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## Patents Act 1970

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### I. GENERAL PROVISIONS

#### Patentable Inventions

**Sec. 1.** (1) For inventions in all technical fields provided that they are new (Sec. 3), are not obvious from the state of the art to a person skilled in the art and are susceptible of industrial application, patents will be granted upon request.

(2) Inventions which comply with the prerequisites of para (1) shall be patentable even if they concern a product consisting of or containing biological material or a method by means of which biological material is produced, processed or used, wherein biological material is any material containing genetic information and being capable of reproducing itself or being reproduced in a biological system. These patentable inventions also include

1. biological material which is isolated from its natural environment or produced by means of a technical method may be the subject of an invention even if it previously occurred in nature;
2. an element isolated from the human body or otherwise produced by means of a technical method, including the sequence or partial sequence of a gene, may constitute a patentable invention even if the structure of that element is identical to that of a natural element.

(3) The following, in particular, shall not be regarded as inventions:  
discoveries as well as scientific theories and mathematical methods;

1. the human body at the various stages of its formation and development;
2. the simple discovery of one element of the human body, including the sequence or partial sequence of a gene;
3. aesthetic creations;
4. plans, rules and methods for mental acts, for games or for business activities as well as programs for data processing plants;
5. the reproduction of information.

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

#### Exceptions from Patentability

**Sec. 2.** (1) Patents shall not be granted

1. on inventions the exploitation of which would violate law and order or would offend good manners; such violation or offense shall not be deduced merely by the fact that exploitation of the invention is prohibited by law or administrative regulations; in this sense, the following, in particular, shall be considered unpatentable:
  - a) methods for cloning human beings;
  - b) methods for modifying the germ line genetic identity of human beings;
  - c) the use of human embryos;
  - d) production and exploitation of hybrid species evolving from germ cells, totipotent cells or cell nuclei of human beings and animals;
  - e) methods for modifying the genetic identity of animals which are used to cause these

animals suffering without any substantial medical benefit to Man or animal, and also animals produced by such methods;

2. on methods intended for the surgical or therapeutic treatment of the human or animal body and diagnostic methods carried out at the human or animal body; this shall not apply to products, in particular, substances or compositions, to be applied in any of these methods.

(2) Patents shall not be granted for plant varieties or animal races as well as for substantially biological methods for breeding plants or animals. The concept of plant variety is defined by Article 5 of Regulation (EC) No 2100/94 on Community plant variety rights, Official Journal No. L 227 of 1 September 1994 p. 1, in the version of Regulation (EC) No 2506/95, Official Journal No. L 258 of 28 October 1995 p. 3. A method for breeding plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection. Inventions which concern plants or animals shall be patentable if the technical feasibility of the invention is technically not limited to a particular plant or animal variety. Sentence 1, part 2, according to which patents shall not be granted for substantially biological methods for breeding plants or animals, shall not affect the patentability of inventions the subject matter of which is a microbiological or other technical method or a product obtained by means of such a method, wherein a microbiological method means any method using microbiological material, or performed upon or resulting in microbiological material.

(3) When applying para (1) subpara 1 lit. a to c, the respective provisions of the Law regulating reproductive medicine, Fed. Law Gaz. No. 257/1992, have to be considered in their version valid at the time the present law has entered into force.

### Novelty

**Sec. 3.** (1) An invention shall be considered new if it does not form part of the prior art. Prior art shall be understood to comprise anything made available to the public by written or oral description, by use or in any other way, prior to the date of priority of the respective application.

(2) Prior art also shall be understood to comprise the contents of

1. patent applications based on this Federal Act,
2. utility model applications on the basis of the Utility Model Act, Fed. Law. Gaz. No. 211/1994,

3. international applications as defined by Sec. 1 subpara 6 of the Act Introducing Patent Treaties, Fed. Law Gaz. No. 52/1979, provided that the prerequisites of Sec 16(2) of the Patent Treaties Introduction Law has been fulfilled, and
4. European patent applications as defined by Sec. 1 subpara 4 of the Act Introducing Patent Treaties, and
5. European patent applications as defined by Sec. 1 subpara 4 of the Act Introducing Patent Treaties where the European patent application has been emanated from an International application, however, only provided that the prerequisites of Article 153(5) of the European Patent Convention, Fed. Law Gaz. No. 350/1979, are fulfilled,

enjoying an earlier priority in the originally filed version, whose contents has been officially published only on the day of priority of the younger application or thereafter. No such earlier priority applications shall be taken into account when assessing whether the invention is obvious from the prior art to a person skilled in the art.

(3) The patentability of substances or compositions forming part of the state of the art shall not be excluded by para (1) and (2), provided that they are intended for the use in a method according to Sec. 2 para (1) subpara 2 and their use in one of these methods does not form part of the state of the art. Para 1 and 2 shall also not exclude the patentability of said substances or compositions for any specific use in one of said methods, provided that such use is not comprised in state of the art.

(4) Para (1) and (2) shall not be applied to a disclosure of the invention effected not earlier than six months preceding the filing of the application and directly or indirectly based on

1. an apparent abuse to the detriment of the applicant or his legal predecessor, or
2. the fact that the applicant or his legal predecessor displayed the invention at official or officially recognised exhibitions as defined in the Convention on International Exhibitions, Fed. Law Gaz. No. 445/1980,

(5) Para (4) subpara 2 shall apply only if the applicant, when filing the application, states that the invention was shown at the exhibition and a confirmation by the organisers of the exhibition is submitted within four months from the filing date. Such confirmation shall include the date of opening of the exhibition and also the date of the first disclosure unless the latter occurred simultaneously at the same day. The confirmation

shall be accompanied by a description of the invention provided with an attestation note issued by the organisers of the exhibition.

### Entitlement to a Patent

**Sec. 4.** (1) Only the inventor or his legal successor shall be entitled to the grant of a patent. Until proved to the contrary, the first applicant shall be considered as the inventor.

(2) If an application is filed by the owner of the parent patent or by his legal successor for an improvement or other further development of an invention already protected by a patent or under application for a patent leading to such patent, the owner of the parent patent or his legal successor shall be free to apply for either an independent patent or a patent of addition dependent on the parent patent for such improvement or other further development.

**Sec. 5.** (1) The first applicant shall, however, not be entitled to the grant of a patent if he is not the inventor or his legal successor or if the substantial contents of his application has been taken from the descriptions, drawings, models, implements or arrangements of another person or from a process used by that person without consent by that person.

(2) If the invention successively has been taken from one owner of the invention by another without his consent, the earlier owner of the invention shall have priority over the later owner of the invention in case of dispute.

### Inventions by Employees

**Sec. 6.** (1) Employees also shall be entitled to the grant of a patent (Sec. 4) for any inventions made by them during their status of employment unless otherwise provided by contract (Sec. 7(1)) or by virtue of Sec. 7(2).

(2) Employees shall comprise salary and wage earners of any kind.

**Sec. 7.** (1) Agreements between employers and employees according to which future inventions of the employee are to belong to the employer or the right to use such inventions is to be granted to the employer, shall have legal effect only if the invention is an employee's invention (para (3)). To become effective, such agreement shall be in writing, which requirement shall be satisfied if included in a collective agreement (Sec. 2(1) of the Labour Organisation Act, Fed. Law Gaz. No. 22/1974).

(2) If a person is employed under public law, the employer may claim the right to the employee's inventions as a whole or the right to use such inventions without requiring an agreement with the employee; the right of use shall be effective also in respect of third parties. In such cases, the provisions of the following paragraph and of Sec. 8 to 17 and 19 shall apply accordingly.

(3) An employee's invention shall be regarded as the invention of an employee if its subject matter falls within the sphere of activity of the enterprise in which the employee is active and if

- a) either the activity that led to the invention forms part of the official duties of the employee, or
- b) the incentive for the invention by the employee is based on his activity within the enterprise, or
- c) the making of the invention was substantially facilitated by using the experiences or resources of the entrepreneur.

**Sec. 8.** (1) In any event, the employee shall be entitled to a reasonable special compensation for assigning to the employer an invention made by him as well as for granting the right of use in respect of such invention.

(2) If, however, the employee has been employed expressly for inventive activities within the employer's enterprise and actually is occupied primarily with such activities, and if the inventive activity incumbent on him led to the invention, he shall be entitled to a special compensation only to the extent that the higher pay due to him in view of his inventive activity by virtue of his employment contract does not already comprise a reasonable compensation for the invention.

**Sec. 9.** In assessing the compensation (Sec. 8), special attention shall be paid, depending on the circumstances of the case, to

- a) the economic importance of the invention to the enterprise;
- b) any other exploitation of the invention possibly occurred in Austria or abroad;
- c) what portion incentives, experiences, preliminary work or resources of the employer's enterprise or internal instructions have contributed to bringing about the invention.

**Sec. 10.** (1) Upon request of one of the parties concerned, the compensation may be altered later on at equitable discretion if there has been a substantial change in the circumstances governing the adequacy of the compensation. In no event shall, however, payments be refunded which the employee has received by virtue of

any previous assessment. Nor shall payments already effected by virtue of any previous assessment or having become due, be supplemented later on unless the compensation consists of a single payment.

(2) The employee shall be entitled to an alteration of the compensation also where the invention has been assigned to a third party by the employer, if the proceeds gained by the employer with this assignment are in striking disproportion to the compensation allocated to the employee or if the employer continues to participate in the exploitation of the invention, thereby gaining profits that are in striking disproportion to the compensation allocated to the employee.

(3) The request (para (1) and (2)) shall be made only after expiration of one year from the latest assessment of the compensation.

**Sec. 11.** (1) If the extent of compensation (Sec. 8 to 10) is made to depend on the use of the invention by the employer and the latter fails to use the invention to an extent commensurate with its economic importance to the enterprise, the compensation shall be assessed as if the employer used the invention to the extent commensurate with its economic importance to the enterprise.

(2) The compensation shall be assessed in the same manner if the employer has assigned the invention to a third party or has disposed of the same in any other way, unless the employee has agreed to such assignment or disposal and the employer fails to prove that such assignment or disposal has been effected just for pretense.

(3) The employer shall be released from the obligation provided under para (1) to pay the compensation, if he undertakes to transfer the right to use the invention to a third party to be designated by the employee. The third party, to whom the right of use is conceded, shall pay to the employer a compensation for his share in the invention to be assessed under consideration of the provisions under Sec. 9 lit. c. A subsequent alteration of such compensation may be requested under Sec. 10 with regard to this compensation.

(4) No claim (para (1 and 2)) shall be raised if the employer, under reasonable consideration of the circumstances of the case, cannot be expected to use the invention at all or to a greater extent than he has done or could be expected to do had there been no assignment or any other disposal. If, however, the employer does benefit from the invention without using the same, a reasonable compensation shall be due to the employee.

**Sec. 12.** (1) If and when an agreement exists, according to which future inventions of the em-

ployee are to belong to the employer (Sec. 7), the employee shall immediately notify the employer of any invention he makes except for those apparently not falling within the scope of the agreement. The employer shall declare to the employee within four months from the day he received that information whether he lays claim to the invention as an employee's invention by virtue of the existing agreement.

(2) If the employee fails to make such notification, he shall be liable to the employer for any damages including any loss of profits notwithstanding the employer's title to the invention. If the employer fails to make such declaration or if his declaration is negative, the invention shall remain with the employee.

**Sec. 13.** (1) The employer and the employee shall be obliged to maintain secrecy as to the inventions that constitute the subject matter of the notification and declaration provided under Sec. 12(1).

(2) The employee's obligation to secrecy shall lapse

- a) if the employer has failed to make the declaration stipulated under Sec. 12(1) or if he made a negative declaration within the term set;
- b) if the employer has set a claim to the invention in time (Sec. 12(1)) and has abandoned secrecy.

(3) The lapse of the obligation to secrecy pursuant to the preceding provision shall not affect the obligation to secrecy otherwise incumbent on the employee.

(4) The employer's obligation to secrecy lapses, if he has set a claim to the invention in time (Sec. 12(1)) and the employee has not opposed that claim.

(5) The obligation to secrecy shall not prevent the employer and the employee from filing a patent application for the protection of his rights in regard of the invention and to take any other steps required.

(6) The employer or the employee who violates the obligation to secrecy shall be liable for damages to the other party, including also the loss of profits.

**Sec. 14.** If the employer has paid a compensation to the employee for an employee's invention and it turns out afterwards that it was not this employee, but another employee of the same employer who made the invention or that another employee of the same employer participated in

making the invention, the employer may set off the compensation paid to the person without a title in favour of the person entitled, either in total or in proportion to the entitled person's share in the invention, if the compensation was paid in good faith and the invention also belongs to the employer according to the legal relationship existing in respect of the person entitled.

**Sec. 15.** (1) Even though the employer has made an agreement with the employee in the matter of an employee's invention, he may renounce his right to the invention wholly or partially at any time. In such a case, the employee may request that the employer's rights to the invention be assigned to him to the extent of the renunciation.

(2) If the employer renounces his rights to the invention completely, his obligation for payment of a compensation shall end at the time of such declaration of renunciation. In case of a partial renunciation, the employer may demand an appropriate reduction of the compensation provided the separate exploitation of the rights assigned to the employee is possible.

(3) The obligation to pay a compensation due for the time until the declaration of renunciation shall remain unaffected.

**Sec. 16.** The rights of the employer and of the employee stipulated by the provisions of Sec. 6 to 15 shall not be affected by the cancellation of employment.

**Sec. 17.** The rights with which the employee is vested by virtue of the provisions under Sec. 6 to 16 shall neither be revoked nor restricted by any agreement.

**Sec. 18.** Cancelled  
(Fed. Law Gaz. No. 1985/104)

**Sec. 19.** Claims by employers and employees arising under the provisions of Sec. 7 to 15 shall lapse after three years.

### Right of the Inventor to be mentioned

**Sec. 20.** (1) The inventor shall have the right to be mentioned as inventor.

(2) This right cannot be assigned and shall not be passed over to the heirs. Renunciation of such right shall be without legal effect.

(3) The mentioning as inventor shall be effected upon request by including in the publication of the application, in the announcement of the publication, in the publication of the grant of a patent, in the patent specification, in the Letters Patent

and by entry into the Patent Register. If the publication of the grant of a patent has already been made and the Letters Patent have already been executed, upon request a special certificate on the naming as inventor shall be executed and a special publication shall be published in the Patent Gazette. The naming as inventor shall also be included in the priority documents to be issued by the Patent Office.

(4) The request shall be made either by the inventor or by the applicant or by the patentee. If several persons are entitled to making the request, the requestor shall prove the consent of the other persons entitled unless the request has been made jointly by all of the persons entitled. If a person other than the person already named as inventor is to be named as inventor in addition to, or instead of, the person named as inventor, also the consent of the person so far named as inventor shall be proved.

(5) If the applicant, the patentee or the person already named as inventor refuses his consent, upon request the Patent Office has to decide on the claim to be named as inventor.

(6) The request (para (5)) shall be dealt with in accordance with the procedural provisions governing contestation proceedings. The grant of a patent shall not be deferred due to such pending proceedings relating to such a request. By virtue of a legally binding decision in favour of such a request, para (3) shall be followed upon request of the person entitled.

### Representatives

**Sec. 21.** (1) Anyone acting as a representative before the Patent Office or the Supreme Patent and Trademark Senate shall have his permanent residence or his place of abode in Austria; however, for attorneys at law, patent attorneys and notaries public, the professional regulations shall apply. The representative shall prove his authorisation by a written power of attorney to be presented in the original or by way of a duly certified copy. If several persons are authorised, each of them shall be authorised also to represent individually.

(2) If an attorney at law, a patent attorney or a notary public becomes active, reference to the authorisation granted to him shall replace documentary evidence thereof.

(3) If a representative becomes active without any power of attorney or, in case of para (2), without referring to the authorisation granted to him, the procedural act taken by him shall be effective only on condition that he will present a



duly executed power of attorney or will refer to the authorisation granted to him within a reasonable term set to him.

(4) A person who has neither his residence nor his place of abode in Austria, shall claim rights from this Federal Act before the Patent Office and before the Supreme Patent and Trademark Senate only if he is represented by a party representative as defined under Sec. 77. If residence or place of abode are within the EEA or in the Swiss Confederation, the appointment of a representative authorised to accept delivery who resides in Austria is sufficient for the claim of rights from this Federal Act. For the utilization of information and other services of the Patent Office including expertises and searches neither the appointment of a representative nor a representative authorised to accept delivery is necessary.

(5) In addition to Sec. 83c JN the place where

1. the representative has his Austrian residence or his Austrian place of abode or
2. the representative authorised to accept delivery has his Austrian residence or
3. in the absence of a representative having an Austrian residence or an Austrian place of abode or a representative authorised to accept delivery having an Austrian residence, the place where the Patent Office has its seat shall be regarded as the residence or place of abode of a patentee having neither his residence nor his place of abode in Austria, in all matters relating to the patent.

(6) The power granted to an attorney at law, a patent attorney or a notary public for representation before the Patent Office shall authorize the same by virtue of the law to assert all rights from this Federal Act before the Patent Office and before the Supreme Patent and Trademark Senate, in particular, to file patent applications, to restrict or withdraw patent applications, to lodge oppositions, to renounce patents, to lodge and withdraw requests to be treated by the Nullity Department as well as legal remedies, to enter into settlements, to accept communications of any kind as well as official fees and procedural and representation costs payable by the adverse party as well as to appoint a substitute.

(7) The authorisation pursuant to para (6) may be limited to a particular protective right or to representation in particular proceedings. It shall, however, expire neither by the death of the mandatory nor by any change in his capacity to act.

(8) If a representative who is neither an attorney at law, nor a patent attorney nor a notary public also is to be authorised to renounce a granted

patent in full or in part, he shall be expressly authorised to do so.

### Effect of a Patent

**Sec. 22.** (1) The patent entitles the patentee to exclude others from industrially producing the subject matter of the invention, putting it on the market, offering it for sale or using it or importing or possessing it for the above purposes. The effect of the patent does not extend to studies and trials as well as to the consequential practical requirements, as far as they are necessary for obtaining a permission, authorisation or registration for putting on the market pharmaceutical products.

(2) If the patent has been granted for a process, its effect shall also cover any products directly produced by this process.

(3) The patent further has the effect that without approval of the owner of the patent it is forbidden for a third party to offer or deliver means that relate to an essential element of the invention for use of the invention to others than the persons who are entitled to use the invention, if the third party knows or if it is apparent because of the circumstances, that these means are suitable and intended to be used for the use of the invention.

(4) Para (3) shall not apply if these means are products which are generally commercially available, unless the third party consciously prompts the supplied party to act in a way forbidden according to para (1).

(5) Persons who do not industrially conduct the actions mentioned in para (1) shall not be regarded as persons who are entitled to use the invention under para (3).

**Sec. 22a.** (1) The scope of protection of the published patent application and of the patent shall be determined by the claims. Nevertheless, the description and the drawings shall be used to interpret the claims. In doing so, the Protocol on the Interpretation of Article 69 of the European Patent Convention shall be applied *mutatis mutandis*.

(2) For the period up to grant of the patent the scope of protection of the application shall be determined by the claims last filed, which are part of the publication according to Sec. 101. However, the patent as granted or as amended in opposition or revocation proceedings shall determine retroactively the scope of protection of the application, in so far the scope of protection is not extended.

**Sec. 22b.** (1) The protection conferred by a patent on a biological material possessing specific characteristics as a result of the invention shall include any biological material directly derived from that biological material through generative or vegetative multiplication in an identical or divergent form and possessing those same characteristics.

(2) The protection conferred by a patent on a process that enables a biological material to be produced possessing specific characteristics as a result of the invention shall include biological material directly obtained through that process and to any other biological material derived from the directly obtained biological material through generative or vegetative multiplication in an identical or divergent form and possessing those same characteristics.

(3) The protection conferred by a patent on a product containing or consisting of genetic information shall extend to any material, subject to Sec. 1, para 3, subpara 2 and 3, in which the product is incorporated and in which the genetic information is contained, and which performs its function.

**Sec. 22c.** (1) The protection referred to in Sec. 22b shall not extend to biological material obtained from the generative or vegetative multiplication of biological material, put on the market in the territory within the European Economic Area by the patentee or with his consent, if the generative or vegetative multiplication necessarily results from the application for which the biological material was marketed, provided that the material obtained is not subsequently used for other generative or vegetative multiplication.

(2) Notwithstanding Sec. 22b, the sale or other form of commercialisation of plant propagating material to a farmer by the patentee or with his consent for agricultural use implies authorisation for the farmer to use the product of his harvest for generative or vegetative multiplication by him on his own farm, wherein the extent and conditions of this exemption corresponds to those under Article 14 of Regulation (EC) No 2100/94.

(3) Notwithstanding Sec. 22b, the sale or any other form of commercialisation of breeding stock or other animal reproductive material to a farmer by the patentee or with his consent implies authorisation for the farmer to use the protected livestock for an agricultural purpose. This includes making the livestock or other animal reproductive material available for the purposes of pursuing his agricultural activity, but not the sale within the framework or for the purpose of a com-

mercial stock-breeding. For said authorisation an appropriate compensation shall be paid.

(4) Sec. 22b does not apply for biological material, which was obtained accidentally or technically not avoidable in the agricultural sector. Therefore, a farmer cannot be claimed against if he did not cultivate seed or seed stock protected by a patent.

**Sec. 23.** (1) The patent shall not enter into effect against a person who, already at the time of filing of the application, used the invention in Austria or took measures necessary for such use (prior user) in good faith.

(2) The prior user shall be entitled to exploit the invention for the requirements of his own business in his own workshops or in other persons' workshops.

(3) This title may be inherited or sold only in combination with the business.

(4) The prior user may demand that his title be acknowledged by the patentee by issuing a certificate. If such acknowledgement is refused, the Patent Office, upon request, shall decide on the claim raised, in proceedings provided for a contestation action. Upon request by the person entitled, the acknowledged title shall be entered into the Patent Register.

**Sec. 24 and 25.** Cancelled (Fed. Law Gaz. No.1996/181)

**Sec. 26.** The effect of a patent shall not extend to vehicles and to arrangements at vehicles which have entered Austria only temporarily for their use for transportation purposes.

### Mutual Relationship of Co-Patentees

**Sec. 27.** (1) A patent applied for by several persons as partners in one and the same invention shall be granted to them without determining respective shares.

(2) The mutual legal position of the partners in a patent shall be governed by civil law.

(3) The right to allow third persons the use of the invention, in case of doubt, shall be subject only to the partners jointly; yet, any of them shall have the right to prosecute infringements of the patent before court.

### Duration of a Patent

**Sec. 28.** (1) The maximum duration of the patent shall be twenty years from the day of application.

(2) Patents of addition shall expire with the parent patent. A patent of addition may, however, be expressly maintained as an independent patent if the parent patent has been cancelled, withdrawn, declared invalid or renounced. In respect of the duration, the due date and the extent of the annuities, the patent of addition that has become independent shall take the place of the parent patent.

**Sec. 29.** Cancelled (Fed. Law Gaz. No.1996/181)

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

**Sec. 30.** A patent shall not release the patentee from the obligation to observe legal provisions.

**Sec. 31.** (1) The patentee may practise the invention on a commercial basis from the date of publication of the grant of the patent according to the scope of protection derived from the patent specification without being bound to the regulations directed to the acquisition of a trade license. The privilege shall cover the production, the placing on the market and the offering for sale, of the subject matter of the invention. If the subject matter of the invention is a method or process, the privilege shall also apply to the use of such method or process.

(2) In case of a plurality of patentees, this privilege shall apply only to those who hold at least a quarter of the patent.

(3) If the privilege is claimed by a person at a point of time at which not more than four persons are entitled to the patent, it shall be assumed that the person in question complies with the prerequisite of para (2) unless proved to the contrary. Sec. 27(2) shall not be affected thereby.

(4) If the patent is legally valid revoked, declared null and void or denied, the invention from that point of time may be practised on an industrial scale only by virtue of the trade licence required for the activity in question. The same shall apply for any industrial exploitation no longer covered by the scope of protection of a patent if the patent has been revoked, declared null and void or denied only in part. However, if the patent expires (Sec. 46) or is withdrawn (Sec. 47), the privilege under para (1) shall continue to apply if claimed prior to the expiration or withdrawal of the patent.

**Sec. 32.** (1) Whoever wishes to make use of the privilege under Sec. 31(1) shall notify the district

administrative authority under whose jurisdiction the privilege is to be used not later than on the day the working of the invention is started.

(2) The notification shall include the patentee's place of residence and nationality as well as the location where the invention is to be worked. The notification shall be accompanied by the patent specification and an excerpt from the register (Sec. 80(6)) that is not older than one month.

(3) The revocation, declaration of nullity or denial of a patent for an invention, notification of whose working has been given under para (1), shall be reported to the district administrative authority within one month from the entry into force of the relevant decision. If the patent is cancelled, declared null and void or denied only in part, a certified copy of the text of such decision shall also be submitted.

(4) Notification under para (3) shall be obligatory for any person who works the invention at the time of the events referred to in para (3).

(5) Persons who shut down a business carried out under claim of the privilege of Sec. 31 shall notify the competent district administrative authority accordingly within one month.

(6) Any person failing to submit the notifications under para (1), (3) or (5) in time shall be guilty of an administrative offence and shall be fined up to EUR 1.090,- by the district administrative authority.

### **Transfer**

**Sec. 33.** (1) The title derived from a patent application and the title derived from a patent shall be passed over to heirs; no reversionary right shall apply to these titles.

(2) Both titles may be assigned to others, either wholly or in imaginary shares, by legal transaction, court order or last will.

(3) If the title derived from a patent application is transferred, the patent, if granted, shall be granted to the legal successor of the applicant. The provisions under Sec. 43(5) to (7) shall apply accordingly.

### **Mortgages**

**Sec. 34.** The title to a patent may be the subject of a mortgage.

### **Voluntary Licences**



**Sec. 35.** The patentee shall be entitled to allow third parties to use the invention for the whole scope of validity of the patent or for part of the same with or without the exclusion of other persons entitled to use the invention (license).

### Compulsory Licences

**Sec. 36.** (1) If a patented invention cannot be exploited without infringing on an invention patented with a better priority (earlier patent), the owner of the later patent shall have claim to a non-exclusive license in the earlier patent, if the invention protected by the later patent constitute an important technical advance of substantial economic significance relative to the invention protected by the earlier patent. Where such license is granted, also the owner of the earlier patent shall have claim to a non-exclusive license in the later patent.

(2) If a plant breeder cannot acquire or exploit a plant variety right without infringing an invention patented with a better priority (earlier patent), he shall have claim to a non-exclusive license in said patent, as far as the plant variety constitutes significant technical progress of considerable economic interest compared with the invention claimed in the patent and as far as said licence is required for the exploitation of the plant variety to be protected.

(3) If a non-exclusive license for a plant variety protected by a plant variety right granted with a better priority (earlier plant variety right) is granted to the owner of a patent for a biotechnological invention, because he can not exploit the biotechnological invention without infringing an earlier plant variety right, the owner of the earlier plant variety right shall have a claim to a non-exclusive license for the younger patent for the exploitation of the patented invention.

(4) If a patented invention is not worked to an adequate extent in Austria, in which context importation also constitutes working, and the patentee has not undertaken everything necessary for such working, anybody has a claim for his business to a non-exclusive license for the patent unless the patentee proves that the working of the invention in Austria cannot reasonably be expected at all or on a larger scale than actually effected, due to the difficulties opposing such working.

(5) If the grant of a license for a patented invention is in the public interest, anybody shall have a claim for his business to a non-exclusive license for the invention. The claim of the federal admin-

istrative authority on this matter, however, is not bound to any business.

**Sec. 37.** (1) If the person entitled to grant a license according to Sec. 36 refuses grant of the same, although the applicant for the license has taken efforts to obtain his consent within a reasonable term and at reasonable conditions common in business, the Patent Office shall, on request of the applicant for the license, decide in proceedings prescribed for the contestation of patents. In case a license is granted, an adequate compensation is to be determined, wherein the economic value of the license is to be taken into consideration. The security, if necessary, as well as the other conditions of use shall be determined considering the nature of the invention and the circumstances of the respective case. The extent and the duration of the license according to Sec. 36 shall granted primarily for the supply of the market in Austria and shall have to be limited to the purpose which has made them necessary. As far as a semiconductor technology is concerned, the license can only be granted for the public, but not for commercial use or to remedy an unfair competition practise assessed in the course of legal or administrative proceedings.

(2) The grant of a license according to Sec. 36 para (4) may not be requested until four years from the filing of an application or three years from the notification of the grant of a patent for which the license is sought; whichever period expires last.

(3) The requirement of obtaining the consent of the person entitled to grant a license may be disregarded in the case of Sec. 36 para (5), if a state of national emergency or other circumstances of the uppermost urgency prevail. In this case, a preliminary permission to use the invention shall be given by interim decision.

(4) A granted license according to para (1) has to be rescinded upon request subject to a reasonable protection of the legitimate interests of the persons entitled, if the conditions which have led to the same cease to exist and are likely not to arise again. The Patent Office decides on such a request in the proceedings prescribed for the contestation of patents.

(5) In proceedings concerning the grant or the rescission of licences according to Sec. 36 para (2) and (3) a technically qualified member has to belong to every Senate of the Nullity Department and a technically qualified member and a legally qualified member to every Senate of the Supreme Patent and Trademark Senate, who are nominated according to Sec. 20 para (3) of the Act on the Protection of Plant Varieties 2001,

Fed. Law Gaz. No. 109, upon proposal of the Federal Minister of Agriculture, Forestry, Environment and Water Management in consent with the Federal Minister for Transport, Innovation and Technology.

### Assignment of a Licence

**Sec. 38.** Licenses according to Sec. 35 and 36 para (2) to (5) as well as for a younger patent according to Sec. 36 para (1) can be assigned only between living persons without the consent of the patentee in conjunction with the portion of the enterprise or the business entitled to the license and, because of death, shall pass over to the legal successors only if the latter carry on the part of the enterprise or business entitled to the license. A license granted in the earlier patent under Sec. 36 para (1) cannot be assigned except together with the assignment of the later patent.

**Sec. 39-42.** Cancelled (Fed. Law Gaz. No.1996/181)

### Entry into the Patent Register

**Sec. 43.** (1) The patent right (Sec. 33), the mortgage right and all the other material rights derived from patent rights shall be acquired and shall become effective against third parties with the entry into the Patent Register.

(2) The date of acquisition of license rights shall be governed by the provisions of civil law. The license rights shall become effective against third parties only with the entry into the Patent Register.

(3) The rank of the above-mentioned rights shall be determined by the order in which petitions for entry have been lodged with the Patent Office provided that such petitions lead to an entry.

(4) Simultaneously received applications shall enjoy equal rank.

(5) The entries into the Patent Register under para (1) and (2) as well as the entry of expiration of the titles to patent rights entered in the Patent Register shall be made by a written request of one of the parties concerned or by a judicial request.

(6) The request for entry shall be accompanied by the document on grounds of which the entry is to be made, either in the original or in a duly certified copy. If the document is not a public docu-

ment, it shall be provided with the duly certified signature of the person using his right.

(7) The request for entry and the pertaining document shall be subject to examination by the Patent Office as to form and contents.

### Encumbrances

**Sec. 44.** Any person acquiring a patent shall assume the encumbrances involved which are apparent at the Patent Office from the patent register or have been duly applied for entry at the time the request for entry is submitted.

### Notes of Dispute

**Sec. 45.** (1) Dispute proceedings pending before the court in respect of the ownership of patents, of mortgage rights or other material rights in patents as well as proceedings relating to the naming as inventor (Sec. 20(5) and (6)), the existence of a right to prior use (Sec. 23) and the concession of compulsory licenses (Sec. 36), in respect of opposition (Sec. 102), furthermore in the matter of revocation (Sec. 47), nullification (Sec. 48), abrogation (Sec. 49) and declaration of dependence (Sec. 50) shall be recorded in the Patent Register upon request (note of dispute).

(2) The note of dispute shall have the effect that the decision be fully effective also against those persons who have effected entries in the Patent Register only after the request for a note of dispute has been received by the Patent Office.

### Expiration

**Sec. 46.** (1) A patent shall expire

1. when having reached the maximum duration at the latest, provided the annuities have been paid in time;
2. if the annuity due has not been paid in time;
3. if the patentee renounces his patent.

(2) If only individual parts of the patent are renounced, the patent shall remain valid with respect to the remaining parts, provided that the latter are still able to constitute the subject matter of a patent of its own.

(3) Expiration shall be effective as of the day following the completion of the maximum duration in case of para (1) subpara 1, the day following the end of the last year of validity in case of para (1) subpara 2, and the day following the notifica-

tion of renunciation to the Patent Office in case of para (1) subpara 3.

### Revocation

**Sec. 47.** (1) A patent may be revoked in whole or in part if the grant of compulsory licenses (Sec. 36 para (4)) has not sufficed to safeguard the working of the invention in Austria to a reasonable extent. Revocation shall come into effect with the entry into force of the decision.

(2) Revocation may not be pronounced until two years from the valid grant of a compulsory license. It shall be excluded if the patentee proves that, due to the difficulties faced with in working the invention, he cannot reasonably be expected to work or to have the invention worked in Austria at all or to a greater extent than effected so far.

(3) Cancelled (Fed. Law Gaz. No.181/1996)

### Declaration of Nullity

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

1. the subject matter of the patent does not comply to Sec. (1) to (3),
2. the patent does not disclose the invention in a manner clearly and completely enough to be carried out by a person skilled in the art,
3. the subject matter goes beyond the contents of the application in its originally filed version determining the day of filing,
4. the biological material deposited under Sec. 87a para (2) subpara 1 has not been constantly available at either the original place of deposit as defined by the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedures of April 28, 1977, Fed. Law Gaz. No. 104/1984 (Budapest Treaty) or at any other place of deposit to which it had been transferred under this Treaty, unless the patentee proves that
  - a) he has re-deposited the biological material and the deposit shall be treated pursuant to Art. 4 of this Treaty as if effected on the day of the original deposit, or
  - b) he was prevented from such re-deposit by an unforeseen or unavoidable event and that he made such deposit within two months after the impediment had ceased to exist.

(2) If the reasons of nullity apply only partially, the nullity shall be declared by restricting the patent accordingly.

(3) The valid declaration of nullity shall be retroactive to the day of filing in case of para (1) subpara 1 to 3, to the day on which the place of deposit found out for the first time that it was unable to furnish samples of the biological material in case of para (1) subpara 4. If the subject matter of the patent under Sec. 3(2) was not patentable, however, the license rights rightfully granted by the later applicant and fairly acquired by third parties, registered in the Patent Register for one year and not affected by any legally founded note of dispute (Sec. 45) shall be without such retroactive effect without prejudice to any claims for compensation arising therefrom against the later applicant.

### Declaration of Disentitlement

**Sec. 49.** (1) The patentee shall be deprived of a patent if it has been proved

1. that the patentee was not entitled to the grant of the patent (Sec. 4(1), Sec. 6 and 7);
2. that the substantial contents of his application had been taken from the descriptions, drawings, models, implements or arrangements of a third person or from a method or process applied by said third person without his consent.

(2) If one of these prerequisites (para (1) subpara 1 and 2) applies only partially, the patentee shall be deprived of his patent only partially.

(3) The claim to disentitlement of the patent in the first case shall only be with the person who is entitled to the grant of the patent and in the second case shall only be with the person affected and shall become invalid by limitation against the bona fide patentee within three years from the date of his entry in the Patent Register.

(4) The mutual claims for compensation and restitution arising from disentitlement shall be judged under civil law and shall be raised according to civil law procedure.

(5) Instead of the disentitlement the assignment of the patent can be requested. If the claim to assignment exists only regarding a part, the patent shall be assigned in part. If no assignment is requested and the patent is disentitled wholly, the patent protection ends with legal effect of the decision declaring the disentitlement. If the assignment of the patent is requested, until the legal effect of the decision the patentee can renounce the patent only upon approval of the requesting party.

(6) The license rights rightfully granted by the earlier patentee, acquired in good faith by third persons and entered in the Patent Register for one year shall remain valid also in respect of the new patentee in case of such patent assignment unless affected by any legally founded note of dispute (Sec. 45), without prejudice to any claims for compensation against the earlier patentee arising therefrom.

(7) The request for disentanglement or assignment can also already be made before the grant of the patent in reference to the patent application, wherein para (1) to (5) shall apply mutatis mutandis. The request shall be dealt with in accordance with the procedural provisions governing the disentanglement of a patent. If the assignment of the patent application is requested, the application proceeding shall be suspended until the legal valid decision on the request and can only be continued with approval of the requesting party.

#### Declaration of Dependence

**Sec. 50.** The owner of a patent having an earlier priority or of a utility model having an earlier priority as defined by the Utility Model Act may request the Patent Office for a decision that the commercial use of a patented invention requires the complete or partial exploitation of his invention. The Patent Office shall decide upon such request in contestation proceedings.

#### Right of Retaliation

**Sec. 51.** A right of retaliation may be enforced by decree by the Federal Government against nationals of a foreign state that does not grant any protection or incomplete protection to inventions of Austrian citizens.

#### Terms

**Sec. 52.** (1) If the duration of a term is not prescribed by a law or by a decree, the authority shall fix the same considering the requirements and the nature of each individual case unless the President of the Patent Office has set out provisions on the extent of terms (Sec. 99(6), third sentence).

(2) The terms set by a law or by a decree shall not be extendable unless expressly stated to the contrary. The terms set by the authority may be extended.

**Sec. 53.** (1) The running of a term shall start with the event determined by the law or decree and

according to which the beginning of the term is to be fixed, or, unless otherwise stipulated, when setting the term, with the delivery to the respective party of the decision or decree fixing the term or, if the decision or the decree has not been delivered, but announced, with such announcement.

(2) When calculating a term fixed by days, the day shall not be taken into account on which the event, the delivery or the announcement, on which the beginning of the term is to be based, takes place.

(3) Terms expressed in weeks, months or years shall end with the expiration of the day of the last week or of the last month which in name or number corresponds to the day on which the term began to run. If there is not such a day in the last month, the term shall end with the expiration of the last day of such month.

**Sec. 54.** (1) The beginning and the running of a term shall be unaffected by Sundays and holidays.

(2) If the end of a term falls on a Sunday or holiday or on a working day on which the filing counter of the Patent Office is closed, the following working day shall be regarded as the last day of the term.

(3) With submissions posted in Austria, the days of mail conveyance shall not be taken into consideration when setting the term. This shall not apply to those cases in which the day of receipt of a submission at the Patent Office is the relevant day (Sec. 102(1) and Sec. 129(3)).

**Sec. 55.** If the terms allocated to several persons involved in one and the same matter for doing one and the same act expire at different dates, such act may be done by any of these persons as long as the term for doing such act is still open to one of them.

**Sec. 56.** If a submission comprises several industrial property rights (patents, trademarks, designs) or applications for such rights, the lodging of separate submissions for each or any of these rights (applications) may be requested upon setting of a term therefor. The separate submissions presented in time shall be regarded as presented on the day of receipt of the original submission. Sec. 163(4) shall remain unaffected.

## II. PATENT AUTHORITIES AND PATENT INSTITUTIONS

### Sphere of Activity of the Patent Office

**Sec. 57.** (1) The Patent Office shall be responsible for the grant of patents, the recall, the, revocation, nullification, disentanglement, declaration of dependence, for decisions on the naming as inventor (Sec. 20), on the existence of a right of prior user (Sec. 23), on the grant of licenses (Sec. 36), on petitions for declaratory decisions (Sec. 163) as well as for services and information work in the field of industrial property (Sec. 57a, 57b) and for all entries in the Patent Register.

(2) In the interest of international cooperation in the field of industrial property, it may be agreed upon that the Patent Office shall provide to states or international governmental or non-governmental organisations dealing with matters in that field technical or legal assistance free of charge or at reasonable costs. Services free of charge shall be agreed upon only if the assistance provided is in the public interest, is given for purposes of development aid or incurs only insignificant costs.

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

**Sec. 57a.** Upon request, the Patent Office shall provide in writing

1. searches on the prior art relating to a concrete technological problem, and
2. expert opinions, whether an invention is patentable under Sec. 1 to 3 in view of the prior art made known by the applicant or to be searched for by the Patent Office.

**Sec. 57b.** The Patent Office shall extend its services and information work, developing, in particular, its documentation for the purpose of an easier accessibility and providing better information to the public in all pertinent fields.

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

**Sec. 58.** (1) The Patent Office is a federal authority and shall have its seat in Vienna. It is the Austrian Central Authority for the protection of industrial property. The activities of the Patent Office shall be consistent with its obligations to objectivity and non-discrimination which result from its public position as a federal authority.

(2) The Patent Office shall be comprised of a President, a Vice President, responsible for the legal field and a Vice President, responsible for the technical field, as well as the legally and

technically qualified members necessary for fulfilment of its responsibilities, and other employees.

(3) The management of the Patent Office shall reside with the President irrespective of the field responsibility of the Vice Presidents; furthermore he is head (manager) of the field of partial legal capacity (Sec. 58a and 58b).

(4) The legally qualified members shall have completed the university degree in law. The technically qualified members shall have completed an university degree of a subject in the field of technology or natural science. For the appointment of the members the pertinent regulations of employment law apply.

(5) The Vice Presidents shall have the formal qualifications prescribed for members of the Patent Office (the technical Vice President those of the technically qualified member, the legally qualified Vice President those of the legally qualified member), or equivalent knowledge.

**Sec. 58a.** (1) The Patent Office shall enjoy legal status (partial legal capacity) to the extent that it is entitled to acquire property and rights by the following service and information works in the field of the protection of industrial property:

1. written information and information by electronic data carriers and media on data concerning applied for or registered industrial property rights,
2. statistic interpretation of data in the field of industrial property,
3. reporting on searches on prior art and on expertises concerning the patentability of inventions to persons, enterprises, states or international governmental or non-governmental organisations dealing with matters in the field of industrial property,
4. reporting on searches on protection rights and on consulting services in connection with patent evaluations, using approved evaluation standards,
5. written information and information by electronic data carriers and media within the scope of trademark application proceedings as well as on the basis of separate requests as to whether a particular sign is identical or might possibly be regarded as resembling to an applied for or registered mark ("resemblance searches"),
6. translations of lists of goods and services in respect of international registration of marks,
7. classification of pictures being parts of marks for national or international governmental or non-governmental organisations working in the field of industrial property,



8. distribution of information work and information services in the fields of industrial property,
9. production, editing, distribution and procurement of printed documents, software and recorded sound, picture and data carriers as well as
10. exhibitions, seminars and similar events.

(2) The President of the Patent Office shall determine more precisely by decree and upon approval by the Federal Minister for Transport, Innovation and Technology, the services and information work as defined in para (1) within its partial legal capacity and the conditions under which they are provided. In this connection care shall be taken that the individual services and information work are suitable to be furnished within the partial legal capacity and that secrecy interests which are worthy of protection will not be violated.

(3) Within its partial legal capacity, the Patent Office shall also be authorised

1. to confer activities under para (2), accounting and all other property, personnel and inventory administration under its partial legal capacity as well as any auxiliary activities under the Patent Office administration to third parties, in particular also to administrative bodies of the Federation, against reimbursement of any expenses under its partial legal capacity,
2. to make legal transactions related to activities under subpara 1, and
3. upon approval of the Federal Minister for Transport, Innovation and Technology, to acquire membership with associations, other legal entities or international organisations if in the interest of promoting legal protection of industrial property.

(4) The Patent Office shall be authorised to cover its expenses necessary for performing its tasks including investments from the property and rights acquired under its partial legal capacity. Receipts in excess of this (profits) shall be paid to the Federation after forming an adequate reserve. The Federation shall not be liable for liabilities arising from the Patent Office's activities in its partial legal capacity.

**Sec. 58b.** (1) To the extent that the Patent Office becomes active under Sec. 58a, it shall see to following a policy in accordance with the principles of an ordinary businessman. The annual balance of accounts shall be submitted to the Federal Minister for Transport, Innovation and Technology as well as to the Federal Minister of Finance. The Federal Minister for Transport, Innovation and Technology, in addition, shall be al-

lowed to inspect the documents of conduct at any time.

(2) The Federal Minister for Transport, Innovation and Technology shall be authorised to examine the policy arising from its partial legal capacity for compliance with existing legal provisions and numerical correctness.

(3) As regards employment contracts or contracts for work and labour which are concluded pursuant to para (1), the respective law shall apply depending on the kind of actions. There shall be no employment with the Federation.

(4) The provisions relating to the carrying on of trades shall not apply to the activities of the Patent Office under Sec. 58a.

(5) Within its partial legal capacity, the Patent Office shall be represented by the managing director. The latter can authorise other empowered persons to conclude legal transactions within the partial legal capacity. In this regard, the Patent Office shall use a name indicating its own legal status. Concerning the supply of services and information work as defined in Sec. 58, para (1) and particularly the respective commercial communication, any indication of an official function shall be avoided. With regard to such supply of services and information work the purchaser shall be informed before signing a contract that such services shall be supplied within the partial legal capacity on a civil law basis and without an official character including the legal consequences resulting from Sec.58a, para (4).

(6) Provided that the partial legal capacity uses general terms and conditions for its supply of services, these shall be subject to the approval of the Federal Minister for Transport, Innovation and Technology in agreement with the Federal Minister for Economy, Family and Youth.

**Sec. 59.** Cancelled (Fed. Law Gaz. No. I 2004/149)

### Divisions of the Patent Office

**Sec. 60.** (1) The Patent Office shall comprise the departments, provided for fulfilling its tasks, and the necessary further organizational units.

(2) The number of the departments and organisational units, their field of activity and their personnel resources shall be determined by the President according to current demands.

(3) Irrespective of the duties and responsibilities conferred on these departments and organisa-

tional units by other legal provisions, the competences are as follows:

1. the Technical Department for the procedure regarding the grant of patents, the opposition proceedings, the proceedings regarding the abandonment and the furnishing written searches and substantial opinions;
2. the Legal Department for the procedure regarding matters related to the assignment of the right of an application, to other legal dispositions relating to such a right, to granted patents or to requests for reinstatement in the state quo ante, to the extent this does not fall under the competence of the Technical Department or the Appeal or the Nullity Department;
3. the Appeal Department for the appeal proceedings (Sec. 70);
4. the Nullity Department for the proceedings related to requests for revocation, the declaration of nullity, disentanglement, the declaration of dependence, the naming as inventor under Sec. 20 (5), the acknowledgement of the right of prior use, requests for declaratory decisions and to requests for the grant of compulsory licenses;

**Sec. 61.** (1) The President shall divide the entire field of technology into patent classes and, if necessary, further subdivide the latter; he shall allocate the individual patent classes or subdivisions to the Technical Departments according to the respective requirements.

(2) To the Technical Departments technically qualified members, to the Legal Departments legally qualified members, shall be appointed. To the Appeal Department and to the Nullity Department legally qualified and technically qualified members shall be appointed. The members of the Technical Departments and of the Legal Departments, at the same time, may also be appointed to the Appeal Department and the Nullity Department.

(3) The President shall determine among the members of the Legal Department and the Nullity Department the number required of chairmen and among the members of the remaining Departments a board for supervising and for controlling business as well as make dispositions as to their representation.

(4) Each Technical Department shall be assigned a legally qualified member for participation in collegial decisions or for giving opinions (Sec. 62 (4)). The same legally qualified member may be assigned to several Technical Departments.

(5) The distribution of work in the Technical Departments and in the Legal Departments shall be

determined by the head of the respective department.

(6) In the Appeal Department and the Nullity Department, the individual cases shall be assigned to the chairmen by the President. In doing so, the load of work and, with technically qualified chairmen, also the technical field concerned in each individual case shall be taken into account.

### Decision Making in the Departments

**Sec. 62.** (1) Decisions and dispositions within the sphere of activity of the Technical Department shall reside with the technically qualified member (examiner) competent according to the distribution of work unless otherwise provided under Sec. 3 and 4.

(2) For the decision as well as for all dispositions in matters of patent protection falling within the scope of activity of the Legal Department that member shall be competent which is assigned to the Technical Department (Sec. 61(4)) to whose patent classes or subdivisions the respective patent or the respective application belongs (Sec. 61(1)). If several patents (patent applications) are affected by such matters, that member shall be competent which, pursuant to Sec. 61(5), is competent for the patent or patent application listed first in the respective petition.

(3) Decisions on the complete or partial rejection of an application according to Sec. 100(1) and on the opposition shall be made by three members of the Technical Department, two of which must be technically qualified members. The head of the department and the examiner shall be members of the Senate. The head of the department shall have the chair.

(4) The legally qualified member assigned to the Technical Department shall participate in the making of decisions under para (3) with the right to vote, or the examiner, if decision making resides solely with him (para (1)), shall first seek the opinion of the legally qualified member where

1. patentability is to be decided upon with a view to the industrial applicability or on grounds of para (2),
2. priority rights (Sec. 93 to 95) are to be decided upon whose legal prerequisites are doubtful or contested,
3. witnesses or experts are heard or an inspection has to be made,
4. an administrative penalty or a penalty for a wanton act is to be decided upon.

(5) If, at a meeting of the Technical Department consisting of three technically qualified members,

the majority takes the view that a decision is to be made also on one of the questions raised under para (4), the legally qualified member assigned to the Technical Department shall participate in decision making in the place of a technically qualified member.

(6) To the extent that the composition of the Senate is not determined by para (3) to (5), it shall reside with the head of the Technical Department. In doing so, the technical field concerned shall be taken into consideration in each particular case.

(7) Prior to deciding upon matters falling under the competence of the Legal Department (Sec. 60(3) lit. 2) and in which technological questions may be of importance, the legally qualified member shall seek the opinion of the competent technically qualified member.

**Sec. 62a.** (1) By decree of the President employees who are not members of the Patent Office can be authorised to deal with issues to be clearly specified in their kind concerning application and granted patents, as far as this is appropriate due to the simplicity of the execution, and the training of the authorised employees offers a guarantee for proper execution. They are bound by the instructions of the member responsible according to the distribution of work. The latter can reserve or draw executions to himself at any time.

(2) The decisions of the employees authorised according to para (1) can be contested like the ones of the competent member.

**Sec. 63.** (1) The Appeal Department and the Nullity Department shall make their final decisions in the following composition including the chairman:

1. the Appeal Department comprised of three technically qualified members and one legally qualified member unless where appeals against decisions of a legally qualified member are concerned; in the latter case, decisions shall be made by three members two of which must be legally qualified members;
2. the Nullity Department comprised of two legally qualified and three technically qualified members.

(2) The chairmen of the Appeal Department shall be legally qualified where appeals against decisions of a legally qualified member are to be decided upon.

(3) For interim decisions in the Appeal Department and the Nullity Department, the presence of three members shall suffice.

**Sec. 64.** (1) For decisions in the Senate the simple majority of votes shall suffice. In case of a tie, the chairman has the casting vote.

(2) Decisions made by the Patent Office shall be accompanied by a statement of reasons. Where a petition in an ex arte case before a Technical Department or the Legal Department is fully approved, the statement of reasons may be omitted. All settlements shall be in writing and shall be delivered ex officio or transmitted telegraphically, by telex or telefax to all persons concerned. In the way of automation-supported data transfer or in any other technical possible way written copies can be delivered, if

1. the party has lodged submissions permissibly in the same way and has not explicitly objected to this way of delivery to the authority, or
2. the party has expressly agreed to this way of delivery.

(3) The approval of a settlement shall be given by the signature of the approving person. However, it can be refrained therefrom, if it is secured that the person giving the approval may be ascertained in another way.

(4) The form and kind of actions as well as of communications and copies are regulated by decree of the President of the Patent Office.

(5) For communications that are written automation-supported or that are transmitted telegraphically, by telex or telefax, by way of automation-supported data transfer or in any other technical possible way a signature or a legalisation is not necessary.

**Sec. 65.** (1) Dispositions for preparing a decision of the Technical Department shall be made by the examiner. Except where it is merely a question of eliminating formal deficiencies from submissions or of correcting submitted specifications, a record shall always be made on the hearing of parties, witnesses or experts.

(2) A decision shall be made on grounds of a petition substantiated in writing. Amendments decided upon at a meeting shall be carried out in the draft of the petition. If the decision substantially deviates from the petition, the draft shall be redrafted upon approval of the member whose petition has become a decision.

(3) Each member of the Senate may change his opinion until closure of a meeting. If, as a result, the decision passed no longer enjoys the majority of votes, a new vote shall be taken.

(4) If there is no unanimity in the Senate on the award or the reasons of the decision, a record shall be drawn up, in which the opinions of the members of the Senate and the proportion of votes shall be indicated. Otherwise, an annotation on the votes to be signed by all of the members of the Senate will suffice.

**Sec. 66.** (1) The Senates of the Appeal Department and the Nullity Department shall be composed by the chairmen from case to case. In doing so, the load of work and, with the technically qualified members, also the technical field concerned in each individual case shall be taken into account.

### Official Robes

**Sec. 67.** (1) At all oral proceedings, the members of the Appeal and of the Nullity Departments shall wear official robes. Further details as to the nature and wearing of the official robes shall be regulated by decree of the President of the Patent Office.

(2) The party representatives referred to in Sec. 77 shall be authorised to wear their official robes if and when they intervene in oral proceedings of the Appeal Department and of the Nullity Department as well as of the Supreme Patent and Trademark Senate.

### Office Routine

**Sec. 68.** Office routine shall be regulated in detail by decree of the President of the Patent Office with a view to enabling regular and rapid operation and under consideration of the duties vested in the Patent Office. In doing so, it shall also be determined how applications may be directly lodged with the Patent Office and at what time they are regarded as received at the Patent Office. The applications shall be marked with the day of receipt.

**Sec. 69.** Against the decisions of the President, to which the latter is entitled under this Federal Act, a regular legal remedy shall be admitted only if expressly provided by this Federal Act. Sec. 2(2) of Dienstrechtsverfahrensgesetz 1984, Fed. Law Gaz. No. 29 shall not be affected.

### Appeals against Decisions and Resolutions of Departments

**Sec. 70.** (1) Decisions passed by the Technical Department and by the Legal Department may be contested by appeal.

(2) No appeal to the Administrative Court shall be lodged against the decisions (interim and final

decisions) of the Appeal Department. Against decisions of the Appeal Department appeal can be lodged to the Supreme Patent and Trademark Senate.

(3) Final decisions of the Nullity Department may form the object of an appeal to the Supreme Patent and Trademark Senate as the highest authority.

(4) No separate appeal shall be lodged against a decree passed by a rapporteur in preparation of a decision of a Technical Department or Legal Department or of a decision of the Appeal Department or Nullity Department.

(5) Likewise, no separate appeal shall be lodged against an interim decision of the Nullity Department with the exception of interruption decisions, yet amendment of the preparatory decrees of the rapporteur (para 4) and of interim decisions of the Appeal Department or of the Nullity Department may be applied for at the respective departments.

### Appeals against Decisions of the Technical Department and the Legal Department

**Sec. 71.** (1) The appeal shall include a substantiated petition for appeal and shall be lodged with the Patent Office within two months after delivery of the decision.

(2) If appeal proceedings are to be carried out with an opposing party, for each opposing party one further copy of the appeal brief and enclosures shall be added to the copy intended for the Patent Office.

(3) Belated appeals shall be rejected by the Department which is competent in first instance. Belated appeals against decisions of the authorised employee shall be rejected by the competent member. Inadmissible appeals as well as appeals not complying with other legal requirements shall be rejected by the Appeal Department without any further proceedings; yet, an appeal may be rejected for formal defects only after the appellant, upon request, has failed to remedy the defects.

(4) The Department of first instance, that has passed the decision, can deal with the appeal within two month after its timely receipt by preliminary decision on the appeal. It can reject the appeal as inadmissible, rescind the decision it has passed or alter it in any direction. If the decision was passed by an authorised employee, the competent member is competent for the preliminary decision on the appeal.



(5) Each party can file the petition to the Department of first instance within two weeks after the receipt of the preliminary decision on the appeal, that the appeal is submitted to the Appeal Department for decision (request for submission). In the preliminary decision on the appeal the possibility of such a request for submission has to be pointed out. With receipt of the request for submission the preliminary decision on the appeal shall become invalid. The Department of first instance has to notify the parties of the invalidation of the preliminary decision on the appeal. Belated or inadmissible requests for submission shall be rejected.

(6) The presentation of new facts and evidence in the appeal proceedings shall be admissible only in support or disproof of the facts and evidences submitted in time in the first instance; this shall not preclude restriction or clarification of the claims. The parties shall be given the opportunity of commenting upon the new facts presented as well as upon the result of possible new procedure of taking evidence.

**Sec. 72.** (1) In case of appeals against decisions of the Technical Department, the chairman shall appoint as rapporteur, among the voting members, a technically qualified member or, unless he himself is legally qualified, the legally qualified member depending on whether mainly technical or legal questions are of importance to the decision. In case of appeals against decisions of the Legal Department, the chairman shall appoint a legally qualified member as rapporteur.

(2) The rapporteur shall deliver one copy of the appeal brief and enclosures to the opposing party, requesting the same to submit their objections within a term of at least two months, which term he shall extend on reasonable grounds. The rapporteur, furthermore, shall pass any decree necessary for a decision or for oral proceedings, in particular, because of the possibly required further correspondence and the adoption of the evidence offered by the parties.

(3) After having carried out the preliminary proceedings, the rapporteur shall submit to the chairman the files including a written statement of all questions of fact and legal questions of relevance to the decision and comments on the same (report). The chairman may ask the rapporteur or any other voting member to supplement this report.

**Sec. 73.** (1) The chairman may call oral proceedings on the appeal. Upon request of the appellant or of the opposing party possibly involved in the proceedings oral proceedings shall be called. The proceedings shall be in public. Sec. 119(2) shall apply.

(2) The chairman shall open the hearing and shall convince himself of the identities of the persons appearing and verify their positions relative to the parties concerned and any possibly powers of attorney. He shall conduct the hearing without permitting digression or lengthiness in a manner so as to guarantee the parties' right to be heard.

(3) The chairman shall determine the order in which the parties are to be heard, the evidence is to be taken and the results of previously taken evidence or investigations are to be presented and discussed. The chairman or members of the Senate appointed by him shall discuss the matter with the parties as to facts and law.

(4) A record of the oral proceedings shall be taken by a clerk. Besides information on place, time and subject matter of the proceedings it shall include the names of the members of the Senate, of the clerk, of the parties, of their representatives, of the witnesses heard and of the experts, as well as a summary report on the contents and procedure of the proceedings. The record shall be signed by the chairman and the clerk. Instead of appointing a clerk, the chairman can make use of a sound storage medium, wherein the information mentioned in sentence 2 shall be included in the record in any case. From the recording on the sound storage medium a written transcription shall be made. This record shall be signed by the chairman only.

(5) The Appeal Department, as a rule, shall reach its own decision, freely appreciating the facts and evidence submitted. It shall be authorised to substitute its opinion for that of the Technical Department or the Legal Department both with regard to the decision and with regard to the reasons and to amend the contested decision accordingly in either direction.

(6) Consultation and voting of the Appeal Department shall be effected in camera. Sec. 65(3) and (4) shall apply mutatis mutandis. Discontinuation may be decided upon in writing by circular unless a member contradicts.

(7) The rapporteur shall draft a decision on grounds of the resolutions adopted. If he is in the minority with his view, he shall make a redraft in agreement with that member whose request has been made a resolution. The chairman shall, however, be free to charge another member of the Senate with the preparation of the draft or parts thereof.

(8) The Fee Entitlement Act 1975, Fed. Law Gaz. No. 136 shall be applied.



(9) In the appeal proceedings the parties have to bear the costs of the proceedings themselves.

### Supreme Patent and Trademark Senate

**Sec. 74.** (1) The Supreme Patent and Trademark Senate is authority of appeal against the final decisions of the Nullity Department of the Patent Office and the authority of appeal against the final decisions of the Appeal Department of the Patent Office. It consists of the President, the Vice President, at least eight further legally qualified members and of the required number of technically qualified members as counsellors. These bear the title "Councillor of the Supreme Patent and Trademark Senate" during their term of office.

(2) The President and the Vice President shall be, or shall have been, members of the Supreme Court as the President, Vice President or as the Chairman of the Senate.

(3) The legally qualified members shall have completed university studies in law and shall have held a profession for which completion of these studies is required, for at least ten years. Moreover, they shall proof scientific or practical activity in the field of legal protection of industrial property. At least three members shall be judges, at least three members shall be legally qualified federal civil servants of the Federal Ministry of Transport, Innovation and Technology or legally qualified members of the Patent Office.

(4) The technically qualified members shall have completed university studies with a subject in the field of technology or natural sciences and shall have special knowledge in a particular field of technology and shall have reached the age of thirty.

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

(6) The members of the Supreme Patent and Trademark Senate shall be appointed by the Federal President for five years; they may be reappointed. The appointment shall in no case prevent any member from voluntarily resigning from this authority upon entry into permanent retirement.

(7) The term of office shall end on the 31st of December of that year in which a member has reached the age of seventy. The term of office shall also end if and when a member has lost his Austrian citizenship, if and when his legal capacity is restricted or if and when he has been condemned to more than one year of imprisonment

because of a deliberately committed punishable act or has been finally convicted because of a punishable act committed with the intent of enrichment.

(8) Members who do not have civil service status shall make the following pledge to the President prior to exercising their duties: "I pledge to perform my duties conscientiously and impartially and to keep secret anything I get knowledge of in fulfilling my duties." The pledge shall be signed. In case of reappointment, a reminder of the pledge shall be sufficient.

(9) In fulfilling their duties, the members shall be independent and shall not be bound to any instructions. The decisions of the Supreme Patent and Trademark Senate shall not be subject to annulment or amendment by administrative procedures. The Federal Minister for Transport, Innovation and Technology shall have the right to obtain information on all subjects of the management of the Supreme Patent and Trademark Senate.

(10) The clerks shall be appointed by the Federal Minister of Transport, Innovation and Technology from among federal civil servants of higher service of this Federal Ministry or of the Patent Office.

(11) The President of the Supreme Patent and Trademark Senate, as head of this authority, shall be entitled to an annual functional fee of 300%, the Vice President of 150%, of the monthly salary of an active federal civil servant of salary level 1 of service class IX of the General Administration.

(12) All other members and the clerks shall receive functional fees in accordance with their respective duty:

a) rapporteurs (co-rapporteurs)	8 to 40%,
b) assessors .....	4 to 15%,
c) clerks .....	3 to 10%

of the monthly salary mentioned in para (11) for each individual case they participated in. For cases completed within a calendar year the functional fees shall be awarded by the Federal Minister for Transport, Innovation and Technology upon proposal by the President at the end of the calendar year with due regard to the time and work required in each individual case.

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

**Sec. 75.** (1) The Supreme Patent and Trademark Senate shall negotiate and decide under the

chair of the President or, in case the latter is unable to attend, of the Vice President, in Senates comprised of five members consisting of the chairman, two legally qualified and two technically qualified members. The Senates shall be set up by the chairman so as to include a legally qualified federal civil servant and at least one judge. The chairman shall appoint one member of the Senate as rapporteur. If necessary, the chairman shall appoint further members of the Senate as co-rapporteur.

(2) At all hearings, the members of the Supreme Patent and Trademark Senate shall wear official robes. Further details as to the nature and wearing of the official robes shall be regulated by decree of the President of the Patent Office.

### Reasons for Exclusion

**Sec. 76.** (1) Members of the Patent Office and of the Supreme Patent and Trademark Senate shall be excluded from participation:

1. in matters in which they are parties themselves or in consideration whereof they have a joint interest, joint liability or joint liability to recourse in respect of one of the parties;
2. in matters concerning their spouses or civil union partners or persons related to them in direct line or related to them by marriage or related to them in the collateral line up to the fourth degree or related by marriage up to the second degree;
3. in matters concerning their adopted or foster parents, adopted or foster children, their wards or persons under their care;
4. in matters in which they represent or have represented one of the parties or in respect of which they have had or may have a material advantage or loss;
5. in appeal proceedings in which the legal remedy is directed against a decision they have participated in;
6. if there are other important reasons suitable to raise doubts as to their full impartiality.

(2) Members of the Supreme Patent and Trademark Senate shall be excluded from participation in the Supreme Patent and Trademark Senate in proceedings in respect of appeals against decisions of the Appeal Department if they took part in the passing of a decision within the Technical Department or the Legal Department.

(3) A members of the Patent Office or of the Supreme Patent and Trademark Senate who considers himself excluded from participation in a decision (para (1) and (2)) shall notify the head of the department or the chairman immediately, stating the reasons therefor. The head of the de-

partment or the chairman, if considering the reasons for exclusion applicable, shall make the necessary arrangements for appointing a substitute member. If the reasons for exclusion apply to the head of the Department or the chairman himself, notification shall be made to the President of the Patent Office in proceedings before the Patent Office or to the President of the Supreme Patent and Trademark Senate in proceedings before this Senate. If one of these himself has the chair, his representative shall be notified.

(4) If, in proceedings before the Patent Office or before the Supreme Patent and Trademark Senate, a reason for exclusion is put forward by a party, para (3) shall be followed.

### Representatives of the Parties

**Sec. 77.** Only attorneys at law, patent attorneys and notaries public as well as the Finanzprokurator shall be authorised to professionally represent parties before the Patent Office and before the Supreme Patent and Trademark Senate.

### Prohibition of Unlicensed Representation

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

1. prepares written documents or drawings for use before domestic or foreign authorities,
2. gives information,
3. represents parties before domestic authorities, or
4. offers himself to perform any of the activities mentioned under subpara 1 to 3, without being authorised to professional representation of parties in such matters in Austria, shall be guilty of unlicensed representation and shall be fined up to EUR 4.360.-- by the district administrative authority.

(2) The representation of a legal entity by employees of an other legal entity, economically associated therewith, is not regarded as unlicensed representation. Other legal representatives with the exception of natural persons are equated with legal entities.

(3) The special provisions relating to the treatment of unauthorised representatives at the ordinary courts shall not be affected.

### Patent Gazette

**Sec. 79.** (1) A periodically appearing official Patent Gazette shall be issued by the Patent Office,

in which any publication provided by this Federal Act as well as any decrees to be passed by the President of the Patent Office shall be published. Unless expressly stated otherwise, these decrees shall enter into force on the day following the issue of the Patent Gazette containing the respective announcement.

(2) The arrangement and publication of this Gazette shall be regulated per decree by the President.

### Patent Register, Patent Specifications

**Sec. 80.** (1) A patent register shall be kept at the Patent Office. It shall specify the numbers, the title, filing date and, if any, the priority of the granted patents as well as the names and the place of abode or residence of the patentees and their representatives. The beginning, expiration, cancellation, revocation, declaration of nullity, disentanglement, declaration of dependence, the naming as inventor, the declaration of independence of a patent of addition, and the assignment of the patent, mortgages and other rights in rem in the patents, the licence rights, the right of use of the employer, the rights of prior user, restitutions in integrum, declaratory decisions and notes of dispute as well as indications under Sec. 156(2) shall also be entered in the Patent Register.

(2) The specifications and drawings pertaining to existing patents as well as all petitions and documents underlying any entries in the Patent Register shall be kept by the Patent Office during the maintained existence of the patent.

(3) Inspection into the Patent Register shall be open to anybody.

(4) The Patent Office shall publish specifications, claims, drawings and abstracts of the granted patents in separate printed documents (patent specifications) to the extent they are open to public inspection. The patent specification shall specify the references considered by the Patent Office in assessing the patentability of the invention for which an application has been filed.

(5) Upon request, public institutions may get free of charge one copy each of all Letters Patent issued from the date of receipt of the request provided these are made accessible to the public.

(6) Upon request, the Patent Office shall hand out certified copies of the entries in the Patent Register.

### Inspection of Files

**Sec. 81.** (1) Any person involved in a proceeding shall be entitled to inspection of the files related to the proceeding.

(2) Anybody may inspect the files that relate to published patent applications and to patents granted thereon.

(3) The inspection of files related to non-published patent applications shall be granted to third parties only on approval by the applicant. No approval need be given to a person vis a vis whom the applicant has cited his patent application. After publication of a separate application anybody may inspect the files of the earlier application not published at that time, without approval of the applicant.

(4) Access to files relating to the searches and expert opinions under Sec. 57a shall only be granted to third parties on approval of the requesting party. No approval need be given to a person vis a vis whom the requesting party has cited such search or such expert opinion.

(5) The right to inspection of files shall also comprise the right to make copies. These shall be certified by the Patent Office upon request.

(6) Anybody shall be given information and official confirmations as to when, under what title, by whom and, if any, by what representative an application has been filed, its file number, to which patent class it pertains, what priority has been claimed, the file number of the priority application, whether an independent patent or a patent of addition is sought, the naming of an inventor, if any, whether the application is still pending as well as whether and to whom the right of it has been assigned.

(7) Deliberation protocols and file portions relating to internal business only shall be excluded from inspection. In case of a trade or business secret or another reason worthy of being taken into consideration, parts of files laying open of which to public inspection is not necessary for an information of the public may also be excluded from inspection, upon request.

### Samples of Deposited Biological Material

**Sec. 81a.** (1) Before the date of publication of the application any person who has the right of inspection of files according to Sec. 81 para (3) shall be entitled to get a sample of a biological material deposited under Sec. 87a para (2) subpara 1. From the date of publication of the application any person who makes a respective

request has this right. The access is granted being subject to para (2) and (3) by handing out a sample of the deposited biological material to the requesting party or an independent expert.

(2) The handing out only takes place if the requesting party obliges itself for the duration of the effect of the patent or until the application is withdrawn or rejected,

1. not to make available to third parties a sample of the biological material deposited or a material derived therefrom and
2. not to use a sample of the deposited biological material or a material derived therefrom for anything else but experimental purposes unless the applicant or the patentee explicitly renounces such an obligation.

(3) Until the completion of the technical preparation for the publication of the application the applicant may request that the access designated in para (1) shall be granted only by handing out a sample to an independent expert

1. until the grant of the patent or
2. in case of a withdrawal or rejection of the application for the duration of twenty years beginning with the application date.

(4) As an expert as defined by para (3)

1. any natural person, as far as the requestor proves, that the appointment happens with approval of the applicant,
2. any natural person, who is acknowledged by the President of the Patent Office as expert and is registered in the expert register, which is maintained by the Patent Office

can be appointed. With the appointment a declaration of the expert shall be presented, in which he undertakes the obligations to the applicant under para (2).

#### **Administrative Penalties and Penalties for Wanton Acts**

**Sec. 82.** (1) The person presiding over a hearing, an examination, an inspection or the taking of evidence shall ensure that order be maintained and propriety be observed.

(2) Persons who disturb an official action or violate propriety by improper behaviour shall be reprimanded. If the reprimand remains without effect, they may be refused to speak upon previous warning, their removal and the appointment of a representative may be ordered or they may be fined up to EUR 726.-- .

(3) The same administrative penalties may be imposed on persons who use an insulting mode of writing in their written submissions.

(4) Measures under para (2) shall be vested with the person presiding over an official action. In proceedings before the Appeal Department or the Nullity Department of the Patent Office or before the Supreme Patent and Trademark Senate, the Senate shall decide on the removal of a person taking part in a hearing or on the imposition of an administrative penalty during a hearing. Administrative penalties under para (3) shall be imposed by the Senate in proceedings in which decisions are vested with the Senate.

(5) On public authorities and representatives authorised to act for parties on a professional basis who are subject to disciplinary regulations no administrative penalties shall be imposed but they may be reported to the disciplinary authority concerned.

(6) The imposition of an administrative penalty shall not exclude the institution of criminal proceedings for the same act.

**Sec. 83.** Persons who call upon the activity of the Patent Office or of the Supreme Patent and Trademark Senate apparently with malicious intent or make incorrect statements with the intention of delaying a case, may get a penalty for wanton acts of up to EUR 726.--. Penalties for wanton acts shall be imposed by the Senate in proceedings in which decisions are vested with the Senate.

**Sec. 84.** (1) Administrative penalties and penalties for wanton acts shall flow to the Federation. The provisions of the Law of Administrative Penalties 1991, Fed. Law Gaz. No. 52, shall apply mutatis mutandis to the execution of the penalties.

(2) Administrative penalties shall be imposed by the authority which conducts the disturbed official action or before which propriety is violated by improper behaviour or to which petitions are addressed (Sec. 82(3)). The power to impose penalties for wanton acts shall lie with the authority whose activity has been called upon with malicious intent or before which incorrect statements have been made with the intention of delaying a case.

(3) A decision of the Technical Department or of the Legal Department, by virtue of which an administrative penalty or a penalty for wanton acts have been imposed, and such a decision of the Nullity Department, shall be appealed in the next higher instance (Sec. 70). The legal remedy shall be lodged within two weeks and shall have no

delaying effect. No ordinary legal remedy shall be permitted against the decision of the appeal instance.

### Delivery

**Sec. 85.** The delivery of documents of the Patent Office and of the Supreme Patent and Trade-mark Senate shall be effected in accordance with the Delivery Act, Fed. Law Gaz. No. 200/1982, unless otherwise provided in Sec. 86.

**Sec. 86.** If an application is filed by several persons jointly, not all of whom do reside in Austria, in case of doubt the person residing in Austria who is named first shall be regarded as the person jointly authorised to accept delivery.

3. the place of deposit and the file number of the deposit have been specified in the application.

(3) The information mentioned in para 2 subpara 3 can be filed subsequently either

1. within sixteen months after the application date or, if a priority has been claimed, after the priority date, or
2. up to the date of the filing of a request for publication of the application ahead of schedule or
3. within one month after the Patent Office has informed the applicant that a right of inspection under to Sec. 81 para (3) exists,

wherein it is relevant which term expires first.

### Unity

**Sec. 88.** An application may contain only one single invention or a group of inventions interrelated in a manner so as to realise a single general inventive concept.

## III. PROCEDURE

### A. Grant of Patents

#### Patent Application

**Sec. 87.** (1) A patent application intended for obtaining a patent for an invention shall be filed with the Patent Office in the written form.

(2) The day on which the application is received at the Patent Office shall be regarded as the filing date.

#### Disclosure

**Sec. 87a.** (1) An invention shall be disclosed in the patent application sufficiently clearly and completely so that it can be carried out by a person skilled in the art.

(2) If an invention relates to a biological material that is not accessible to the public, nor can be described in the application in a manner that a person skilled in the art is able to carry out the invention in accordance therewith, or if the invention contains the use of such a biological material, the invention shall be regarded as disclosed under para (1) only if

1. the biological material has been deposited at a place of deposit under the Budapest Treaty not later than on the day of filing,
2. the application contains the pertinent information on the characteristic features of the deposited biological material, that is known to the applicant, and

#### Requirements for the Application

**Sec. 89.** (1) The application shall comprise:

1. the name and the place of abode or residence of the applicant as well as his representative, if any;
2. the petition for grant of a patent;
3. a brief technical designation of the invention to be patented (title);
4. a description of the invention,
5. one or several claims (Sec. 91(1))
6. any drawings necessary for understanding the invention;
7. an abstract (Sec. 91(2))

(2) The parts of the application mentioned in para (1) subpara 4 to 7 shall be submitted in duplicate. They may be drawn up also in the English or French languages.

**Sec. 89a.** The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.

**Sec. 90.** Cancelled (Fed. Law Gaz. No. I 2004/149)

**Sec. 91.** (1) The claims shall precisely and distinctly define what protection is sought for. They shall be supported by the description.

(2) The abstract shall be a short version of the disclosure contained in the application. It shall



merely serve as a technical information and may not be used for any other purpose, in particular not for determining the scope of protection.

(3) The description, claims, drawings and abstract may be amended until the decision of grant is passed (Sec. 101c (1)). To the extent that such amendments affect the substance of the invention, they shall be divided out from the application and, if the applicant wishes to obtain also protection for the same, shall be filed in separate applications (Sec. 99 (5)).

**Sec. 91a.** If parts of the application are in the English or French languages (Sec. 89(2)), the applicant shall be requested in the context of the examination of conformity with the law to submit a translation into German within the term set by Sec. 99 para (2). This translation shall form the basis of the application proceedings; its correctness shall not be examined in the application proceedings.

**Sec. 92.** Form and content of an application shall be regulated in detail by decree of the President of the Patent Office. In doing so, consideration shall be paid to a maximum of expediency and simplicity as well as to the comprehensibility of the patent specification and to the requirements in respect of printing and publication thereof.

#### Division of an Application

**Sec. 92a.** The applicant or owner of a granted patent or the respective legal successor may during the whole application proceedings as well as up to the expiration of a term

1. of two months after the entry into force of the decision, with which the patent application has been rejected, or
2. of six months after the publication of the grant of the patent under Sec. 101c para (2), if no opposition has been raised, or
3. of two months after entry into force of the decision on an opposition raised in time

file a separate application (partial application). The filing date of this partial application shall be the day on which the original application was filed at the Patent Office, if the applicant claims this day as application date in the partial application and the partial application does not exceed the contents of the earlier application in the originally filed version.

#### Conversion of an Application

**Sec. 92b.** The applicant may apply for a conversion of the application to a utility model applica-

tion as defined by the Utility Model Act until the decision of grant (Sec. 101c (1)) or the decision on rejection (Sec. 100) is passed. Such utility model application shall be accorded as filing date the day on which the patent application was filed at the Patent Office. The conversion of a patent application is not admissible if the utility model application concerned has been converted under Sec. 21 of the Utility Model Act.

#### Priority

**Sec. 93.** (1) The applicant shall get the right of priority for his invention on the day an application for a patent is duly filed.

(2) From this day, the applicant shall have priority over any equivalent invention filed at a later date.

(3) If the application contains deficiencies and such deficiencies are eliminated in time (Sec. 99), such elimination takes effect as of the day of the first filing if such elimination of deficiencies does not affect the substance of the invention

**Sec. 93a.** Within a period of twelve months after the application date of a prior patent or utility model application filed at the Patent Office, the applicant is entitled to the right of priority of the prior patent or utility model application for a later filed patent application concerning the same invention (inner priority). The prerequisites and the effects of this priority right correspond to those of Article 4 of the Paris Convention for the Protection of Industrial Property, Fed. Law Gaz. No. 399/1973.

**Sec. 93b.** Within a period of twelve months after the application date of a prior patent or utility model application filed at a filing office not underlying the scope of an agreement between individual states on the acknowledgement of priority, the applicant is entitled to the right of priority of the prior patent or utility model application for a patent application concerning the same invention filed later in this country, if it is ascertained that a corresponding reciprocity with this filing office was published by announcement of the Federal Minister for Transport, Innovation and Technology in the Federal Law Gazette. The prerequisites and the effects of this priority right correspond to those of Article 54 of the Paris Convention for the Protection of Industrial Property, Fed. Law Gaz. No. 399/1973.

**Sec. 94.** Separate priorities for individual parts of the subject matter of the application (partial priorities) may be claimed by virtue of Sec. 93a or 93b or of international agreements only. Such partial priorities shall be admissible even if the

day of receipt of the application at the Patent Office remains decisive for the priority of a characteristic feature of the subject matter of the application. Several priorities may be claimed for each claim.

**Sec. 95.** (1) The priority rights granted on the basis of Sec. 93a or 93b or of international agreements shall be expressly claimed. To this end, the filing date of the application the priority of which is claimed and the country in which this application has been effected shall be indicated (priority declaration). Furthermore, the file number of this application shall be quoted.

(2) The declaration of priority shall be submitted not later than two months from the receipt of the application at the Patent Office. Within this term, correction of the declaration of priority may be requested.

(3) If the grant or maintenance of a patent depends on whether a priority has been lawfully claimed, the right of priority shall be proved. It shall be governed by decree of the President of the Patent Office, what documents in the proceedings before the Patent Office and before the Supreme Patent and Trademark Senate are required for this proof (priority documents) and at what time these documents are to be submitted.

(4) If the declaration of priority is not submitted in time, if the priority documents are not lodged in time or if the file number of the application whose priority has been claimed is not notified upon official request, the priority shall be defined as of the date of application in Austria.

#### Examination of Conformity with the Law

**Sec. 99.** (1) Each application shall be subject to an examination of conformity with the law by the Patent Office by the Technical Department, wherein, however, an examination on whether the applicant is entitled to a grant of the patent does not take place. The financial profitability of the invention shall not be assessed.

(2) If the application does not comply with the formal requirements prescribed, the applicant shall be invited to eliminate any deficiencies within a term set.

(3) If the examination, if necessary after the hearing of experts, reveals that a patentable invention does not exist, the applicant shall be notified accordingly, if necessary after a discussion with the examiner, by stating any reasons whatsoever and also by inviting the applicant to file a response within a term set.

(4) If the examination reveals that the application lacks unity (Sec. 88), the applicant shall be ordered to establish unity within a term set. Upon request of the applicant in this case, it shall be determined by way of decision that the application lacks unity. With the entry into force of such a decision the applicant shall be allowed a new term set to establish unity.

(5) If the application has been unduly amended (Sec. 91 (3)), the applicant shall be invited to divide out the unduly amendments within a term set. Within the period referred to in Sec. 92a a separate application can be filed for the part to be divided out, which shall be assigned as filing date the date at which the Patent Office has been notified about the amendments in the proceedings on the original application.

(6) Upon request, the terms provided under para (2) to (5) may be extended. The President of the Patent Office may issue guidelines on the principles of the examination as well as on the procedure to be followed by the Technical Department. In particular, he may determine the extent of the terms to be set by the Office. In doing so, an examination as efficient and accurate as possible as well as the uniform treatment of the applications by the Technical Department shall be taken into account.

#### Rejection of the Application

**Sec. 100.** (1) If the examination under Sec. 99 reveals the inadmissibility of the grant of the patent according to Sec. 99, the application shall be rejected. If these conditions apply only partially, only the respective part of the application shall be rejected.

(2) In any case the application shall be rejected in whole if one of the terms set under Sec. 99 elapses without use and no response is received until the decision on rejection is passed.

#### Publication of the Application

**Sec. 101.** (1) The application shall be published being subject to Sec. 101a immediately after expiration of eighteen months after the filing date, or if a priority is claimed, after the priority date. Upon request of the applicant, it can, however, be published before expiration of this term.

(2) The publication of the application shall include the specifications, claims, drawings and abstracts each in the originally filed version, as well as a search report in the enclosure, if this exists before completion of the technical preparations for the publication. In the search report the

documents investigated by the Patent Office at the time of the making of the report shall be mentioned that may be considered for the assessment of the patentability. The search report shall be based on the claims in their originally filed version, wherein Sec. 22a para (1) sentence 2 and 3 shall be applied mutatis mutandis. If the search report has not been published together with the application, it shall be published separately.

(3) If the claims have been amended before completion of the technical preparations for the publication of the application, the last filed claims shall also be included in the publication.

(4) The Patent Gazette shall include a reference to the publication of the application stating the name, place of abode or residence of the applicant, a brief appropriate designation of the subject matter of the invention (title) and the filing date of the application (publication of the application).

(5) The application entitles the applicant from the day of its publication in the Patent Gazette (para (4)) for the time being to a claim for adequate financial compensation against the party that has unauthorisedly used the subject matter of the invention. Sec. 154 shall apply mutatis mutandis with the proviso that this entitlement does not fall under the statute of limitations before expiration of one year after the publication of the grant (Sec. 101c para (2)).

**Sec. 101a.** (1) If the decision by which the patent has been granted becomes legally valid before the terms set in Sec. 101 para (1), the application shall be published at the same time together with the patent specification (Sec. 80 para (4)). In this case no publication of a search report takes place.

(2) The application shall not be published if it has been withdrawn or rejected before completion of the technical preparations for the publication. If the decision on rejection does not become legally valid, the application shall be published even after the expiration of the terms set in Sec. 101 para (1).

(3) If a utility model application under Sec. 21 of the Utility Model Act is converted to a patent application and a publication cannot take place within the terms set in Sec. 101 para (1) the application shall be published even after the expiration of this term.

(4) If a separate application cannot be published any more within the terms set in Sec. 101 para (1), the application shall be published even after the expiration of this term.

## Objections of Third Parties

**Sec. 101b.** (1) After the publication of the application any third party can raise an objection against the patentability of the filed invention. The objections shall be substantiated. The third party has no position in the case before the Patent Office and shall not be entitled to the reimbursement of costs.

(2) The objections are communicated to the applicant, who can comment thereon.

## Grant of a Patent

**Sec. 101c.** (1) If no objections against the grant exist and the application fee for the patent specification has been paid, the Technical Department shall decide to grant the patent.

(2) The grant of the patent shall be published in the Patent Gazette. At the same time the patent specification shall be published (Sec. 80 para (4)), the patent shall be entered in the Patent Register and the Letters Patent shall be issued for the patentee. With publication in the Patent Gazette the legal effects of the patent shall enter into force.

## Publication of Withdrawal or Rejection of the Application

**Sec. 101d.** (1) If the application is withdrawn after the publication or if the application is rejected, this also shall be made known in the Patent Gazette.

(2) With the publication of the withdrawal or the rejection of the application the effects of provisional protection (Sec. 101(5)) shall be considered as not having been operative.

## Opposition

**Sec. 102.** (1) An opposition may be lodged against the grant of a patent within four months from the day of publication of the grant of the patent (Sec. 101c para (2)). The opposition shall have to be received at the Patent Office not later than on the last day of the term set.

(2) The opposition shall be submitted in writing in duplicate. It may be based only on the following grounds supported by definite facts:

1. that the subject matter of the patent does not comply with Sec. 1 to 3;

2. that the patent does not disclose the invention sufficiently clearly and completely to be carried out by a person skilled in the art;
3. that the subject matter of the patent goes beyond the contents of the application in its originally filed version determining the day of filing;
4. that the biological material deposited under Sec. 87a para (2) subpara 1 has not been permanently available either at the original place of deposit as defined by the Budapest Treaty or at another place of deposit to which it has been transferred according to this Treaty, unless the patentee proves

- a) that he deposited the biological material anew and the deposit, under Article 4 of this Treaty, is to be treated as if it had been made on the day of the original deposit, or
- b) that he had been prevented from such new deposit by an unforeseen or unavoidable event and finally had made such a deposit within two months after the impediment had ceased to exist;

(3) A copy of the opposition shall be delivered to the patentee for him to submit a written response within a two-month term to be extended on reasonable grounds.

### Opposition Proceedings

**Sec. 103.** (1) As soon as a response has been filed or the term to do so has expired, the rapporteur in charge of the respective matter shall take the measures in respect of any further correspondence that may be necessary, the hearing of the parties concerned, the production of the pieces of evidence offered by the parties, the recording of such pieces of evidence as well as of a clarification as reliable as possible of the true facts.

(2) The chairman may order oral proceedings on request or ex officio if he considers this necessary in the particular case for the decision on the opposition. The hearing is open to the public. Sec. 119 para (2) shall apply.

(3) The chairman shall open the oral proceedings and assure himself of the identity of the persons appearing as well as to verify their positions in the case and the possible authority to represent. He shall lead the oral proceedings without allowing for digression or lengthiness in such a way that the parties right to be heard is preserved.

(4) The chairman determines the order in which the parties shall be heard, the evidence shall be taken and the results of previously taken evidence or enquiries shall be submitted and discussed. The chairman or members of the Senate

appointed by him shall discuss the case with the parties factually and legally.

(5) The oral proceedings shall be taken down on record. Sec. 73 para (4) shall apply mutatis mutandis.

(6) The Fee Entitlement Act 1975 shall apply.

### Evaluation of Evidence and Decision

**Sec. 104.** (1) The Technical Department shall decide by freely evaluating the facts and evidence presented.

(2) Consultation and voting of the Technical Department shall be effected in camera. Discontinuation may be decided upon in writing by circular unless a member contradicts. Sec. 117 first sentence shall apply mutatis mutandis.

(3) The rapporteur shall draft the decision based on the decisions passed. If the rapporteur has remained in the minority with his view, he shall make a new draft in agreement with the member, whose request has been made a decision. The chairman shall, however, be free to charge another member of the Senate with the preparation of the draft or parts thereof.

(4) The patent shall be revoked, if the opposition is successful. If the opposition is partially successful, only the respective part of the patent shall be revoked. In all other cases the opposition shall be dismissed.

### Costs

**Sec. 105.** The costs for the opposition proceedings shall be borne by the parties themselves.

**Sec. 106.** Cancelled (Fed. Law Gaz. No. I 2004/149)

### Publication of the Decision on the Opposition

**Sec. 107.** The complete or partial revocation of a patent shall be published in the Patent Gazette. If the patent is only partially cancelled, the Patent Office shall publish the amendments.

### Effects of the Revocation

**Sec. 108.** The effects of the application and of the patent shall be considered as not having been operative within the scope of the legally valid revocation of the patent.

## B. Searches and Expert Opinions

### Requirements and Treatment of Requests

**Sec. 111a.** (1) A request for searches under Sec. 57a subpara 1 shall relate to one single concrete technical problem only. In the request, it may also be asked for the search to be directed to an earlier date. The request shall be accompanied by a precise and clear description and, if necessary, a concise abstract of the concrete technical problem, and drawings.

(2) The request for carrying out a search under Sec. 57a subpara 2 shall be accompanied by the description of the invention, the claims and, if necessary, the drawings. Sec. 91(1) shall be applied mutatis mutandis. If the applicant does not indicate from which prior art the search is to depart, the search shall be based on that prior art which is known to the Patent Office on the day of receipt of the request. In the request, it may also be asked for the search to be directed to an earlier date.

(3) Requests for carrying out a search or an expert opinion under Sec. 57a, together with enclosures (para (1) and (2)), shall be submitted in writing in duplicate. The description, the claims and the abstract also may be in the English or French languages, yet the Patent Office shall be entitled to demand a German translation.

(4) The technically qualified member (Sec. 61) competent according to the distribution of business shall be appointed to deal with the requests. The dispatch of such request shall be accompanied by a copy of each enclosure (para (1) and (2)) also submitted by the applicant.

(5) In case of any deficiency of the request or of an enclosure, the requesting party shall be called upon to eliminate this deficiency within a term set. If the deficiency is not eliminated, the request shall be rejected by decision. The decision may be appealed against.

## C. Contestation of Patents

### Filing of a Request

**Sec. 112.** (1) Proceedings for revocation, annulment or disentanglement of a patent shall be initiated only by petition. However, the Patent Office shall be entitled to continue proceedings initiated by a petition for revocation or annulment ex officio in case such petition is withdrawn.

(2) The requesting party who does not have his residence in a state in which the decision ordering the requesting party to reimburse the costs would be enforced, shall give security for the costs of the proceedings to the adverse party upon request of the latter. This request shall be submitted within 14 days from delivery of the petition, otherwise such title to security shall lapse.

(3) The height of the security shall be fixed at the discretion of the Patent Office. A term shall be set to the requesting party within which to furnish the security. If the security is not furnished before the expiration of the term, the petition shall be considered withdrawn.

### Immediate Rejection

**Sec. 113.** (1) Petitions for the revocation, annulment or disentanglement of a patent that do not appear to be based on legal grounds as well as requests that do not contain any specific demand or to whose submission the requesting party is not entitled (Sec. 49 and 50) shall be rejected by the Nullity Department without further proceedings by stating the reasons.

(2) Likewise, petitions shall be rejected for lack of competence of the Nullity Department, for decided cases or for pending dispute without further proceedings by stating the reasons.

(3) Such decisions shall be regarded as final decisions.

### Form and Contents of the Request

**Sec. 114.** (1) The request shall contain a concise presentation of the dispute and, in addition to the specific demand, an indication as to the pieces of evidence to be furnished.

(2) The request plus enclosures shall be filed at the Patent Office in duplicate if directed against a single patentee only.

(3) If the request is directed against several patentees, a copy of the petition plus copies of the enclosures shall be submitted for each of the adverse parties in addition to the copies intended for the Patent Office.

### Third Party Intervention

**Sec. 114a.** (1) Any person having a legal interest in a party being successful in proceedings pending before the Nullity Department or the Supreme Patent and Trademark Senate between other parties may join this party in the proceedings (third party intervention). The intervener shall have the status of a co-litigant (Sec. 14,



Code of Civil Procedure), even though the prerequisites under Sec. 20, Code of Civil Procedure do not apply.

(2) Otherwise, Sec. 18 to 20, Code of Civil Procedure, shall apply *mutatis mutandis*.

### Proceedings on Petitions for Contestation

**Sec. 115.** (1) The chairman shall appoint a technically qualified member and a legally qualified member as rapporteurs.

(2) If a petition for instituting proceedings has been found appropriate, the legally qualified rapporteur shall send a copy thereof plus copies of enclosures to the adverse party, demanding the latter to submit two copies of his written reply within a term of at least two months to be extendible by consent of the rapporteur in the event of reasonable grounds.

### Interruption because of Opposition Proceedings

**Sec. 115a.** Pending proceedings for declaration of nullity shall be interrupted *ex officio*, if opposition proceedings are pending or made pending. The interrupted proceedings shall be continued after legally valid conclusion of the opposition proceedings on request or *ex officio*, if the patent was not revoked. If the patent was revoked, the proceedings shall be terminated *ex officio*.

### Preliminary Proceedings

**Sec. 116.** (1) After submission of the reply or after lapse of the term set therefor, the legally qualified rapporteur, if necessary, shall carry out preliminary proceedings (para (2) and (3)) in preparation of the hearing. The rapporteurs shall seek mutual agreement in the preliminary proceedings. In case of disagreement, the chairman shall decide.

(2) In the preliminary proceedings, all of the material for the hearing shall be prepared to such an extent that the hearing, if possible, may be carried out without interruption. In particular, the parties shall be heard or their statements shall be obtained as to which of the actual allegations are not contested unless this is clear from the briefs presented.

(3) The preliminary proceedings shall also include the taking of evidence, such as inspections, the hearing of non-local witnesses and time-consuming investigations by experts, if the taking of evidence within the hearing considerably complicated or delayed the hearing or in-

cluded disproportionately high costs or if the immediate taking of evidence were necessary for securing the evidence.

(4) The parties shall be summoned wherever evidence is taken in preliminary proceedings. Failure to appear shall not prevent the taking of evidence.

(5) Sec. 120 shall apply for the taking of evidence in preliminary proceedings. Evidence by hearing the parties shall not be admitted in preliminary proceedings.

(6) In the preliminary proceedings, the legally qualified rapporteur shall have all the powers and duties of a chairman under Sec. 180 to 185, Code of Civil Procedure.

(7) The chairman may order supplementing of the preliminary proceedings in respect of individual facts to be clearly specified.

(8) After receipt of the response or after lapse of the term set therefor as well as, if necessary, after having carried out the preliminary proceedings, the rapporteur shall present to the chairman the files including a written statement of the facts as well as of all questions of fact and legal questions relevant to the decision and comments thereon (report). The legally qualified rapporteur shall report on the legal questions and the technically qualified rapporteur shall report on the technical questions. The chairman may order a rapporteur or any other voting member to supplement the report.

### Termination of Proceedings without Hearing

**Sec. 117.** If a patent expires during proceedings before the Nullity Department, the proceedings shall be terminated by decree unless the requesting party insists on their being carried out by substantiating a legal interest. In cases under Sec. 46(1) subpara 2 and 3, the requesting party basically shall be entitled to reimbursement of costs, the adverse party only if he did not cause the petition to be filed due to his conduct and the patent lapsed during the term set for filing a response. The decision to terminate the proceedings shall also settle the question of reimbursement of costs (Sec. 122(1)). This decision shall be regarded as final.

### Public Notice of the Oral Proceedings

**Sec. 118.** (1) The oral proceedings shall be publicly notified by the chairman. The response shall be delivered to the requesting party not later than on the day of public notice of the hearing.

(2) The oral proceedings may be postponed to any other date for important reasons by the chairman either on request or ex officio.

(3) The parties or their representatives as well as the witnesses and experts to be heard at the oral proceedings shall be summoned for the oral proceedings.

(4) Failure of the parties or their representatives to attend the oral proceedings shall neither affect the proceedings, nor the decision.

(5) If adjournment is requested at the oral proceedings, the Senate shall decide thereupon.

### Oral Proceedings

**Sec. 119.** (1) The oral proceedings shall be conducted and carried out in accordance with the provisions under Sec. 171 to 203, Code of Civil Procedure, to be applied mutatis mutandis. Sec. 73(3), last sentence, shall apply.

(2) In addition to the cases mentioned in Sec. 172, Code of Civil Procedure, the public may be excluded on request for part or for all of the oral proceedings where an important interest of the Federation or an operational or business secret of one of the parties or one of the witnesses would be endangered by the oral proceedings being held in public.

(3) Notwithstanding the exclusion of the public, the members of the Patent Office and of the Supreme Patent and Trademark Senate as well as the Federal officials in the upper grade of the civil service of the Federal Ministry for Transport, Innovation and Technology shall be granted access.

### Evidence and the Taking of Evidence

**Sec. 120.** (1) Unless otherwise provided by this Act, the taking of evidence shall be carried out by applying the provisions of Sec. 266 to 383, Code of Civil Procedure, mutatis mutandis.

(2) The evidence given by the witnesses before the Patent Office as well as the sworn statements made by the parties before the Patent Office shall be equivalent to a testimony before court.

(3) The preceding principles in respect of the taking of evidence shall apply both to the preliminary proceedings and to the hearing.

(4) The Fee Entitlement Act 1975 shall apply.

(5) The administrative penalty and penalty for wanton acts to be imposed under Sec. 313, 326, 333 and 354 of the Code of Civil Procedure must not exceed EUR 721.--. In taking evidence during an hearing, the administrative penalty and penalty for wanton acts shall be imposed by the Senate, in the preliminary proceedings by the legally qualified rapporteur (Sec. 116(1)). Sec. 84(1) and (3) shall apply.

### Deliberation and Voting

**Sec. 121.** Deliberation and voting of the Nullity Department shall take place in camera. Termination may be decided upon in writing by circular provided a member does not oppose.

### Costs of the Proceedings

**Sec. 122.** (1) The reimbursement of procedural and representation costs shall be decided upon by applying Sec. 40 to 55, Code of Civil Procedure, mutatis mutandis, being subject to para (2) and Sec. 117.

(2) The party who withdraws a petition shall reimburse the costs to the opposing party.

### Contents of the Decision

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

1. the designation of the department and the names of all members who took part in the decision;
2. the names of the parties, their representatives and authorised persons as well as their positions in the case;
3. the decision;
4. the facts of the case underlying the decision, comprising a concise description of the facts resulting from the oral proceedings and pointing out the petitions lodged by the parties in respect of the main issue;
5. the reasons for the decision;
6. the instructions on the parties' rights to appeal.

### Pronouncement of the Decision

**Sec. 124.** (1) The pronouncement of the decision including the essential reasons for the decision

shall be effected, if possible, orally immediately upon closure of the oral proceedings.

(2) In all cases, however, the written decision together with a full statement of the reasons of the decision shall be forwarded to the parties as soon as possible.

### Recording

**Sec. 125.** (1) A record shall be taken of all the evidence taken in the preliminary proceedings and of the oral proceedings. The record shall be signed by the chairman or, in preliminary proceedings, by the rapporteur taking the evidence. Otherwise, Sec. 73(4) shall apply *mutatis mutandis*.

(2) Of the meeting *in camera* (Sec. 121), a separate record shall be taken, from which the result of the deliberation and voting shall be apparent. This record shall be signed by the chairman and by the clerk.

### Legal Assistance

**Sec. 126.** The courts shall provide legal assistance to the Patent Office and to the Supreme Patent and Trademark Senate. (Fed. Law Gaz. No. 225/1965, Article I subpara 10).

### Reopening of the Proceedings

**Sec. 127.** (1) If a patent has wholly or partially been revoked, withdrawn, declared null and void or denied or a request aimed at such has been rejected wholly or partially, the closed proceedings may be reopened upon request by a party,

1. if a document on which the decision is based has been falsely drafted or forged;
2. if a witness or an expert has made a false statement or the opposing party has perjured itself during its interrogation and the decision has been based thereon;
3. if the decision has been obtained through a fraudulent act liable to criminal action, by the party's representative, the opposing party or its representative;
4. if a member who took part in the decision or in an earlier decision underlying this decision has been found guilty of infringing his official duty to the party's detriment, which shall be liable to criminal action;
5. if a criminal verdict, on which the decision is based, has been repealed by another legally effective verdict.

(2) Reopening may, however, be requested by the parties to the dispute only within a year after the entry into force of the decision to be annulled and without prejudice to the rights of third parties acquired in the meantime.

(3) In particular, persons who have used the invention so far or have made arrangements to do so shall acquire the right to which a prior user of the invention is entitled (Sec. 23).

(4) The decision on the request for reopening shall be vested with that authority (Technical Department, Appeal Department or Nullity Department of the Patent Office or Supreme Patent and Trademark Senate) which passed the contested decision. If the request for reopening is sustained by the Supreme Patent and Trademark Senate, the latter shall also decide whether the reopened proceedings shall take place before it or before a sub-authority.

(5) The request for reopening proceedings shall not have an impeding effect on the execution of the decision.

**Sec. 128.** If the invalidation of a patent has been entered in the Patent Register by the Patent Office by mistake, the Patent Office, after having discovered this error, shall order and publish the cancellation of this entry. Rights of third parties acquired in good faith in the meantime shall be preserved as in the case of reopening.

### Further Processing of the Publication

**Sec. 128a.** If after failure to keep a term set by the Patent Office an application has been rejected, the applicant or his legal successor can request further processing of the application. The request shall be filed with the Patent Office within two months after the delivery of the decision on rejection. The omitted action shall be taken within this term set. The request shall only be granted if the fee for further processing is paid. With granting the request for further processing the decision on rejection shall become ineffective.

#### Restitutio in integrum

**Sec. 129.** (1) Any person who, due to an unforeseen or unavoidable event, was unable to keep a term set and such failure involves a legal prejudice pursuant to a provision relating to the protection of an invention by virtue of this provision, shall be entitled to reinstatement into the former status. A failure based on a minor error shall not impede reinstatement.

(2) Reinstatement into the former status shall not occur

1. for failure to keep the term set for the request for reinstatement (Sec. 131(1)) and the term set for the legal remedy against the decision on such request;
2. for failure to keep the term set for an opposition (Sec. 102(1)) and the term set for an appeal by the opponent (Sec. 71(1), Sec. 145a (2)).

(3) Within the term set for submitting a priority declaration, correction of the same or for filing the priority documents (Sec. 95(2) and (3)), reinstatement into the former status shall be admissible only if the request, irrespective of the terms set for the filing of the request (Sec. 131), has been received by the Patent Office not later than on the day before the publication of the grant of the patent (Sec. 101c (2)). With the granting of the reinstatement any decision of grant (Sec. 101c (1)) or decision on rejection (Sec. 100) already passed shall become invalid.

**Sec. 130.** (1) The request shall be decided upon by that department before which the omitted action was to be taken. If an action was omitted before the Technical Department, the legally qualified member assigned to that department shall decide on the request.

(2) In the sphere of competence of the Nullity Department of the Patent Office any decision shall be taken by the chairman. This decision may be appealed against at the Supreme Patent and Trademark Senate in accordance with the provisions governing such legal remedy. The provisions otherwise in force shall apply to the sphere of competence of the Patent Office in respect of decision making and contesting of decisions.

**Sec. 131.** (1) The request for reinstatement shall be submitted within two months from the day on which the impediment ceased to exist, but in any case not later than within twelve months after the day of expiration of the term. (Fed. Law Gaz. No. 210/1951, Article I subpara 12).

(2) The requesting party shall indicate any circumstances constituting the grounds of the request and substantiate the same unless they are already known to the authority. The omitted action shall be taken at the same time the request is filed.

(3) A copy of the request plus enclosures shall be presented to any possible adverse party of the requesting party.

**Sec. 132.** Cancelled (Fed. Law Gaz. No. I 2004/149)

**Sec. 133.** (1) If the request or the belated action is deficient, the requesting party shall be invited

to eliminate the deficiency within a term set before a decision is taken.

(2) If the protective right concerned has been entered in a public register, the request and the way it has been dealt with shall be entered in the register.

(3) The grant of the reinstatement shall be announced in the Patent Gazette if a protective right is reinstated by the grant of the reinstatement the lapse of which has been officially announced.

**Sec. 134.** (1) Prior to passing a decision, any adverse party to the requesting party involved in this case shall be given the opportunity to make a submission within a term set (Sec. 131(3)).

(2) Irrespective of whether the request is granted or not, the requesting party shall be charged with the costs incurred to the adverse party in respect of the proceedings relating to the request and representation.

**Sec. 135.** By the grant of reinstatement into the former status, the legal consequences involved in the failure to meet the term shall become ineffective. The authority shall take any measures appropriate in executing the decision.

**Sec. 136.** (1) If a protective right has been refused, lapsed, expired or otherwise become ineffective and is reinstated by the grant of reinstatement, it shall not enter into effect against any person who, after the lapse of the protective right and before the day of the official announcement of the grant of reinstatement (Sec. 133(3)) or, in case of Sec. 133(2), not later than on the day of entry of the request in the Register, in all other cases not later than on the day of receipt of the request at the competent authority, started to use the subject matter in Austria or took the measures required for such use in Austria (interim user). Such person shall be entitled to exploit the subject matter for the requirements of his own business in his own or in other persons' workshops. This title shall be inherited or sold only in connection with the business. Otherwise, the provisions relating to prior use shall apply.

(2) If, in respect of the reinstated protective right, there has been a license agreement concluded during its earlier validity and the right of the licensee is impaired by an interim user (para (1)), the licensee shall be entitled to demand an appropriate reduction of the payment stipulated or, if he is no longer interested in fulfilling the contract because of such impairment, to terminate such contract.

## Execution

**Sec. 137.** (1) Legally valid pronouncements of the Patent Office as well as of the Supreme Patent and Trademark Senate shall be executory deeds under Sec. 1 of the Regulation of Execution.

(2) The Patent Office ex officio shall carry out in the registers to be maintained by it, the entries and deletions necessary to execute its legally valid decisions as well as the decisions of the Supreme Patent and Trademark Senate. The necessary decrees shall be passed by the chairman with collective decisions of the Patent Office and by the chairman of the Appeal Department or Nullity Department with decisions of the Supreme Patent and Trademark Senate.

## Appeal

**Sec. 138.** (1) Any party who considers itself wronged by a final decision of the Nullity Department of the Patent Office shall have the right of appeal to the Supreme Patent and Trademark Senate. The appeal shall have suspensive effect.

(2) With the exception of decisions of interruption, there shall be no separate legal remedy against the decisions passed by the Nullity Department in the course of the preliminary proceedings or of the hearing. They shall be contested only by appeal to the Supreme Patent and Trademark Senate if they had an influence on the final decision (Sec. 70).

(3) The appeal shall be lodged in writing with the Patent Office within two months upon delivery of the decision. It shall contain a substantiated request for appeal stating the grounds.

(4) The appeal brief and its enclosures shall be submitted in duplicate. If the appeal is directed against several adverse parties, a copy plus a copy of each enclosure shall be submitted in addition to that destined for the Supreme Patent and Trademark Senate.

**Sec. 139.** (1) The Nullity Department shall be responsible for all matters falling within the sphere of action of the Patent Office and relating to appeals to the Supreme Patent and Trademark Senate. It shall decide in camera. These decisions shall be regarded as final.

(2) If an appeal lodged in time includes deficiencies, the legally qualified rapporteur of the Nullity Department shall set a term to the appellant for correction. If the deficiencies are eliminated within this term, the appeal shall be regarded as properly submitted.

(3) Belatedly lodged appeals or appeals that are not corrected within the term set under para (2), shall be rejected by the Nullity Department.

(4) In all other cases, the legally qualified rapporteur shall send a copy of the appeal brief to the adverse party, informing the same that he is free to submit a response to the appeal within two months.

(5) After receipt of a response to the appeal in time or after expiration of the two-month term, the relevant files shall be presented to the Supreme Patent and Trademark Senate by the legally qualified rapporteur.

## Proceedings before the Supreme Patent and Trademark Senate

**Sec. 140.** (1) Unless otherwise provided below, the provisions of Sec. 113 to 127 and 129 to 136 shall be applied to the proceedings before the Supreme Patent and Trademark Senate mutatis mutandis.

(2) The Supreme Patent and Trademark Senate shall not take new evidence.

(3) If the Supreme Patent and Trademark Senate establishes an infringement of the procedural provisions by the Nullity Department preventing the passing of a lawful decision, or if it considers the taking of additional evidence necessary, it shall refer the case back to the Nullity Department.

**Sec. 141.** If the appeal includes deficiencies that have not been objected to under Sec. 139(2), the rapporteur shall set a term to the appellant to correct the same.

**Sec. 142.** (1) The Supreme Patent and Trademark Senate shall pass a decision without preliminary proceedings and without oral proceedings,

1. if the deficiencies of the appeal have not been corrected within the term set under Sec. 141;
2. if the appellant is not entitled to lodge an appeal;
3. if the appeal should have been rejected already by the Nullity Department (Sec. 139(3));
4. if the appeal is directed against decisions under Sec. 113 and Sec. 139(3);
5. if the appeal is directed against a decision on a request for reinstatement into the former status (Sec. 130(2));



6. if the appeal is directed only against the decision on the reimbursement of costs (Sec. 122);
7. if the appeal is based exclusively on the fact that the passing of a lawful decision was prevented by infringement of the procedural provisions or if, according to the state of the file, the referring back of the case to the Nullity Department on grounds of infringement of such procedural provisions appears necessary.

(2) If no final decision on an appeal is at issue, a decision may be passed also by writing without a meeting, if the chairman does not consider necessary such meeting because of the simplicity of the case. If, in this case, a member of the Supreme Patent and Trademark Senate expresses an opinion deviating from the rapporteur's request, a meeting shall be convened in any event.

**Sec. 143.** (1) If a party renounces a hearing, if also the adverse party does not insist on such hearing within a term set by the rapporteur and if also the chairman does not consider it necessary, the case shall be decided upon in camera.

(2) The oral proceedings, after calling of the case, shall commence with the reading of the rapporteur's written report. This report shall contain a representation of the basic facts, of the contents of the appeal and of the response to the appeal, yet no expression of an opinion on the decision to be passed.

(3) After this, the appellant and then the adverse party shall be heard; the latter shall have the right of the last word.

(4) The decision shall be passed only by those members of the Senate who took part in the oral proceedings on which the decision is to be based. If a change in the membership of the Senate occurs prior to passing a decision, the oral proceedings shall take place once more, before the newly composed Senate.

**Sec. 144.** An appeal may be withdrawn until the end of the oral proceedings. If the appeal is withdrawn before the oral proceedings, the adverse party shall be granted a term for asserting a claim for the reimbursement of costs, if necessary. If no costs are recorded, the rapporteur shall close the proceedings. In all other cases, the closure of the proceedings and possible claims for reimbursement of costs shall be decided upon in camera.

**Sec. 145.** (1) The Supreme Patent and Trademark Senate shall decide upon the verdict and the reasons for the decision by an absolute majority. The chairman shall preside over the deliberation and voting. He shall participate in voting

like any other member of the Senate. After the presentation of the facts of the case as well as of any request by the rapporteur and the possibly appointed co-rapporteurs the chairman shall call upon the voting members in the order in which they asked for the floor and, after the conclusion of the deliberation, shall proceed to the voting on the requests made. The chairman shall determine the questions and the order in which they are put to vote. No member shall be allowed to refuse participation in the voting even if he was in the minority on a preliminary question. Each voting member may withdraw his vote until the end of the meeting.

(2) The result of the vote shall be recorded by the clerk and signed by him and by the chairman. Each voting member shall be free to write down the reasons for his opinion not having been incorporated in the decision and attach it to the voting record.

(3) The rapporteur shall draw up the settlement of the case on grounds of the decisions passed. If the rapporteur has remained in the minority with his opinion, the chairman may charge other members of the Senate with the preparation of the draft or parts thereof. He shall verify whether the draft of the settlement is in conformity with the decision.

#### **Appeal to the Supreme Patent and Trademark Senate against Decisions of the Appeal Department**

**Sec. 145a.** (1) The party that considers itself wronged by a final decision of the Appeal Department shall have the right of appeal to the Supreme Patent and Trademark Senate. The appeal shall have suspensive effect.

(2) The appeal shall be lodged with the Patent Office within two month after the delivery of the decision of the Appeal Department. It shall include a substantiated request for appeal. If appeal proceedings are to be carried out with an adverse party, the appeal brief and enclosures shall be submitted in duplicate. If the appeal is directed against several adverse parties, a copy plus a copy of each enclosure for each adverse party shall be submitted in addition to that destined for the Supreme Patent and Trademark Senate.

(3) All matters falling under the sphere of activity of the Patent Office, relating to appeals to the Supreme Patent and Trademark Senate, shall fall within the competence of the Appeal Department. It shall make its decisions in camera. These decisions shall be regarded as final.

(4) If an appeal lodged in time includes deficiencies, the rapporteur of the Appeal Department shall set a term to the appellant for correction. If the deficiencies are eliminated within this term, the appeal shall be regarded as properly submitted.

(5) Belated appeals or appeals that have not been corrected within the term set under para 4, shall be rejected by the Appeal Department. In all other cases, if the appeal proceedings shall not be carried out ex parte, the rapporteur shall deliver one copy of the appeal brief to the adverse party including the notification, that he may submit a response to the appeal within two months.

(6) After receipt of the response to the appeal in time or after expiration of the two month term the files shall be presented to the Supreme Patent and Trademark Senate.

#### **Proceedings before the Supreme Patent and Trademark Senate in Case of Appeals**

**Sec. 145b.** (1) Inadmissible appeals as well as appeals that already should have been rejected by the Appeal Department, shall be rejected by the Supreme Patent and Trademark Senate without further proceedings. In the case of deficiencies an appeal shall only be rejected after the appellant, upon request, has failed to meet the deficiencies. The rapporteur shall set a term for correction for the appellant.

(2) The Supreme Patent and Trademark Senate shall not take new evidence.

(3) The Supreme Patent and Trademark Senate decides on the appeal by decision in camera without oral proceedings. However, if it considers it necessary in the individual case for decision on the appeal, the Supreme Patent and Trademark Senate can order oral proceedings upon request or ex officio. For these the provisions for the appeal proceedings before the Supreme Patent and Trademark Senate shall apply mutatis mutandis.

(4) The Supreme Patent and Trademark Senate shall decide on the case itself. However if it detects an infringement of the procedural provisions or it considers supplementing of the taking of evidence necessary, it shall refer the matter back to a sub-authority.

(5) In the copy of its decision the Supreme Patent and Trademark Senate can confine the reproduction of the presentation of the parties and the actual basis for the decision to that which is necessary for understanding its legal explication.

If the Supreme Patent and Trademark Senate confirms the decision of the Appeal Department and considers its reasoning as correct, it will suffice, if it refers to its correctness.

(6) In proceedings of appeal the parties shall bear the costs of the proceedings themselves.

(7) As far as no deviations result from para 1 to 6 and Sec. 145a, the provisions relating to appeal shall also apply to the appeal.

#### **IV. PATENT INFRINGEMENTS AND THE OBLIGATION TO PROVIDE INFORMATION**

##### **Claim for Injunction**

**Sec. 147.** Any person whose rights from a patent have been infringed upon or who has to pursue such infringement may sue for injunction.

##### **Claim for Destruction**

**Sec. 148.** (1) The patent infringer shall be liable to eliminate an unlawful state.

(2) The person infringed, in particular, may demand, at the infringer's expenses, that any objects infringing his patent (infringing objects) be destroyed and the tools, implements and other means (infringing means) exclusively or preferably serving to produce infringing objects be rendered unusable for such purpose to the extent that this does not affect the material rights of third parties.

(3) If the infringing objects or infringing means mentioned in para (2) include elements whose unchanged existence and whose use by the defendant do not infringe the exclusive right of the plaintiff, the court shall specify such elements in its judgement pronouncing destruction or rendering unusable. In executing the judgement, such parts shall, as far as possible, not be destroyed or rendered unusable if the adverse party pays in advance the costs involved.

(4) If, in the execution procedure, it turns out that higher costs will be involved in rendering the infringing elements unusable than in destroying the same, and if these costs are not paid in advance by the adverse party, the court of execution shall order the destruction of those infringing elements after having heard the parties.

(5) If the unlawful state can be eliminated in a way other than designated in para 2, which involves no or only less destruction of assets, the infringed party may request measures of that kind only.

(6) Instead of demanding that infringing objects be destroyed or that infringing means be rendered unusable, the infringed party may demand that the infringing objects or infringing means be left to him by their owner for an adequate compensation not exceeding the costs of production.

(7) If necessary, an expert shall be consulted in executing destruction for specifying the objects being subject to execution.

### Publication of the Judgement

**Sec. 149.** (1) If a claim is raised for cessation or elimination, the court shall, upon request, if the successful party has a legitimate interest therein, grant to the latter the right to have the judgment published at the adverse party's expense within a term to be set in accordance with Sec. 409(2), Code of Civil Procedure. The scope and type of publication shall be determined in the judgment.

(2) The publication shall comprise the verdict. Upon request of the successful party, the court may, however, decide to publish a text that deviates from the verdict in extent or wording or supplements the same. Such request shall be made not later than four weeks after the entry into force of the judgment. If the request has been made only after the closure of the oral proceedings, the decision shall be with the court of first instance upon entry into force of the judgment.

(3) Upon request of the successful party, the court of first instance shall decide upon the costs of the publication of the judgment and shall charge the adverse party with the reimbursement of the same.

### Monetary Claims

**Sec. 150.** (1) The party infringed by the unauthorised use of a patent shall be entitled to adequate monetary compensation from the infringer.

(2) In case of culpable patent infringement, the infringed party, instead of adequate monetary compensation (para (1)), may demand

- a) damages including any loss of profits, or
- b) the surrender of the profits made by the infringer through the patent infringement.

(3) Independent of proof of damage, the infringed party can demand double the monetary compensation he is entitled to under para (1), if the

patent infringement is based on gross negligence or intent.

(4) The infringed party also shall be entitled to adequate compensation for any damage other than financial losses he suffered by the culpable patent infringement insofar as this is justified by the particular circumstances of the case.

### Rendering of Accounts

**Sec. 151.** The infringer shall be liable vis-à-vis the infringed party to render accounts and to have the correctness of such accounts checked by an expert. If a higher amount is revealed than that resulting from accounting, the costs for examination shall be borne by the infringer.

### Information on Origin and Distribution Network

**Sec. 151a.** (1) Who is infringed in one of his powers entitled by his patent may request information on the origin and distribution networks of the infringing goods and services if this would not be disproportional in relation to the seriousness of the infringement and would not breach duties of confidentiality enacted by law; the infringer and such persons are obliged to provide the information who, for commercial purposes,

1. had infringing goods in their possession
2. used infringing services
3. provided services used in infringements.

(2) The duty to provide information referred to in para (1) comprises, as appropriate,

1. the names and addresses of producers, distributors, suppliers and of other previous holders of the goods or services, as well as the intended commercial buyers and retailers;
2. the quantities of the produced, delivered, received or ordered goods and the prices paid for the goods and services.

### Preliminary Injunctions

**Sec. 151b.** (1) With reference to claims to cease and desist, destruction, appropriate compensation, damages and the surrender of the profits according to this Act, preliminary injunctions may be granted for securing the claim as such as well as for securing evidence.

(2) For securing claims to appropriate compensation, damages and surrendering the profits, preliminary injunctions may be granted in case of infringements committed for commercial purposes, if it is likely that compliance with these claims is jeopardised.

(3) For securing claims to cease and desist and destruction, preliminary injunctions may be granted even if the prerequisites named in Sec. 381 of the Regulation of Execution do not apply.

(4) Preliminary injunctions referred to in para (1) may be granted upon request of the claimant without the defendant having been heard, if any delay is likely to cause irreparable harm to the claimant or where there is a risk of evidence being destroyed.

### Employer's Liability

**Sec. 152.** (1) An action for cessation (Sec. 147) may be brought against the owner of an enterprise if a patent infringement has been committed, or is likely to be committed, in his enterprise by a person working for him or on behalf of him. He shall be liable to elimination (Sec. 148) if he is the owner of the infringing objects or infringing means.

(2) If a patent infringement substantiating a claim for adequate financial compensation is committed in an enterprise by a person working for or on behalf of the owner of the enterprise, the obligation for payment of the financial compensation (Sec. 150(1)), for rendering an account (Sec. 151) and for information (Sec. 151a) shall affect the owner of the enterprise only, except where he neither has known of the patent infringement nor has taken advantage of the same.

(3) If a patent infringement is committed in an enterprise by a person working for or on behalf of the owner, the owner of the enterprise shall be liable under Sec. 150(2) to (4) if he was aware of, or must have had knowledge of, the patent infringement, without prejudice to liability of these persons.

### Joint Liability

**Sec. 153.** Insofar as the same monetary claim (Sec. 150) has been brought against several persons, they shall be jointly liable.

### Limitation

**Sec. 154.** Sec. 1489, General Civil Code, shall apply to all monetary claims (Sec. 150), the claim rendering of accounts (Sec. 151) and the claim to information (Sec. 151a). The limitation of all of these claims also shall be interrupted by an action for rendering of accounts or by a petition for declaratory decisions (Sec. 163).

### Process Patents

**Sec. 155.** With a patent on a method or process for the production of a novel product, any product having the same composition shall be regarded as produced according to the patented method or process until proof to the contrary.

### Prejudicial Questions

**Sec. 156.** (1) The validity or effectiveness of a patent on which an infringement action is based shall be judged separately by the court as a prejudicial question being subject to para (3).

(2) The court of the first instance shall forward to the Patent Office for attachment to the grant files a copy of each judgment in which the validity or effectiveness of a patent has been judged, set copy confirming the legal force of such judgment. The Patent Register shall include a reference to such judgment.

(3) If a judgment depends on whether a patent is null and void (Sec. 48), the court shall examine this issue independently first of all. Upon request of the court, the Patent Office shall furnish a written expert opinion on whether the declaration of nullity of the patent is likely because of the documents presented in the judicial proceedings. If the court considers the nullity of the patent likely on the basis of the presentation of evidence, it shall interrupt the proceedings. If the defendant does not prove within one month from the delivery of the interruption decision that he has filed a request for nullity at the Patent Office that nullity proceedings between the parties to the dispute are already pending or that he has joined such proceedings as an intervening third party, the court shall continue proceedings upon request of the plaintiff. In such case, the court shall decide without regard to the objection of nullity. However, any decision of the Nullity Department passed before closure of the hearing shall be taken into consideration.

(4) If proceedings regarding an infringement action have been interrupted under para (3), instead of the proof that he has filed a request for nullity, that nullity proceedings between the parties to the dispute are already pending or that he has joined such proceedings as an intervening third party, the defendant can prove that he has raised an opposition against the patent.

(5) If proceedings before court have been interrupted because of proceedings pending before the Patent Office, the court shall continue proceedings upon a party's request after entry into

force of the decision on the prejudicial question and shall take such decision as a basis therefor.

(6) If the validity or effectiveness of a patent has been judged by the Patent Office or by the Supreme Patent and Trademark Senate differently than by the court in infringement proceedings, this may serve as a basis for an action for re-trial (Sec. 530(1) Code of Civil Procedure); in respect of jurisdiction, Sec. 532(2) Code of Civil Procedure, and in respect of interruption of appeal proceedings, Sec. 544(1) Code of Civil Procedure, shall apply *mutatis mutandis*; the term for bringing an action (Sec. 534(1) Code of Civil Procedure) shall be calculated from the day on which the decision on the validity or effectiveness of the patent has taken legal effect.

#### **Treatment of Prejudicial Proceedings by the Patent Office and by the Supreme Patent and Trademark Senate**

**Sec. 157.** (1) If in proceedings relating to declaration of nullity a decision on interruption (Sec. 156) is presented, the following particulars shall apply to the proceedings as of such presentation:

1. The proceedings shall be handled rapidly.
2. The party who has presented the decision on interruption shall be confirmed immediately by the receiving office on a copy of the cover page that he has brought an action before the Nullity Department, that he has joined pending proceedings as an intervening third party or that he has presented a decision on interruption in respect of pending proceedings.
3. A response (Sec. 115(2)) shall be filed within a month, which term is not extendible.
4. Proof of allegations not presented to the Patent Office and communicated to the adverse party within two weeks before the oral proceedings shall be accepted only if the adverse party has no objections.
5. The terms for filing an appeal (Sec. 138) and a response to the appeal shall be one month and not extendible.

(2) If in proceedings relating to an opposition a decision on interruption (Sec. 156) is presented, para (1) shall apply *mutatis mutandis*.

#### **Provisional Protection**

**Sec. 158.** If before publication of the grant of the patent (Sec. 101c(2)) a claim under Sec. 101(5) is lodged before court and if the judgment depends on whether this claim lawfully exists, the court may interrupt the proceedings up to the publication of the grant. The interrupted proceed-

ings shall be continued after the publication of the grant upon request or *ex officio*.

#### **Criminal Patent Infringement**

**Sec. 159.** (1) Any person infringing a patent shall be fined by the court up to 360 times the *per diem* rate. Any person committing the act on a commercial basis shall be sentenced to up to two years of imprisonment.

(2) Likewise, an owner or manager of an enterprise shall be punished who has not prevented a patent infringement committed within the enterprise by a person working for or on behalf of him.

(3) If the owner of the enterprise under para (2) is a company, a cooperative, an association or any other legal entity not belonging to physical persons, para (2) shall apply to the organs of the enterprise if they have become guilty of such restraint.

(4) Para (1) shall not apply to persons working for or on behalf the owner, who have committed the act by order of their employer or ordering party if they could not have been expected to refuse the commitment of this act because of their economic dependence.

(5) Prosecution shall take place only upon request of the infringed party.

#### **Private-Law Claims**

**Sec. 160.** The assertion of claims under Sec. 150 shall be subject to the provisions of Article XXI of the Code of Criminal Procedure, 1975, Fed. Law Gaz. No. 631. Both parties shall be entitled to appeal against the decision on the claim for compensation.

#### **Particularities of Criminal Prosecution**

**Sec. 161.** Criminal proceedings shall be subject to Sec. 119(2) and Sec. 148, 149 and 157, *mutatis mutandis*. Sec. 156 shall apply also *mutatis mutandis* with the proviso, that the one-month term under Sec. 156(3) shall begin with the delivery of a summons to the accused by the criminal court to attest that he has filed a request for nullity at the Patent Office, that nullification proceedings between the parties to the dispute are already pending, that he has joined such proceedings as intervening third party or that he has lodged an opposition. If the accused fails to submit the request for nullification or the opposition in time, the court shall file the request for nullification or opposition *ex officio* where it considers



nullity of the patent to be possible. Parties to such proceedings shall be the court filing the request, the private plaintiff and the accused. The costs arising in such proceedings shall be costs of the criminal proceedings.

### Jurisdiction

**Sec. 162.** (1) Actions and injunctions under this Federal Act shall exclusively fall within the competence of the Commercial Court of Vienna. The Senate (Sec. 7(2) first sentence, Sec. 8(2) Jurisdictional Rules) shall decide irrespective of the value at dispute. This shall also apply to injunctions.

(2) Criminal cases under this Federal Act shall fall within the jurisdiction of the Provincial Court for Criminal Matters in Vienna.

### Requests for Declaratory Decisions

**Sec. 163.** (1) Any person who produces industrially, puts on the market, offers for sale, or uses, an object, applies a process industrially or intends to take such measures, may request a declaratory decision at the Patent Office against the owner of a patent or the exclusive licensee, that the object or the process is covered by the patent neither wholly nor partially.

(2) The patentee or the exclusive licensee may request a declaratory decision at the Patent Office against any person who produces industrially, puts on the market, offers for sale, or uses an object, applies a process industrially or intends to take such measures, that the object or the process is covered by the patent either wholly or partially.

(3) Requests under para (1) and (2) shall be rejected if the adverse party proves that an action for infringement in respect of the same object or the same process was brought before court prior to the submission of the request for a declaratory decision and is pending before court between the same parties.

(4) A request for a declaratory decision shall be related to only one patent plus its patents of addition. The request shall be accompanied by a precise and clear description of the object or process and, if required, drawings, in quadruplicate. One copy of the description, if required, together with the drawings, shall be attached to the final decision.

(5) When judging the scope of protection of the patent which is the subject matter of the declaratory proceedings, the Patent Office shall take into

consideration the contents of the grant files and the prior art proved by the parties.

(6) The procedural costs shall be borne by the requesting party if the adverse party has not provoked the request by his behavior and has acknowledged the claim within the term set for his response.

(7) Otherwise, the provisions for contestation proceedings shall apply to the declaratory proceedings.

### Obligation to Give Information on Patent Protection

**Sec. 165.** Any person who designates objects in a manner suitable to give the impression that they enjoy patent protection shall, upon request, give information on what protective right such designation is based.

### V. BIOPATENT MONITORING COMMITTEE

Sec. 166. (1) The Biopatent Monitoring Committee monitors and assesses the impact of the implementation into Austrian Law of Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions, OJ No. L 213 of 30 July 1998, p.13, with regard to relevant national patents and utility models granted with protective effect for the Republic of Austria.

(2) The Biopatent Monitoring Committee has particularly the duties arising from the resolution of the National Assembly of 16 April 1998, 107/E (XX. GP):

1. inspecting the impact on human rights, animals, plants and ecological systems as well as on consumer protection, agriculture and developing nations of Austrian legal provisions passed to implement the Directive;
2. inspecting the national granting and finding practice, particularly in respect of Sec. 1 para 3 subpara 2 and 3, Sec. 2 first sentence of para 2 as well as Sec. 36 and 37;
3. inspecting if Austrian legal provisions passed to implement the Directive satisfy the following principles:
  - a) no patent protection for methods to clone human beings and to modify the human germ line;
  - b) no patent protection for methods using human embryos and for embryos themselves;
  - c) no further restriction of the "animal protection clause" as defined in Art. 6 para 2 lit. d of the Directive;
  - d) awarding the farmer and stock-breeder privilege pursuant to Art. 11 of the Directive;

e) meeting the obligations resulting from the Convention on Biological Diversity, Fed. Law Gaz. No. 213/1995.

4. Monitoring the implications of research and economic policy, particularly on small and medium-sized enterprises.

(3) The Federal Minister for Transport, Innovation and Technology shall provide the National Assembly with a report on the observations and assessments of the Biopatent Monitoring Committee at three-year intervals. The first such report shall be provided on 30 June 2012.

#### § 167.

(1) The Biopatent Monitoring Committee is comprised of the following members:

1. a representative of the Federal Chancellery;
2. a representative of the Federal Minister of Health;
3. a representative of the Federal Minister of Agriculture, Forestry, Environment and Water Management;
4. a representative of the Federal Minister for Transport, Innovation and Technology;
5. a representative of the Federal Minister of Economy, Family and Youth;
6. a representative of the Federal Minister for Science and Research;
7. a representative of the Bioethics Commission;
8. a representative of the Austrian Chamber of Commerce;
9. a representative of the Austrian Chamber of Agriculture;
10. a representative of the Austrian Federation of Trade Unions;
11. a representative of the Austrian Chamber of Patent Attorneys;
12. a representative of the Austria Bar Association;
13. a representative of the Federation of Austrian Industries;
14. a representative of the Austrian Federation for Industrial Property Rights and Copyrights;
15. a representative of the Austrian Ring of Industrial Patent Engineers;
16. a representative of the Association for Consumer Information.
17. a representative of the Federal Environmental Agency Austria;
18. a representative of Oekobuero - Coordinating body of Austrian environmental organizations.

(2) The Committee shall conduct an open dialogue with interested citizens.

(3) The Chairman of the Biopatent Monitoring Committee and the Deputy Chairman (if any) shall be elected by the members of the Committee. The Committee has quorum if at least half of its members are present. Resolutions are

passed by majority of votes, in the event of a tie the Chairman shall have the deciding vote.

(4) The Committee shall issue rules of procedure and may establish Working Groups. In order to comply with its duties, the Committee is authorised to consult with experts and other respondents and to subcontract work against payment to them.

(5) The Chairman of the Committee shall represent the Committee externally. Activities of Committee members are unpaid and honorary.

(6) The Committee's office at the Patent Office assists the Committee, its Chairman and any established Working Groups with the execution of their duties. The Committee's office shall prepare an estimate of costs and a final statement of accounts for each calendar year.

#### V. FEES

Cancelled (Fed. Law Gaz. No. I 2004/149)

#### VI. TEMPORARY AND FINAL REGULATIONS

##### Temporary Regulations

**Sec. 173.** (1) To patents and patent applications filed before January 1<sup>st</sup>, 1994, when assessing the patentability Sec. 2, subpara 2, when assessing the novelty Sec. 3, as reason for declaration of nullity Sec. 48(1) subpara 2, as well as reason for opposition Sec. 102(2) subpara 2 shall continue to be applied in their versions valid before the entry into force of the Federal Act Fed. Law Gaz. No. 634/1994.

(2) To the duration and the expiration of patents based on patent applications filed before December 1<sup>st</sup>, 1984, Article VI of the Patent Law Amendments 1984, Fed. Law Gaz. No. 234/1984, shall continue to be applicable but the duration of these patents shall be at least 20 years from the application date. To rights claimed by the military or monopoly administration before January 1<sup>st</sup>, 1996, under Sec. 24 and 25, Sec. 24, 25 and 173 subpara 3 in the version valid before January 1<sup>st</sup>, 1996, shall continue to be applicable.

(3) Subject to para 1 above, Sec. 3, para 2, subpara 4, shall continue to apply to patents and patent applications whose application date is prior to the date the Fed. Law, Fed. Law Gaz. I No. 81/2007, comes into force. Sec. 3, para 3, second sentence, shall be applicable to all patent applications pending at the time the Fed. Law, Fed. Law Gaz. I No. 81/2007, is coming into

force, as far as a decision as to the grant of the patent has not been issued.

**Sec. 174.** (1) For patents and patent applications regarding to which the decision on publication has been made before the entry into force of the Federal Act Fed. Law Gaz. I No. 149/2004, Sec. 4(3), Sec. 5(1), Sec. 20(3), Sec. 28(2), Sec. 31, 32, 45(1), Sec. 52(1), Sec. 57(1), Sec. 60(3) lit. a to c, Sec. 62(3) and (4), Sec. 80(1), Sec. 81(2) and (3), Sec. 91(3), Sec. 92a, 92b, 101, 102, 103 to 109, 111, 127(1) and (4), Sec. 128, 129(3), Sec. 156(4) and (5), Sec. 157, 158 and 171(1), (3) and (5) shall continue to be applied in the version valid before the entry into force of the mentioned Federal Act.

(2) For patents and patent applications under para (1), Sec. 81a shall apply in the version of the Federal Act Fed. Law Gaz. I No. 149/2004 with the proviso that announcement the application takes the place of publishing the application.

(3) For patent applications that are regarded as withdrawn on the day the Federal Act Fed. Law Gaz. I No. 149/2004 entered into force, but for which the term of four months set under Sec. 99(5) in the version valid before the entry into force of the mentioned Federal Act has not elapsed before this day, the legal consequence that the application is regarded as withdrawn, shall not take effect, if the requirements prescribed in Sec. 99(5) in the version valid before the entry into force of the mentioned Federal Act are met.

(4) For patent applications, for which the term of two weeks after the delivery of the decision on rejection set under Sec. 99(4) in the version valid before the entry into force of the Federal Act Fed. Law Gaz. I No. 149/2004 has not expired before the day of the entry into force of the mentioned Federal Act, the response can be filed late until the expiration of the term set.

(5) Patent applications for which the order on publication has not been passed before the entry into force of Federal Act Fed. Law Gaz. I No. 149/2004, shall be continued under the provisions on proceedings valid after entry into force of the mentioned Federal Act. The legal consequence of Sec. 99(5) in the version valid before entry into force of the mentioned Federal Act shall not take effect if the term set for response to the official action has not expired yet on the day of the entry into force of the mentioned Federal Act. These patent applications shall be published even after expiration of this term set if a publication cannot take place any more within the term set under Sec. 101(1) in the version of the mentioned Federal Act.

(6) For the patent applications mentioned in para (5), the late submission of information mentioned in Sec. 87a(2) subpara 3 can take place until finishing the technical preliminary work for the publication if the term set in Sec. 87a(3) subpara 1 in the version of the Federal Act Fed. Law Gaz. I No. 149/2004 has already expired on the day of entry into force of the mentioned Federal Act.

(7) For the patent applications mentioned in para (5) for which a term for separate application under Sec. 92a para (1), (2), (3) or (4) in the version valid before entry into force of the Federal Act Fed. Law Gaz. I No. 149/2004 has been set, this term shall be considered as not having been set and the separate application can be filed until the expiration of the term set in Sec. 92a of the version of the mentioned Federal Act.

(8) Sec. 92b last sentence in the version of the Federal Act Fed. Law Gaz. I No. 149/2004 shall not apply to applications for conversion that have been filed before entry into force of the mentioned Federal Act.

**Sec. 175.** (1) Sec. 49(5) to (7) in the version valid before entry into force of the mentioned Federal Act shall continue to apply to applications for disentanglements filed before entry into force of the Federal Act Fed. Law Gaz. I No. 149/2004.

(2) Sec. 145a and 145b in the version of the Federal Act Fed. Law Gaz. I No. 149/2004 shall apply if the decision of the Appeal Department is passed after the day lying before entry into force of the mentioned Federal Act.

(3) Sec. 150(3), Sec. 156(3) to (5) and Sec. 161 in the version before the entry into force of the mentioned Federal Act shall continue to apply to action brought in before entry into force of the Federal Act Fed. Law Gaz. I No. 149/2004.

(4) A written power of attorney under Sec. 21(1) in the version of the Federal Act Fed. Law Gaz. I No. 149/2004 can only be considered as reference power of attorney if it is presented to the Patent Office after entry into force of the mentioned Federal Act.

**Sec. 176.** (1) For patent applications filed before the entry into force of the Federal Act Fed. Law Gaz. I No. 149/2004 Sec. 94(2) in the version valid before entry into force of the mentioned Federal Act shall continue to apply.

(2) For applications filed before the entry into force of the Federal Act Fed. Law Gaz. I No. 149/2004, Sec. 95(2), Sec. 132(1), (3) and (4), Sec. 168(1), (2) and (3) first, fourth and fifth sentence in the version valid before entry into force of the mentioned Federal Act shall continue to

apply.

(3) For annuities, the due dates of which lie before the entry into force of the Federal Act Fed. Law Gaz. I No. 149/2004, Sec. 166(2) to (10) in the version valid before the entry into force of the mentioned Federal Act shall continue to apply. This applies also to annuities, the due dates of which lie after the entry into force of the mentioned Federal Act, but that are duly paid before entry into force of the mentioned Federal Act.

**Sec. 176a.** (1) Until the entry into force of Sec. 101 in the version of the Federal Act Fed. Law Gaz. I No. 149/2004 (Patents Act and Fees Amendment 2004)

1. Sec. 81a in the version of the Federal Act Fed. Law Gaz. I No. 42/2005 (Amendment implementing the Directive on the legal protection of biotechnological inventions) has to be applied with the proviso that the announcement takes the place of the publication,
2. Sec. 87a para (3) subpara 1 in the version of the Federal Act Fed. Law Gaz. I No. 42/2005 (Amendment implementing the Directive on the legal protection of biotechnological inventions) has to be applied with the proviso that the late submission of information mentioned in Sec. 87a para (2) subpara 3 can take place until the decision on publication is made,
3. Sec. 87a para (3) subpara 2 in the version of the Federal Act Fed. Law Gaz. I No. 42/2005 (Amendment implementing the Directive on the legal protection of biotechnological inventions) shall not be applied.

(2) Until the entry into force of Sec. 48 in the version of the Federal Act Fed. Law Gaz. I No. 42/2005 (Amendment implementing the Directive on the legal protection of biotechnological inventions) Sec. 48 prior the entry into force in the version of said law shall be applied with the proviso that the term "biological material" takes the place of the term "microorganism".

### Final Regulations

**Sec. 177.** Provisions of other Federal Acts referred to in this Federal Act shall be applied in their respective valid version if not otherwise defined.

**Sec. 178.** All person related terms under this Federal Act shall relate to both sexes irrespective of the form chosen.

Sec. 178a. The term "Beschwerdeabteilung" (Appeal Department) relating to the Appeal Department of the Patent Office in this Federal Act and

in provisions of other Federal Acts shall be replaced by the term „Rechtsmittelabteilung“ (Legal Remedies Department) in the grammatically correct form as appropriate.

**Sec. 179.** The execution of this Federal Act shall lie with:

1. the Federal Government in respect of Sec. 51,
2. the Federal Minister of Justice in respect of Sec. 49(4), Sec. 147 to 156, 158 to 162 and 165,
3. the Federal Minister for Transport, Innovation and Technology and the Federal Minister of Justice in respect of Sec. 74(2) and (3) where it relates to the appointment of judges as well as in respect of Sec. 126,
4. the Federal Minister for Transport, Innovation and Technology in agreement with the Federal Minister of Foreign Affairs in respect of Sec. 57(2),
5. the federal Minister for Transport, Innovation and Technology in agreement with the Federal Minister for Economy, Family and Youth in respect of Sec. 58b para 6,
6. the Federal Minister for Transport, Innovation and Technology in respect of all other provisions of this Federal Act.

**Sec. 180.** (1) Sec. 21, 60(4) and (5), Sec. 64(3) and (4), Sec. 68, 78(1), Sec. 79, 89(1), Sec. 90, 94(2), Sec. 99(5), Sec. 166(3) and (4), Sec. 168, 169, 171(2), the heading of Sec. 172a, Sec. 172a, the heading of the VI. section as well as Sec. 173 in the version of the Federal Act Fed. Law Gaz. No. 418/1992 shall enter into force with the beginning of the fourth month following upon the publication of the Federal Act Fed. Law Gaz. No. 418/1992.

(2) Sec. 167 shall become invalid with the end of the third month following upon the publication of the Federal Act Fed. Law Gaz. No. 418/1992.

(3) Sec. 4(3), Sec. 21, Sec. 48(1) subpara 2, Sec. 50, Sec. 77, Sec. 81(3), Sec. 90, Sec. 91a(1), the heading of Sec. 92b, Sec. 92b, Sec. 102(2) subpara 2 and 4 as well as Sec. 102(5) in the version of the Federal Act Fed. Law Gaz. No. 212/1994, shall enter into force on April 1, 1994.

(4) Sec. 22 and 28(1), Sec. 36, 37 and 47(1), 80(1), Sec. 81(7), Sec. 110 and 112(2), Sec. 137(2), Sec. 155 and 166(3), Sec. 173 subpara 2 to 7 as well as Sec. 173a in the version of the Federal Act Fed. Law Gaz. No. 181/1996, shall enter into force as of January 1st, 1996.

(5) Sec. 24, 25, the heading of Sec. 29, Sec. 29, the heading of Sec. 38, Sec. 38 to 42 and 47(3), Sec. 110(2), the heading of Sec. 164 as well as



Sec. 164, 172 and Sec. 173 subpara 3 shall become ineffective with the end of December 31st, 1995.

(6) Sec. 3(2), Sec. 58(2), Sec. 58a and 60 (3) lit.d, Sec. 61(6), Sec. 62(4) subpara 3 to 5, Sec. 64 (3) to (5), Sec. 70 (5), Sec. 81 (4), Sec. 93a, 93b and 94(1), Sec. 95(1), Sec. 166 (1), Sec. 172b and 172c as well as Sec. 173 subpara 2 in the version of Federal Act Fed. Law Gaz. I No. 175/1998 shall enter into force with the beginning of the second month following upon the publication of the Federal Act Fed. Law Gaz. I No. 175/1998. Simultaneously, Sec. 62(4) subpara 3 in the version valid up to now and Sec. 110 with its heading shall become ineffective.

(7) Sec. 36(4) in the version of Federal Act Fed. Law Gaz. I No. 175/1998 shall enter into force on January 1, 1996.

(8) Sec. 78(1), Sec. 82(2), Sec. 83, 120(5), Sec. 166(1), (3) and (4) and Sec. 168 (1), (3) and (4) in the version of Federal Act Fed. Law Gaz. I No. 143/2001 shall enter into force on January 1, 2002.

(9) Sec. 3(4), Sec. 5(1), Sec. 7(1), Sec. 20 (3) and (5), Sec. 21(1) and (2), Sec. 22 (3) to (5), Sec. 22a, 28(2), Sec. 31, 32, 43(5), Sec. 45(1), Sec. 48 (1) subpara 1, 3 and 4, Sec. 48(3), Sec. 49(5) to (7), Sec. 50, 52(1), Sec. 57(1), Sec. 57b, 58b(3), Sec. 60(3), Sec. 62(3) and (4), Sec. 62a, 63(2), Sec. 64(2), (4) and (5), Sec. 68, 69, 70(2) and (5), the heading of Sec. 71, Sec. 71, 72(2), Sec. 73(4), (8) and (9), Sec. 74(1), (4), (10) and (11), Sec. 76 (2) to (4), Sec. 78 (2) and (3), Sec. 79(1), Sec. 80(1) and (2), Sec. 81(2) and (3), Sec. 81a, 82(2) and (5), Sec. 83, 84(1), Sec. 87(1), Sec. 87a(2) and (3), Sec. 91(3), Sec. 91a, 92a, 92b, 93(1), Sec. 94, 95(2), the heading of Sec. 99, Sec. 99, 100, the heading of Sec. 101, Sec. 101, 101a, the heading of Sec. 101b, Sec. 101b, the heading of Sec. 101c, Sec. 101c, the heading of Sec. 101d, Sec. 101d, 102, 103(2) to (6), Sec. 104, 105, the heading of Sec. 107, Sec. 107, the heading of Sec. 108, Sec. 108, 112(2), Sec. 114(3), Sec. 115(2), the heading of Sec. 115a, Sec. 115a, 120(4) and (5), Sec. 122(1), Sec. 125, 127(1) and (4), Sec. 128, the heading of Sec. 128a, Sec. 128a, 129(2) subpara 2, Sec. 129(3), Sec. 137(2), Sec. 138(2), Sec. 139(2) and (3), Sec. 141, 142(1) subpara 1, the heading of Sec. 145a, Sec. 145a, the heading of Sec. 145b, Sec. 145b, 148, 150(3) and (4), the heading of Sec. 151a, Sec. 151a, 152(2) and (3), Sec. 154, 156(3) to (6), the heading of Sec. 157, Sec. 157, the heading of Sec. 158, Sec. 158, 159, 160, 161, the heading of the VI. section, the heading of Sec. 173, Sec. 173 to 176, the heading of Sec. 177 and Sec. 177 to 179 in the version of the Federal Act Fed. Law Gaz. I. No.

149/2004 shall enter into force with the beginning of the seventh month following upon the publication of the mentioned Federal Act. Simultaneously, Sec. 4(3), Sec. 49(6), Sec. 76(5), Sec. 90, the heading of Sec. 106, Sec. 106, the heading of Sec. 109, Sec. 109, the heading of Sec. 111, Sec. 111, Sec. 129(2) subpara 3, Sec. 132, the V. section, Sec. 172b, 172c and 173a in the version valid up to now shall become ineffective.

(10) Sec. 21(4) and (5), Sec. 58, 58a(4), Sec. 60(1) and (2), Sec. 61, 72(1), Sec. 74(3), Sec. 75(1), Sec. 115(1), Sec. 119(3) and Sec. 181 in the version of the Federal Act Fed. Law Gaz. I No. 149/2004 shall enter into force with the beginning of the day following upon the publication of the mentioned Federal Act. Simultaneously, Sec. 59 and 60(4) and (5) in the version valid up to now shall become ineffective.

(11) Sec. 1 para (2) to (4), Sec. 2, 3 para (3), Sec. 22b, 22c, 36 para (2) to (5), Sec. 37, the heading of Sec. 38, Sec. 38, 47 para (1), the heading of Sec. 81a, Sec. 81a, 87a para (2) and (3), Sec. 89a, 102 para (2) subpara 4 and Sec. 182 in the version of the Federal Act Fed. Law Gaz. I No. 42/2005 (Amendment implementing the Directive on the legal protection of biotechnological inventions) shall enter into force with the beginning of the day following upon the announcement of the mentioned Federal Act. Simultaneously, Sec. 36 para (4) to (7) and the heading of Sec. 37 in the version valid up to now as well as Sec. 81a, Sec. 87a para (2) and (3) and Sec. 102 para (2) subpara (4) in the version of the Federal Act Fed. Law Gaz. I No. 149/2004 (Patents Act and Fees Amendment 2004) shall become ineffective.

(12) Sec. 48 para (1) subpara 4 and Sec. 48 para (3) in the version of the Federal Act Fed. Law Gaz. I No. 42/2005 (Amendment implementing the Directive on the legal protection of biotechnological inventions) shall enter into force with the entry into force of Sec. 101 in the version of the Federal Act Fed. Law Gaz. I No. 149/2004 (Patents Act and Fees Amendment 2004). Simultaneously, Sec. 48 para (1) subpara 4 and Sec. 48 para (3) in the version of the Federal Act, Fed. Law Gaz. I No. 149/2004 (Patents Act and Fees Amendment 2004), shall become ineffective.

(13) Sec. 159 (3) in the version of the Federal Act Fed. Law Gaz. No. 151/2005 is coming into force per 1 January 2006.

**Sec. 180a.** (1) Sec. 22 (1), Sec. 57a, 60 (3), Sec. 61 (3), Sec. 62 (2) and (7), Sec. 81 (4), the heading before Sec. 111a, Sec. 111a (3) and Sec. 181a in the version of the Federal Act, Fed. Law Gaz. I No. 130/2005 are coming into force with



the beginning of the following day of the announcement of said Federal Act.

(2) Sec. 64 (4), Sec. 67 (1), Sec. 75 (2), Sec. 79 (2), Sec. 92 and 95(3) in the version of the Federal Act, Fed. Law Gaz. I No. 130/2005 are coming into force per 1 January 2006.

(3) The decree of 2 October 1965 of the Federal Ministry for Commerce and Reconstruction on the nature and wearing of the official robes of the members of the Supreme Patents and Trademarks Senate, Fed. Law Gaz. No. 293/1965, the decree of the Federal Minister for Economic Affairs on the implementation of the Patents Act 1970, the Act Introducing Patent Treaties (Act Introducing the European Patent Convention and the Patent Cooperation Treaty), the Act concerning Supplementary Protection Certificates 1996 (Protection Certificate Act), the Act concerning Utility Models, the Act concerning the Protection of Semiconductors, the Trademarks Protection Act 1970 and the Design Protection Act 1990 (Regulation on Patents, Utility Models, Trademarks and Designs - PGMMV), Fed. Law Gaz. No. 226/1994, and the decree of the Federal Minister for Economic Affairs on the release of official publications of the Patent Office, Fed. Law Gaz. II No. 237/1997, cease to be in force per 31 December 2005.

(4) Sec. 151a, the heading of Sec. 151b, Sec. 151b and Sec. 183 in the version of the Federal Act, Fed. Law Gaz. I No. 96/2006, come into force with the beginning of the day following the announcement of the mentioned Federal Act.

(5) Sec. 1 para 1, Sec. 3 para 2 and 3, Sec. 22A, 60 para 3 subpara 1, and Sec. 173 para 3 in the version of the Fed. Act, Fed. Law Gaz. No. I 81/2007, are coming into effect with the entry into force of the revised European Patent Convention.

(6) Sec. 21 para 4 in the version of Fed. Act, Fed. Law Gaz. I No. 81/2007, comes into force with the beginning of the day following the announcement of said Federal Act.

(7) Sec. 54 para 2, Sec. 58b para 6, Sec. 74 para 9, Sec. 157 para 1 subpara 2, Sec. 178a and 179 subpara 5 and 6 in the version of Fed. Act, Fed. Law Gaz. I No. 126/2009 shall come into force on 1 January 2010.

(8) Sec. 58 para 1, Sec. 58a para 1 and 2, Sec. 58b para 3 and 5, Sec. 60 para 3 subpara 1,

Sec. 62 para 1, Sec. 64 para 2 second sentence and the V. section in the version of Fed. Act, Fed. Law Gaz. I No. 126/2009 shall come into force with the beginning of the day following the announcement of said Federal Act.

Sec. 180b. Sec. 76 para 1 subpara 2 in the version of Fed. Act, Fed. Law Gaz. I No. 135/2009 shall come into force on 1 January 2010.

**Sec. 181.** Decrees on the basis of this Federal Act in its respective valid version may be already enacted starting with the day following the announcement of the Federal Act which is to be carried out; however, they shall not come into force before the legal provisions to be carried out.

**Sec. 181a.** (1) By this Federal Act Art. 10 (6) of the Directive 2001/83/EC on the Community code relating to medicinal products for human use, amended by the Directive 2004/27/EC of the European Parliament and Council of 31 March 2004 on the amendment of the Directive 2001/83/EC, OJ No. L 136 of 30 April 2004 p. 34, is implemented.

(2) By this Federal Act Art. 13 (6) the Directive 2001/82/EC on the Community code relating to veterinary medicinal products, amended by the Directive 2004/28/EC of the European Parliament and Council of 31 March 2004 on the amendment of the Directive 2001/82/EC, OJ No. L 136 of 30 April 2004 p. 58, is implemented.

**Sec. 182.** By this Federal Act the Directive 98/44/EC of the European Parliament and Council of 6 July 1998 on the legal protection of biotechnological inventions, OJ No. L 213 of 30 July 1998 p. 13, is implemented.

**Sec. 183.** By this Federal Act the Patents Act is adapted to the Directive 2004/48/EC of the European Parliament and Council on the enforcement of intellectual property rights, OJ No. L 157 of 30 April 2004 p. 45.