these claims is jeopardized.

(3) To safeguard the right to demand an injunction and elimination preliminary injunctions may be issued even if the requirements referred to in section 381 of the Execution Order are not met.

(4) At the request of the injured party preliminary injunctions pursuant to subsection 1 shall be issued without hearing the other party if a delay would likely cause the injured party to suffer irreparable damage or if there is a danger that evidence would be destroyed.

57. If, in the course of the court proceedings, it turns out that the decision depends on the preliminary question whether the trade mark right the infringement of which is alleged is valid according to the provisions of this act and if the court suspended the proceedings until a legally effective decision has been passed on the preliminary question by the Patent Office at which the preliminary question had already been brought to trial prior to the beginning of or during the court proceedings, the judgment shall be based on that decision.

58. (1) If the proprietor of an earlier registered trade mark acquiesced in the use of a later sign in Austria during a time period of five successive years with knowledge of such use, he may not, in terms of the goods or services for which this later sign was used, object to the use by virtue of his earlier right, unless the user of the later sign acted in bad faith when commencing the use or, if the later sign is a registered trade mark, its application was filed in bad faith.

(2) In the case of subsection 1 the proprietor of the later trade mark or the user of the later sign may not object to the use of the earlier registered trade mark, although the latter may no longer be invoked against him.

59. (1) Where a commercial announcement or communication in respect of which an injunction in the meaning of section 51 is at issue appears in a publication not subject to the disposition of the obligor, the competent court for the authorisation of the execution may, upon request of the acting creditor, issue an order (section 355 EO) to the proprietor of the undertaking dealing with the publishing or the distribution of the publication to discontinue further publications of the announcement or communication in numbers, volumes or editions of the publications appearing after the delivery of the order or if the publication contains the announcement or communication only to discontinue the further distribution of the latter.

(2) This measure may also be adopted as an interim order in the meaning of section 382 EO under the terms of the rules of the Order of Execution upon request of an endangered party. Section 56, first sentence, and subsections 3 and 4 shall apply.

(3) As regards the claim for damages of the requester on the grounds of infringement of the order (section 355 EO) section 53 (2) 1 and (4) shall be applied *mutatis mutandis*.

CHAPTER IV

Trade mark infringements liable to prosecution

60. (1) Anyone who infringes a trade mark in trade shall be ordered by the court to pay a fine of up to 360 times the *per diem* rate. Any person who commits such an act commercially shall be sentenced to detention not exceeding 2 years.

(2) Likewise, anyone who uses without authorization a name, a company or the specific designation of a company or a trade mark similar to these designations for the designation of goods or services pursuant to section 10 in a way capable of causing confusion in trade shall be punished.

(3) The proprietor or manager of an undertaking who fails to prevent a violation committed by an employee or agent in the course of activities of an undertaking pursuant to subsection 1 or 2 shall be punished.

(4) If the proprietor of the undertaking pursuant to subsection 3 is a corporation, a collective, an association or another legal entity which is not a physical person, subsection 3 shall apply to the organs if they are guilty of having committed such an omission.

(5) The criminal law provisions referred to in subsection 1 and 2 shall not apply to employees or agents who acted upon instruction of their employer or the ordering party if, due to their economic dependency, they cannot be expected to refuse to commit such acts.

60a. (1) The offenses identified in section 60 shall be prosecuted only at the request of the injured party.

(2) The criminal proceedings shall be incumbent upon the single judge of the court of first instance.

(3) To assert the claims pursuant to section 53 the provisions of the Title XXI of the Austrian Code of Criminal Procedure 1975, Federal Law Gazette No. 631, shall apply. Both parties shall be entitled to appeal the judgment concerning the claims for damages.

60b. Section 52 of this Federal Act (elimination) as well as section 119 (2) (exclusion of the public) and section 149 (publication of the judgment) of the Austrian Patent Act 1970, Federal Law Gazette No. 259, shall apply *mutatis mutandis* to criminal proceedings in infringement cases concerning trade marks and signs. Section 57 (preliminary questions) shall also apply to criminal proceedings in trade mark infringement cases.

60c. Anyone who infringes the provisions of an order issued on the basis of section 9 shall be punished by the district administrative agency with a fine of up to € 72 or detention not exceeding one month. In case of aggravating circumstances these penalties may also be imposed concurrently. In case of a conviction the court shall also decide in favor of forfeiture of the relevant goods.

61. (1) Anyone who intercedes before the Patent Office or before the Supreme Patent and Trade Mark Chamber as a representative shall be required to have his residence in Austria; however, the professional regulations shall apply to attorneys, patent attorneys and notaries. The representative shall demonstrate his authorization by providing written authorization, an original or a duly certified copy of which shall be submitted. If several persons are authorized, each person shall also be individually authorized to represent.

(2) If an attorney, a patent attorney or a notary intercedes, the reference to the authorization granted to him shall replace its documentary proof.

(3) If a representative intercedes without authorization or, in the case of subsection 2, without referring to the authorization granted to him, the procedural step undertaken by him shall be effective only on condition that he produces proper authorization or refers to the authorization granted to him within the time limit set.

(4) Anyone who neither has a residence nor a place of business in Austria may assert rights from this Federal Act before the Patent Office only if he has a representative who fulfills the requirements of subsection 1. Before the Appeal Department and before the Nullity Department of the Patent Office as well as before the Supreme Patent and Trade mark Chamber he may assert these rights only if he is represented by an attorney, a patent attorney or a notary. However, if the residence or place of business is located in the European Economic Area or in the Swiss Confederation, the appointment of a person with a domestic residence authorized to accept service of process shall be sufficient to assert rights from this Federal Law. Neither the appointment of a representative nor of a person authorized to accept service shall be required to utilize services or information provided by the Patent Office.

(5) The authorization granted to an attorney, a patent attorney or a notary to act as a representative before the Patent Office shall authorize him by law to exercise all rights under this Federal Act before the Patent Office and before the Supreme Patent and Trade Mark Chamber, especially to file trade mark applications, withdraw applications, waive registered trade marks, file and withdraw petitions to be dealt with by the Nullity Department, file and withdraw legal remedies, conclude compromises, accept service of process of documents of any kind and receive payment of official fees and of the costs of proceedings and representation to be reimbursed by the adverse party, as well as appoint a substitute.

(6) The authorization in accordance with subsection 5 may be limited to a specific right of protection and to the representation in specific proceedings. It shall however not expire on the death of the principal or as a result of a change in his legal capacity.

(7) If a representative other than an attorney, a patent attorney or a notary shall also be authorized to waive a registered trade mark, in whole or in part, he shall be expressly authorized to do so.

61a. In addition to section 83c JN [*Jurisdictionsnorm* / Law on Court Jurisdiction] the place where

1. the representative has his residence or his place of business in Austria, or
2. the person authorized to accept service of process has his residence in Austria, or
3. in the absence of a representative with a residence or a place of business in Austria or a person authorized to accept service with a residence in Austria, the place where the Patent Office is situated

shall be deemed the place for matters relating to the trade mark as residence or place of business of a trade mark proprietor who has neither a residence nor a place of business in Austria.

CHAPTER VI

Collective trade marks

62. (1) Associations having legal personality may apply for the registration of trade marks the purpose of which is to identify the goods and services of their members and which are capable of distinguishing these goods or services from those of other undertakings (collective trade marks).

(2) Legal persons under public law shall be equal to the associations referred to in subsection 1.

(3) The provisions of this Federal Act shall apply to the collective trade marks accordingly, unless subsection 4 and sections 63 to 67 stipulate otherwise. Especially the legal effects provided in section 4 (2) and section 31 of this Federal Act and in section 9 (3) of the Federal Law against Unfair Competition 1984, Federal Law Gazette No. 448, also set in in favor of non-registered signs if a sign has validity in the trade concerned as a sign of the goods and services of the members of an association.

(4) In derogation from subsection 1 and section 4 (1) 4 collective trade marks may in trade consist exclusively of signs or indications that may serve to describe the geographical origin of the goods and services. Such a trade mark shall not entitle its proprietor or a member of the association which according to the regulations might be authorized to file a suit on its own to prohibit a third party from using this sign or indication in trade, provided such use is in compliance with the proper customs in industry or trade; in particular, such a trade mark may not be invoked against a third party which is entitled to use a geographical name.

63. The application of the collective trade mark shall include regulations that provide information about the name, place of business, purpose and representation of the association, about the circle of persons entitled to use the collective trade mark, the terms of use, withdrawal of the right of use if the trade mark is misused and about the rights and obligations of the parties in case the collective trade mark is infringed. In addition, for collective trade marks pursuant to section 62 (4), the regulations shall provide that each person whose goods or services originate from the relevant geographic area and are in compliance with the terms of use of the collective trade mark included in the regulations can become a member. The Patent Office shall be notified of later amendments to the regulations. Vis-à-vis others they shall not become effective until the day following such notification. The regulations and their amendments shall be presented in duplicate. Anyone may inspect the regulations.

64. When registering collective trade marks the Patent Office shall include the information prescribed in section 17 (1) with the following amendment and modification in the Trade mark Register and in the confirmation to be handed over to the party:

1. under the registration number the word “collective trade mark”;
2. a reference to the regulations and their date.

65. Collective trade marks may only be transferred to associations within the meaning of section 62 (1) or (2). The transfer request shall include the regulations of the new proprietor. Section 63 shall apply *mutatis mutandis*.

66. Irrespective of the regulations otherwise governing the cancellation of trade marks (section 62 (3)) a collective trade mark shall be cancelled

1. if an association within the meaning of section 62 (1) or (2) as the proprietor of the collective trade mark ceases to exist;
2. if the association allows or tolerates that the collective trade mark is used in a manner contradicting the general purposes or the regulations of the association. It shall especially be deemed an improper use if use of the collective trade mark is capable of misleading the trade.

67. The claim of the association for compensation due to unauthorized use of the collective trade mark which exists pursuant to the applicable regulations shall also include damage incurred by a member.

CHAPTER VII

Geographical Indications and Designations of Origin pursuant to Regulation (EC) No. 510/2006 for the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs, Official Journal No. L 93, P. 12, as amended by the Regulation (EC) No. 1791/2006, Official Journal No. L 363 dated 12/20/2006, P. 1

68. (1) Requests for registering a designation as a geographical indication or designation of origin pursuant to Regulation (EC) No. 510/2006, for amending the specification or for cancellation of the registered designation shall be submitted to the Patent Office and examined by the latter.

(2) By order of the President of the Patent Office the form and the content of these requests can be regulated in greater detail as well as the place and the type of the publications to be carried out applying the Regulation (EC) No. 510/2006 can be determined. In this connection the greatest possible usefulness and simplicity and, for electronic publications, especially the recognizability of the publication's date and of the process status, the necessary data security and the simple but constant accessibility to the data during the existence of the community protection shall be taken into account.

(3) If the request does not fulfill the prescribed requirements, the applicant shall be asked to correct the deficiencies within a prescribed time period, extendable upon request. Requests not corrected shall be rejected by decision.

(4) Unless stipulated otherwise in this chapter the other provisions of this Federal Act shall apply *mutatis mutandis* to the proceedings pursuant to this chapter.

68a. (1) The Patent Office shall publish the proper request electronically as well as a reference to this publication in the Austrian Patent Gazette. Within four months from the date of the electronic publication there may be filed a written objection with the Patent Office against this request. The well-founded objection and all exhibits shall be received by the Patent Office no later than on the last day of the deadline. No *restitutio in integrum* for missing the deadline for filing an objection or for missing the appeals deadline (subsection 7) shall take place.

(2) The admissible objection shall be served to the association filing the request within an adequate time period, extendable for reasons worthy of consideration, to provide written comments. If no timely written comments are provided, this shall be deemed a withdrawal of the request.

(3) After timely commenting the official in charge shall make the relevant decisions concerning any necessary correspondence, the procurement of evidence offered by the parties, as well as the collection of evidence. At the request of one party or if he deems this to be necessary in individual cases to decide on the objection, he shall officially schedule oral proceedings which he opens and conducts. He shall verify the identity of the appeared and check their legal standing and any power of representation, and conduct the oral proceedings without permitting digressions and circuitousness in such a way that the parties' right to be heard is preserved. As the person conducting the oral proceedings he shall determine the order in which the parties shall be heard, the evidence is taken and the results of earlier evidence or findings shall be submitted or discussed. He shall decide on motions to take evidence and shall reject apparently immaterial motions. He shall also be entitled to suspend and adjourn the oral proceedings as and when required and to determine the time for resuming the oral proceedings. A record of the oral proceedings shall be taken. The official in charge shall decide by freely assessing the available facts and evidence.

(4) The parties shall bear their own costs concerning the objection proceedings. The Law on the Scale of Fees 1975, Federal Law Gazette Nr. 136, shall apply.

(5) If the request fulfills the requirements of Regulation (EC) No. 510/2006 and the domestic provisions and those under Community law issued for their application, the Patent Office shall so determine by decision while, if need be, simultaneously rejecting a filed objection and publish this positive decision electronically. Otherwise, unless action pursuant to subsection 8 shall be taken, the request shall be rejected by decision.

(6) Under the conditions of Article 5 (6) of the Regulation (EC) No. 510/2006 an adjustment period adequate for the circumstances of the individual case may be determined in the positive decision.

(7) Every natural person or legal entity with a legitimate interest and a domestic residence or seat or place of business may appeal the decision pursuant to subsection 5 within two months from the electronic publication of the decision.

(8) If, as part of the examination of the submitted grounds of the objection, it is determined that the information of the single document published pursuant to subsection 1 require more than just minor amendments, the aforementioned proceedings shall be conducted again.

68b. (1) Objections pursuant to Article 7 (2) of the Regulation (EC) No. 510/2006 shall be filed with the Patent Office within four months after the related publication in the Official Journal of the European Communities pursuant to section 6 (2) of the Regulation and substantiated within such time period. The Patent Office shall receive the well-founded objection along with all exhibits no later than on the last day of the deadline. No *restitutio in integrum* for missing the deadline for filing an objection shall take place

(2) Objections filed late or objections not filed by means of or based on the sample of the prescribed form shall be deemed as not filed. The objector shall be informed about this. This notification, or the lack thereof, shall be inconsequential for the legal effect to take place.

(3) The Patent Office shall be the competent authority for proceedings pursuant to Article 7 (5) of the Regulation (EC) No. 510/2006.

68c. (1) The proceedings pursuant to section 68 (3) and (4) as well as section 68a shall be applied accordingly to requests for amending the specification pursuant to the first sentence of Article 9 (2) of the Regulation (EC) No. 510/2006.

(2) The proceedings pursuant to section 68 (3) and (4) as well as section 68a (1) to (5), (7) and (8) shall be applied accordingly to requests for the cancellation of a registered designation pursuant to Article 12 (2) of the Regulation (EC) No. 510/2006.

68d. (1) In proceedings under this chapter the Patent Office may solicit statements especially from federal ministries, regional authorities as well as from associations, organisations and institutions of trade and industry.

(2) As to questions relating to control bodies to be named and their special tasks the approval of the Federal Minister of Health, Family and Youth shall be obtained.

68e. If a legitimate interest is credibly shown, the Patent Office, in proceedings pursuant to sections 68 to 68c, shall grant access to the files as well as allow copies to be made. Section 50 (2) to (5) shall apply *mutatis mutandis*.

68f. (1) Anyone who carries out acts in trade that infringe section 8 (1) or Article 13 of the Regulation (EC) No. 510/2006 may be sued for injunctive relief by persons entitled to use the protected geographical indication or designation of origin or by associations for the promotion of economic interests of companies, provided these associations represent interests that are affected by such an act, by the Austrian Federal Chamber of Labour, by the Austrian Federal Economic Chamber, by the Presidential Conference of the Chambers of Agriculture of Austria or by the Austrian Trade Union Federation and, to the extent that he is entitled to such disposition, also for the elimination of the condition opposing the aforementioned provisions. Section 52 (2) and (6) shall apply *mutatis mutandis*.

(2) If one of the acts referred to in subsection 1 is carried out culpably, the person entitled to use the protected geographical indications or designation of origin shall be entitled to pecuniary claims by applying section 53 (2), (4) and (5) *mutatis mutandis*.

(3) The proprietor of an undertaking may be sued for injunctive relief pursuant to subsection 1 if one of the acts referred to in subsection 1 has been or is likely to be committed in the course of activities of the undertaking by an employee or an agent. He shall be obligated to elimination pursuant to subsection 1 if he is the proprietor of the objects or means of infringement.

(4) If an employee or agent committed an act referred to in subsection 1 in the course of activities of the undertaking, the proprietor of the undertaking, irrespective of any liability of these persons, may be sued for damages, applying section 53 (2) to (4) *mutatis mutandis*, and to draw up accounts if he was aware or should have been aware of the legal violation.

68g. (1) With reference to claims for injunctive relief, elimination, damages and surrender of the profit under this law preliminary injunctions to safeguard the claim itself as well as to secure evidence may be issued. Section 56 (2) to (4) shall apply *mutatis mutandis*.

(2) In other respects, section 55a as well as section 119 (2) (exclusion of the public), section 149 (publication of the judgment), section 151 (accounting), and section 154 (limitation) of the Austrian Patent Act 1970 shall also be applied *mutatis mutandis* to infringement proceedings under civil law according to this section.

68h. (1) Anyone who, in trade, without any justification by virtue of the existence of an exemption clause to carry a protected geographical indication or designation of origin, recognized under Community law,

1. uses such an indication or designation to identify products other than those referred to in the associated specification, but comparable to them, or
2. misuses, imitates or evokes the protected name, even if the true origin or the product is indicated, or if the protected name is translated or accompanied by expressions such as “style”, “type”, “method”, “as produced in” “imitation” or similar, or
3. uses such an indication or designation in a way that exploits the reputation of this protected name, or
4. uses such an indication or designation in any other misleading way in connection with the distribution of goods or services or to designate his undertaking,

shall be fined by the court to pay 360 times the *per diem* rate. Anyone who commits such an act commercially shall be sentenced up to two years in prison.

(2) Likewise, anyone who offers for sale, markets, or, for the aforementioned purposes, imports, exports or possesses goods designated in accordance with subsection 1 shall be punished.

(3) The proprietor or manager of an undertaking who fails to prevent an infringement pursuant to subsection 1 or 2 committed by an employee or agent in the course of activities of the undertaking shall be punished.

(4) If the proprietor of the undertaking pursuant to subsection 3 is a corporation, a collective, an association or another legal entity which is not a physical person, subsection 3 shall apply to the organs if they are guilty of having committed such an omission.

(5) The criminal law provisions referred to in subsection 1 and 2 shall not be applied to employees or agents who acted upon instruction of their employer or the ordering party if, due to their economic dependency, they cannot be expected to refuse to commit such acts.

68i. (1) The offenses identified in section 68h shall be prosecuted only at the request of a person entitled to use the protected geographical indication or designation of origin.

(2) To assert the claims under section 68 f (2), the provisions of Title XXI of the Austrian Code of Criminal Procedure 1975, Federal Law Gazette No. 631, shall apply. Both parties shall be entitled to appeal the judgment concerning the claims for compensation.

(3) The provisions on the elimination pursuant to section 68f (1) of this Federal Act as well as section 119 (2) (exclusion of the public) and section 149 (publication of judgment) of the Austrian Patent Act, Federal Law Gazette No. 259, shall apply in criminal proceedings *mutatis mutandis*.

68j. (1) Irrespective of the value of the matter in dispute the commercial courts shall have jurisdiction for actions and preliminary injunctions under this section.

(2) Jurisdiction in criminal matters under this section shall be incumbent upon the single judge of the court of first instance.

CHAPTER VIII

Community trade mark

69. Pursuant to Article 25 (1b) of the Regulation (EC) No. 40/94 on the Community trade mark, Official Journal No. L 11 dated 1/14/1994, page 1, as amended by Regulation (EC) No. 3288/94 for the implementation of the agreements entered into as part of the Uruguay Round, Federal Gazette No. 349, dated 12/31/1994, page 83, applications for Community trade marks may be filed with the Patent Office. The Patent Office shall note the date of receipt on the application and forward the documents without examination to the Office for Harmonization in the Internal Market (Trade marks and Designs) in Alicante within the time limit of two week prescribed in Article 25 (2) of this Regulation.

69a. (1) If, for a Community trade mark application or a registered Community trade mark pursuant to Article 34 or 35 of Regulation (EC) No. 40/94, the seniority of a trade mark registered in the Trade mark Register of the Patent Office or of a trade mark that enjoys protection in Austria by virtue of an international registration was claimed and if this trade mark forming the basis of the seniority claim was cancelled due to waiving on the part of its proprietor or due to a lack of timely renewal, the invalidity of the trade mark may be established *a posteriori* based on the grounds for cancellation pursuant to sections 30 to 34 and section 66.

(2) Petitions pursuant to subsection 1 shall be directed against the proprietor of the registered Community trade mark.

(3) If the establishment *a posteriori* of the invalidity of a trade mark pursuant to subsection 1 in conjunction with section 33a is requested, the date relevant shall be the effective date of the cancellation of the trade mark forming the basis of the seniority claim due to waiving on the part of its proprietor or due to a lack of timely renewal, not the date of the petition referred to in section 33a (1) and (6).

69b. In response to a request for conversion of a Community trade mark application or a registered Community trade mark into a domestic application transmitted by the Office for Harmonization in the Internal Market (Trade marks and Designs), the applicant, at the request of the Patent Office, shall within a time limit of two months, which may be extended upon request,

1. pay the fees payable for a domestic application,
2. present the required representations of the trade mark, in the case of sound marks also a sound rendition of the trade mark on a data medium, pursuant to section 16 (2),
3. submit a German translation of the request for conversion and the documentation attached thereto if the request for conversion or the documentation attached thereto have not already been submitted in German and
4. disclose an address for service pursuant to Article 110 (3c) of the Regulation (EC) No. 40/94, unless he is represented by an authorized representative pursuant to section 61 or has named a person authorized to accept service of process.

Otherwise, the application that emerged from the request for conversion shall be rejected by decision.

69c. (1) The application shall be treated like a domestic trade mark application and examined for legality (section 20) with the exception of the case regulated in subsection 2.

(2) If the request for conversion concerns a trade mark that was already registered as a Community trade mark, the trade mark shall not be examined for its legality (section 20).

69d. (1) Irrespective of the value of the matter in dispute, the Commercial Court of Vienna shall be the Community trade mark court of the first instance within the meaning of Article 91 (1) of Regulation (EC) 40/94. In legal matters in which the Community trade mark court has jurisdiction for actions the Commercial Court of Vienna shall also have exclusive jurisdiction for preliminary injunctions.

(2) Jurisdiction in criminal matters concerning Community trade marks shall be incumbent upon the Vienna Provincial Court for Criminal Matters.

CHAPTER IX
Trade marks in accordance with the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

70. (1) A request for conversion of an international registration shall be identified as such and include the number of the international registration. In addition,

1. an original or a certified copy of a written statement from the World Intellectual Property Organization showing the trade mark and the goods or services to which the protection of the international registration had extended on the territory of the Republic of Austria until the cancellation in the International Register, and
2. a German translation of all documentation, to the extent that it has not been drafted in German,

shall be submitted within a time period of two months which is extendable by request. If the request is not in compliance with the aforementioned requirements, it shall be rejected by decision.

(2) The application shall be treated like a domestic trade mark application and examined for legality (section 20) with the exception of the case regulated in subsection 3.

(3) If the request involves an international registration where the time limit for the refusal of protection pursuant to section 5 (2) of the Protocol has already lapsed without being used at the time of the cancellation, the trade mark shall not be examined for legality (section 20).

CHAPTER X
Prohibition of unauthorized legal representation

71. (1) Anyone who, in matters relating to the protection of trade marks, commercially

1. prepares written submissions or documents for proceedings before domestic or foreign authorities,
2. provides opinions,
3. represents parties before domestic authorities, or
4. offers to perform the activities referred to under (1) to (3),

having no authorization to represent parties professionally in such matters, shall be guilty of unauthorized legal representation and shall be liable to a fine not exceeding € 4,360.00 to be imposed by the district administrative authority.

(2) Representation of a legal person by employees of another legal person economically associated with the former shall not be considered as unauthorized legal representation. Other legal entities with the exception of natural persons shall be equivalent to legal persons.

(3) The special provisions relating to the treatment of unauthorized legal representation at ordinary courts shall not be affected.

CHAPTER XI

(Cancelled; Federal Law Gazette I 149/2004)

CHAPTER XII
Transitional provisions

73. Neither in the examination for legality (section 20) nor in the cancellation proceedings pursuant to section 33 the provision of section 4 (1) 9 shall apply to trade mark applications filed in good faith before January 1, 1996.

74. In terms of the claims which existed at the time Federal Act I 111/1999 entered into force against the proprietor of a trade mark registered before Federal Act Federal Law Gazette I No. 111/1999 entered into force the term of the five-year period referred to in section 32 (2) shall begin when this Federal Act enters into force.

75. (1) The relevant provisions in the version applicable before Federal Act Federal Law Gazette I No. 111/1999 entered into force shall continue to be applied to petitions for cancellation of a trade mark pursuant to section 33 in conjunction with sections 1, 3, 4, 7, 60 or 66 filed before Federal Act Federal Law Gazette I. No. 111/1999 entered into force.

(2) If a petition for cancellation pursuant to section 33 of a trade mark registered before the Federal Act referred to in subsection 1 is entered into force is filed after the Federal Act referred to in subsection 1 entered into force, such a petition can no longer be based on section 33 in conjunction with sections 1, 3, 4, 7, 60 or 66 in the version applicable before the Federal Act referred to in subsection 1 entered into force, but only on section 33 in conjunction with sections 4, 7 or 66 as amended by the Federal Act referred to in subsection 1.

76. For assessing the use of a trade mark in the time period until January 1, 1994, section 33a in the version applicable before Federal Act Federal Law Gazette I No. 111/1999 entered into force shall continue to apply to petitions pursuant to section 33a.

77. (1) The provisions of the Chapter III in the version applicable before Federal Act Federal Law Gazette I No. 111/1999 entered into force shall continue to apply to actions filed before Federal Act Federal Law Gazette I No. 111/1999 entered into force.

(2) In terms of the claims that existed at the time Federal Act Federal Law Gazette I No. 111/1999 entered into force against the proprietor of a trade mark registered before Federal Act Federal Law Gazette I No. 111/1999 entered into force or against the user of a sign whose use was commenced before such time the term of the five-year period referred to in section 58 shall begin when this Federal Act enters into force. Any limitation that already occurred shall remain unaffected by this provision.

77a. (1) Section 35 (4) in the version applicable before Federal Act Federal Law Gazette I No. 149/2004 entered into force shall continue to apply to decisions of empowered employees that were made before the aforementioned Federal Act entered into force.

(2) Section 18 (1) and section 63 (2) in the version applicable before Federal Act Federal Law Gazette I No. 149/2004 entered into force shall continue to be applied to applications filed before the aforementioned Federal Act entered into force and to requests that were filed before the aforementioned Federal Act entered into force and that are to be treated as applications. Section 18 (2) and (3) and section 63 (2) in the version applicable before the aforementioned Federal Act entered into force shall apply to fees relating to the period of protection and to printing cost contributions the payment of which was requested before the aforementioned Federal Act entered into force.

(3) Section 18 (4), section 22 (3) and (4), section 24 (3), section 28 (4), section 40 (1) and (2) first sentence, section 68 (2) and (5) and section 69b (2) 1 in the version applicable before Federal Act Federal Law Gazette I No. 149/2004 entered into force shall continue to apply to requests filed before the aforementioned Federal Law entered into force. Section 132 (1) and (3) of the Austrian Patent Act 1970 and section 42 (1) last half sentence in the version applicable before the aforementioned Federal Act entered into force shall continue to apply to *restitutio in integrum* requests filed before the aforementioned Federal Act entered into force.

(4) Section 19 (2) and (3) and section 63 (2) in the version applicable before Federal Act Federal Law Gazette I No. 149/2004 entered into force shall continue to apply to trade marks whose period of protection ends before the aforementioned Federal Act entered into force. This shall also apply to trade marks whose period of protection ends after the aforementioned Federal Law entered into force, but for which the renewal fee had already been paid properly before the aforementioned Federal Act entered into force.

77b. (1) Oppositions may only be filed against trade marks whose publication (section 29a (1) or (2)) did not take place before July 1, 2010.

(2) To appeals filed before the Appeal Department until January 1, 2010, section 36 in the version applicable until December 31, 2009, shall continue to be applied.

CHAPTER XIII

Final provisions

78. Any personal identification used in this Federal Act shall equally refer to both sexes.

79. To the extent that this Federal Act makes reference to provisions of other federal acts, the latter shall be applied as currently valid, unless stipulated otherwise.

80. The following shall be entrusted with enforcing this Federal Act:

1. in terms of sections 10, 10a, 10b, 12, 14, 23 and 57 the Federal Minister of Traffic, Innovation and Technology and the Federal Minister of Justice,
2. in terms of section 6 (2) the Federal Minister of Traffic, Innovation and Technology in agreement with the Federal Minister of External Affairs,
3. in terms of sections 13, 51 to 56, 58 to 60b, of section 67 and sections 68f to 68j the Federal Minister of Justice,
4. in terms of section 68d (2) the Federal Minister of Traffic, Innovation and Technology in agreement with the Federal Minister of Health, Family and Youth,
5. in terms of all other provisions the Federal Minister of Traffic, Innovation and Technology.

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

(2) Section 4 (1) 2, sections 9, 10 a, 16 (2), section 17 (4), sections 18, 22 (3), sections 26, 28 (2), sections 30, 30a, 31 (3), sections 32, 33, 33a (3) and (6), sections 33b, 33c, 37, 42, 60 (1), section 62 (3), sections 70, 71 and 72 (1) as amended

by Federal Act Federal Law Gazette No. 773/1992 shall enter into force simultaneously with the Treaty on the European Economic Area.

(3) Section 2 (3), section 4 (1) 9, section 17 (2) 1, section 24 (1) as well as Chapter VIII with the exception of section 69d as amended by Federal Act Federal Law Gazette I No. 111/1999 shall enter into force retroactively as of January 1, 1996.

(4) Section 17 (2) 2, section 18 (4) as well as Chapter IX as amended by Federal Act Federal Law Gazette I No. 111/1999 shall enter into force when the Protocol relating to the Madrid Agreement concerning the International Registration of Marks for the territory of the Republic of Austria, Federal Law Gazette III No. 32/1999, enters into force.

(5) Section 6 (3), section 18 (1), (2) and (4), section 19 (2), section 28 (4), section 40 (1), sections 60c, 68 (2), section 71 (1) and section 72 (1) as amended by Federal Act Federal Law Gazette I No. 143/2001 shall enter into force as of January 1, 2002.

(6) Section 19, section 20 (2), section 24 (3), section 27 (3), section 28 (4) and (5), section 35 (4), section 38 (2), section 39 (1), section 41 (4), section 42 (1) and (2), section 54 (2) and (3), sections 55a, 63, 65, the title of Chapter VII, sections 68, 68c, 68f (4), section 68g (2), section 69b (2) 1, sections 77a and 80 / 4 as amended by Federal Act Federal Law Gazette I No. 149/2004 shall enter into force from the beginning of the seventh month following the promulgation of the aforementioned Federal Act. Simultaneously, sections 18, 22 (3) and (4), section 28 (4), sections 40, Chapter XI and section 80 (4) in the version previously applicable shall go out of force.

(7) Section 39 (2) as amended by Federal Act Federal Law Gazette I No. 149/2004 shall enter into force from the beginning of the day following the promulgation of the aforementioned Federal Act.

(8) Section 60 (4) and section 68h (4) as amended by Federal Act Federal Law Gazette I No. 151/2005 shall enter into force as of January 1, 2006.

81a. (1) Section 24 (4) as amended by Federal Act Federal Law Gazette I No. 131/2005 shall enter into force as of January 1, 2006.

(2) Sections 55a, 56, 59 (2), section 68g (1), sections 69b and 83 as amended by Federal Act Federal Law Gazette I No. 96/2006 shall enter into force from the beginning of the day following the promulgation of the aforementioned Federal Act

(3) Section 61 (4), the title of Chapter VII, section 68 (1) and (2), sections 68a to 68d, section 68f (1) and section 80 as amended by Federal Act Federal Law Gazette I No. 81/2007 shall enter into force from the beginning of the day following the promulgation of the aforementioned Federal Act.

(4) Sections 22, 36 and 77b (2) as amended by Federal Act Federal Law Gazette No. I No. 126/2009 shall enter into force on January 1, 2010. Simultaneously, section 20 (2) last sentence shall go out of force.

(5) Section 29 (1), sections 29a to 29c, 41 (2) and (3), section 42 (1) and section 77b (1) as amended by Federal Act Federal Law Gazette I No. 126/2009 shall enter into force on July 1, 2010.

82. Orders on the basis of this Federal Act as amended may already be enacted beginning on the day that follows the promulgation of the Federal Act to be implemented; they shall however not enter into force prior to the legal provisions to be implemented.

83. By this Federal Act the Austrian Trade mark Protection Act is adjusted to Regulation 2004/48/EC of the European Parliament and of the Council on the Enforcement of Intellectual Property Rights, Official Journal No. L 157 dated April 30, 2004, page 45.