

**AUSTRIA**  
**Utility Model Act**

BGBl. No. 211/1994 as amended by BGBl. Nos. 175/1998 and 143/2001

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## **I. GENERAL PROVISIONS**

### **Section 1 Subject Matter**

(1) Upon application inventions which are new (Section 3), which are based on an inventive step and which are susceptible to industrial application shall be protected as utility models.

(2) The programm logic on which programs for data processing systems are based shall also be regarded as an invention as defined by subsection (1).

(3) The following in particular shall not be regarded as inventions as defined by subsection (1):

1. discoveries, scientific theories, and mathematical methods;
2. aesthetic creations;
3. schemes, rules and methods for performing mental acts, for playing games or for doing business, and programs for data processing systems;
4. presentations of information.

(4) The provisions of subsection (3) shall exclude the protection as utility models of the subject matter or activities referred to in that subsection only to the extent to which protection is demanded for them as such.

### **Section 2 Exceptions**

The following shall not be protected as utility models:

1. inventions the publication or exploitation of which would be contrary to "ordre public" or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by regulations;
2. methods for treatment of humans by surgery or therapy and diagnostic methods practiced on humans; this shall not apply to products, in particular substances or compositions, for use in any of these methods;
3. plant or animal varieties (animal races) including microorganisms or essentially biological processes for the production of plants or animals.

### **Section 3 Novelty**

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

(2) As state of the art shall also be considered the contents of earlier priority date.

1. utility model applications on the basis of this Federal Law,
2. patent applications on the basis of the 1970 Patents Act, Federal Law Gazette no. 259,
3. international applications in the meaning of section 1, (6) of the Act Introducing Patent Treaties, Federal Law Gazette no. 52/1979, provided the conditions as set out in section 16, subsection 2 of the Act Introducing Patent Treaties are fulfilled, and
4. European patent applications in the meaning of section 1, (4) of the Act Introducing Patent Treaties, provided the conditions of article 79, subsection 2 of the European Patent Convention, Federal Law Gazette no. 350/1979, or, where the European patent application was filed on the basis of an international application, the conditions of article 158, subsection 2 of the European Patent Convention are fulfilled,

in the version as originally filed whose contents were not officially published before the priority date of the later applications or thereafter. When assessing the question whether the invention is not obvious to the person skilled in the art from the prior art, such applications of an earlier priority date are not taken into consideration.

(3) The protectability of substances or compositions that are comprised in the state of art shall not be excluded by subsection (1) if intended for use in a method referred to in Section 2(2) or in any such method for animals and unless their use in any of these methods is part of the state of art.

(4) For the application of subsection (1) a disclosure of the invention shall not be taken into consideration if it occurred not earlier than six months prior to the filing date of the application and if it was directly or indirectly due to:

1. the applicant or his legal predecessor, or
2. an evident abuse to the prejudice of the applicant or his legal predecessor.

#### **Section 4 Effect**

(1) The utility model shall entitle the owner of the utility model to

exclude others from industrially producing the subject of the invention, from putting it on the market, offering it for sale or working it; in the case of a process the effect shall extend also to the products manufactured directly by that process.

(2) The extent of protection conferred by the utility model shall be determined by the terms of the valid claims. The specification and the drawings shall be used to interpret the claims. For this purpose the Protocol on the Interpretation of Article 69 of the European Patent Convention, Federal Law Gazette No. 350/1979, shall apply *mutatis mutandis*.

(3) The utility model shall have no effect in the case of vehicles and fittings of vehicles which enter Austria only temporarily in the course of their use in traffic.

#### **Section 5 Right of Prior User**

(1) A utility model shall not be effective against a person who had already used the invention in good faith in Austria or had made the necessary arrangements for doing so before the priority date (prior user).

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

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

(4) The prior user may request a document from the owner of the utility model recognizing his right. Recognition of the right shall be entered in the Utility Model Register at the request of the prior user.

(5) If such recognition is refused, the Patent Office shall, upon request, decide that matter and may order that such right be entered in the Utility Model Register.

#### **Section 6 Period of Protection**

The period of protection of the utility model shall start as from the date of the official publication of the utility model (Sec. 23) and shall end no later than ten years after the end of the month in which the application for the utility model was filed.

### **Section 7 Right to Utility Model Protection**

(1) The inventor or his successor in title shall be entitled to utility model protection.

(2) The sections 6 to 17 and 19 of the Patents Act 1970, Federal Law Gazette No. 259, shall apply mutatis mutandis.

### **Section 8 Naming of the Inventor**

(1) The inventor shall be entitled to be named as the inventor in the official publication, in the utility model register, in the utility model document, in the utility model certificate and in the priority documents to be issued by the Patent Office.

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

(3) The request for naming may be made by the inventor, by the applicant or by the owner of the utility model. Where several persons are entitled to make the request the party making the request shall produce proof that the other persons entitled agree, unless the request is made jointly by all those entitled. Where a person other than the one already named as inventor is to be named as such in addition to or in place of the person so named, proof of the consent of the person already named shall also be produced.

(4) Where the applicant, the owner of the utility model or the person already named as inventor refuses his consent, the Patent Office shall decide, upon request, on the right to be named as an inventor. The inventor shall be named pursuant to subsec. (1) on the basis of a final decision granting such request.

### **Section 9 Relationship of Several Utility Model Owners**

The legal relationship of a plurality of utility model owners shall be governed by civil law. The right to permit third parties to work the utility model shall in case of doubt be exercised only by all the utility model owners jointly; each individual utility model owner may, however, bring proceedings for infringement.

### **Section 10 Transfer**

(1) The right arising from an application for a utility model and the utility model may be transferred either wholly or in imaginary shares.

(2) Such rights shall not pass to the State (Sec. 760 of the Austrian Civil Code).

#### **Section 11 Liens**

The utility model may be subject to a lien.

#### **Section 12 Expiry**

(1) A utility model shall expire

1. on completion of the maximum duration;
2. if an annual fee is not paid in time;
3. if the utility model is abandoned by the utility model owner.

(2) Where the waiver relates only to certain parts of the utility model (restriction), the utility model shall remain valid with regard to the other parts. In this connection there shall be no examination by the Patent Office if the remaining parts still comply with the provisions of this Act and if the restriction is admissible.

(3) Expiry shall take effect on the day following completion of the maximum duration in the case set out in subsec. (1)1., on the day following the expiry of the last year of validity in the case set out in subsec. (1)2. and on the day following notification of the waiver to the Patent Office in the case set out in subsec. (1)3.

## **II. FILING PROCEDURE**

### **Section 13 Application**

(1) An application of an invention to obtain a utility model shall be filed at the Patent Office in writing. The date of an application's arrival at the Patent Office shall be regarded as the date of filing.

(2) The application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

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

### **Section 14**

(1) The application shall contain:

1. the name and domicile or place of residence of the applicant as well as of his representative, if any;
2. the petition for registration of a utility model;
3. a short, relevant designation of the invention (title);
4. a description of the invention (specification);
5. one or more claims (subsec. (2));
6. the drawing necessary to understand the invention;
7. an abstract (subsec. (3)).

(2) The claims shall define in a clear and distinguishing manner the matter for which protection is sought. They shall be supported by the specification.

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

(4) The parts of the application specified in subsec. (1)4. to 7. shall be filed in duplicate. They may also be filed in English or in French. If parts of the application are written in English or French, a German translation thereof shall be filed within three months as from the filing date. The filing procedure shall be based on such translation; its correctness shall not be examined in the filing procedure. If a translation

is not filed within the time limit, the application shall be deemed withdrawn.

### **Section 15**

The form and content of the application shall be regulated in detail by ordinance. In doing so, consideration shall be paid to maximum expediency and simplicity and to the needs of the publication of the printed copy of the utility model.

### **Section 15a Branching off**

(1) The applicant or holder of a patent filed or granted with effect for the Republic of Austria shall be entitled, during the entire period of the application procedure and until expiry of a deadline of

1. two month after the patent application is considered withdrawn, or
2. two month after the entering into effect of the decision of refusal of the patent application, or
3. two month after the patent is considered as granted in accordance with section 107 of the 1970 Patents Act, or
4. eleven month after the entry into effect of the decision on the granting of the European patent in the absence of any objection, or
5. two month upon legal validity of the decision on a opposition raised in due time,

to file a utility model application and claim on the application date of the patent application as application date of the utility model application (branching off declaration). Priority rights claimed for the patent application shall be preserved for the utility model application.

(2) The branching off declaration shall be submitted within two month upon receipt of the utility model application at the Patent Office. The date of application and the reference of the patent application shall be indicated, and a copy of the patent application in the version originally filed and, if the patent application was not filed in German, a translation into German submitted.

(3) The applicant shall be granted an extendable period of two months for remedying deficiencies. If the deficiencies have not been remedied within the period stated the branching off declaration shall be regarded as withdrawn.

### **Section 16 Priority**

(1) The applicant shall have the priority right from the date on which his application for a utility model was duly filed.

(2) Separate priority for separate parts of the subject of the application (partial priorities) may be claimed only on the basis of sections 16a or 16b or of intergovernmental agreements. Such partial priorities shall also be admitted where the date of arrival of the application at the Patent Office is decisive for the priority of a feature of the subject of the application. More than one priority may be requested for one claim.

(3) The application fee shall be the single fee multiplied by the number of all priorities claimed for the application. Unless payment of the full amount is duly proved within the time limit set for such payment (Sec. 49), the priority of the application shall be determined by the day of its receipt by the Patent Office (subsec. (1)), and the partial amount paid shall, insofar as it exceeds the single application fee, be refunded.

### **Section 16a**

The applicant shall have the right of priority of a previous patent or utility model application for a period of twelve months following the date of filing a previous patent or utility model application with the Patent Office, if the subsequent utility model application refers to the same invention (internal priority). The conditions and effects of this right of priority shall correspond to those listed in article 4 of the Paris Convention for the Protection of Industrial Property, Federal Law Gazette no. 399/1973.

### **Section 16b**

The applicant shall have the right of priority of a previous patent or utility model application for a period of twelve months following the date of filing a previous patent or utility model application, filed with an application office not covered by the scope of an intergovernmental agreement on recognition of priority, if the subsequent patent application refers to the same invention and if a respective mutuality with this application office is declared by a notice to be published by the Federal Minister for Economic Affairs in the Federal Law Gazette. The conditions and effects of this right of priority shall correspond to those listed in article 4 of the Paris Convention for the Protection of Industrial Property, Federal Gazette no. 399/1973.

## **Section 17**

(1) The rights of priority granted on the basis of section 16a and 16b or of intergovernmental agreements must be expressly claimed. The date and country of the application, the priority of which is claimed, shall be indicated (declaration of priority), as well as the reference number of that application.

(2) The declaration of priority shall be submitted to the Patent Office within two months of the arrival of the application at the Patent Office. Within that period, an amendment of the declaration of priority may be requested. For such request, a fee amounting to half the application fee (Sec. 46(1)) shall be payable. In case of partial priorities (Sec. 16(2)) the fee shall be the multiple corresponding to the number of priorities to be amended.

(3) If the maintenance of the utility model depends on the validity of the claim to priority, the right of priority must be proved. The evidence required for such proof (priority documents) in the proceedings before the Patent Office and before the Supreme Patent and Trademark Chamber and the time of submission shall be laid down by ordinance.

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

## **Section 18 Examination for Compliance with the Law**

(1) Each application shall be examined by the Patent Office for its compliance with the law. An examination for novelty, inventive merit, commercial feasibility as well as whether the applicant is entitled to utility model protection shall, however, not be included in the application procedure. If there are no objections to publishing and registering the utility model, a search report pursuant to Section 19 shall be prepared.

(2) If the examination for compliance with the law shows that there are objections to publishing and registering the utility model, the applicant shall be requested to comment thereon within two months. If on the expiration of the specified period of time it is found that publication and registration are inadmissible, the application shall be rejected.

(3) If there are objections pursuant to subsec. (2) due to the fact that the claims are not uniform, the applicant shall be requested to establish the unity (Sec. 13(3)) and to file, in duplicate, a new uniform version of all claims maintained within the time limit specified in subsec. 2. If these requests are not complied with, the application shall be rejected entirely.

(4) If a separate application is filed for the parts no longer further prosecuted in the original application (subsec. (3)) within the time limit specified in subsec. (2) and if the date on which the original application was filed with the Patent Office is claimed as the filing date, that date shall be deemed the filing date of the separate application.

(5) If amended application documents are submitted, it will not be examined in the application procedure whether such amendment goes beyond the contents of the application in its original version.

#### **Section 19 Search Report**

(1) If there are no objections to publishing and registering the utility model, the Patent Office shall prepare a search report in which the documents found by the Patent Office on the date of preparing the report are cited which may be taken into consideration in assessing the novelty and the inventive merit.

(2) The search report shall be based on the claims. Sec. 4(2) sentences 2 and 3 shall apply mutatis mutandis. The search report shall be prepared within six months as from the filing date, if possible.

(3) Unless the applicant files a petition for accelerated publication and registration (Sec. 27), the search report shall be delivered to the applicant with the request to pay the publication fee (Sec. 46(2)) within a period of two months as from delivery of the report and to duly prove the payment (Sec. 49). Upon justified request the time limit shall be extended once for a period of two months.

(4) The applicant may amend the claims within the time limit specified in subsec. (3) by filing a new version of all claims that are maintained in duplicate. In such a case there shall be no supplement to or amendment of the search report. There shall be no examination if the amended claims are uniform (Sec. 13(3)). Sec. 18(5) shall apply.

(5) If due payment of the publication fee has not been duly proved (subsec. (3)) or if the amended claims (subsec. (4)) are defective, a time limit of one month shall be fixed for applicant to remedy the deficiencies. Unless the deficiencies are remedied within that period of time, the application shall be rejected.

#### **Section 20 Voluntary Division**

The applicant may voluntarily divide the application until the time limit specified in Sec. 19(3) expires. In the event of a division a new version of all maintained claims in duplicate shall be filed in addition to the original application. If the separate application of the part no longer further prosecuted in the original application is effected at the same time as the divisions of the original application and if in doing so the day on which the original application was filed with the Patent Office is claimed as the filing date, that date shall be deemed the filing date of the separate application.

#### **Section 21 Conversion**

The applicant may request the conversion of the application into a patent application within the terms of the Patents Act 1970, Federal Law Gazette No. 259, until the time limit specified in Sec. 19(3) expires. The date on which the application for the utility model was filed with the Patent Office shall be deemed the filing date of such patent application.

#### **Section 22 Publication and Registration**

If the application complies with the requirements of Sections 18 and 19, the publication of the utility model in the Utility Model Gazette (Sec. 23) and its registration in the Utility Model Register (Sec. 24) shall be ordered.

#### **Section 23**

The publication of the utility model is effected by promulgation of the data specified in Sec. 24 in the Utility Model Gazette (Sec. 40).

#### **Section 24**

On registration, which shall be effected at the same time as publication (Sec. 23), the following shall be entered in the Utility Model Register (Sec. 31) kept by the Patent Office:

1. the register number;
2. the date of the application and the priority claimed, if any;

3. the beginning of the period of protection (Sec. 6);
4. the title of the invention;
5. the name and the registered office or residence of the utility model owner and of his representative, if any;
6. the name and residence of the inventor, if any.

#### **Section 25 Utility Model Document**

(1) The Patent Office shall issue a utility model document for each registered utility model which shall comprise in particular:

1. the data specified in Sec. 24;
2. the version of the specification, claims, drawings and abstract on which the decision of publication and registration of the utility model (Sec. 22, 27(2)) is based;
3. the search report unless the search report is issued separately pursuant to Sec. 27(3).

(2) Upon request public institutions may be given free of charge one copy of any utility model documents and separately issued search reports issued as from the date of receipt of the request if these are made accessible to the public.

#### **Section 26 Utility Model Certificate**

The Patent Office shall issue a utility model certificate to the owner of the utility model. The certificate shall comprise a confirmation of the registration of the utility model as well as a copy of the utility model document.

#### **Section 27 Accelerated Publication and Registration**

(1) The applicant may request the immediate publication and registration of the utility model independent of the date of the completion of the search report. Such request may be made up to the day before the delivery of the search report. The payment of the publication fee (Sec. 46(2)) and of the surcharge for the accelerated publication and registration (Sec. 46(3)) shall be duly proved (Sec. 49) at the same time as filing the request otherwise the request shall be deemed not made.

(2) If as a result of the examination for compliance with the law (Sec. 18) there are no objections to publication and registration, the publication of the utility model in the Utility Model Gazette (Sec. 23) and its registration in the Utility Model Register (Sec. 24) shall be ordered

immediately.

(3) If the search report has not been completed by the time of publication and registration of the utility model, the search report shall not be included in the utility model document (Sec. 25), but issued separately. The search report shall be sent to the utility model owner.

### **III. DECLARATION OF NULLITY, DECLARATION OF LACK OF TITLE AND DECLARATION OF DEPENDENCE**

#### **Section 28 Declaration of Nullity**

(1) Anyone may request the declaration of nullity of a utility model if

1. the utility model does not comply with Sections 1 to 3;
2. if the claims, the specification and the drawings on which the order pursuant to Sec. 22 or Sec. 27(2) is based do not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art
3. if the subject of the utility model goes beyond the contents of the application in the version as originally filed and establishing the filing date.

(2) Where the grounds for nullity apply only in part, the utility model will be declared null and void only in part.

(3) By the final declaration of nullity the effects of the utility model specified in Sec. 4 are deemed not to have taken place from the beginning to the extent that the utility model is declared null and void. If the object of the utility model according to section 3, para. 2 was not protectable, the license rights lawfully granted by the owner of the utility model of the later priority and acquired in good faith by third parties which have been registered in the Utility Model Register for one year and which are not the subject of a legally founded entry relating to a dispute (Sec. 32(3)) shall not be affected by such retroactive effect, this without prejudice to any claims for compensation which may be made against the owner of the utility model of the later priority.

#### **Section 29 Declaration of Lack of Title**

(1) Anyone who alleges that

1. he is entitled to utility model protection instead of the owner of the utility model (Sec. 7), or
2. that the essence of the utility model has been usurped from his descriptions, drawings, models, implements or installations or from a process used by him

may request that the owner of the utility model is declared to lack title to the utility model and that it is assigned to the person so requesting.

Unless an assignment is requested, utility model protection shall end on the day the decision declaring lack of title becomes final.

(2) Where the reason for declaration of lack of title (subsec. (1)) applies only in part, the utility model owner shall be declared only partially lacking in title or the utility model shall be assigned only in part.

(3) The claim against the bona-fide utility model owner shall be barred by limitation within three years as from the date of its registration in the Utility Model Register.

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

(5) In the case of an assignment pursuant to subsec. (1) the license rights lawfully granted by the earlier owner of the utility model and acquired in good faith by third parties that have been registered in the Utility Model Register of at least one year shall, provided they are not the subject of a legally founded entry relating to a dispute (Sec. 32(3)), not be affected by such retroactive effect, this without prejudice to any claims for compensation which may be made against the owner of the utility model of the later priority.

### **Section 30 Declaration of Dependence**

The owner of a utility model of an earlier priority date or of a patent of an earlier priority date may apply for a decree that the commercial use of a utility model entails the full or partial use of his invention protected by a utility model or patent.

#### **IV. UTILITY MODEL REGISTER**

##### **Section 31**

(1) In addition to the data mentioned in Sec. 24, the expiration of utility model protection, the declaration of nullity, the declaration of lack of title, the declaration of dependence, the designation as the inventor as well as the assignment of utility models, liens and other rights in rem relating to utility models, licenses, the employer's right of use, rights of prior user, restoration of rights, decisions relating to declaration and entries of disputes as well as indications of rulings transmitted pursuant to Sec. 41 applying Sec. 156(2) of the Patents Act 1970, Federal Law Gazette No. 259, mutatis mutandis shall be registered in the Utility Model Register.

(2) Any person may inspect the Utility Model Register. A certified extract from the Register shall be issued upon request.

##### **Section 32**

(1) Rights in rem relating to utility models as well as the utility model itself in the event of its assignment (Sec. 10) shall be acquired upon registration in the Utility Model Register.

(2) The petition for registration shall be accompanied by the original or a duly certified copy of the document on which the entry is to be based. Any document other than a public document shall bear the duly certified signature of the person alienating his right.

(3) Legal disputes relating to utility models shall be entered into the Utility Model Register upon request (entry relating to legal dispute).

(4) For the rest, Sec. 43 subsec. 2, 3, 4, 5 and 7 (entries in the Patent Register), Sec. 44 (charges) and Sec. 45(2) (entries relating to legal dispute) of the Patents Acts 1970, Federal Law Gazette No. 259, shall apply mutatis mutandis.

(5) Subsec. (2) as well as Sec. 43 subsec. 5 and 7 of the Patents Act 1970, Federal Law Gazette No. 259, shall apply mutatis mutandis to the assignment of the right arising from the application for a utility model.

## **V. RESPONSIBILITY AND PROCEDURE**

### **Section 33 General**

(1) Unless otherwise provided in this Federal Act, the Patent Office shall be responsible for taking decisions and handling other matters relating to utility model protection. In the Patent Office:

1. the Technical Division shall be responsible for the filing procedure, the preparation of the search report and for taking note of a waiver of a utility model;
2. the Legal Division shall be responsible for the procedure in matters relating to the assignment of the right arising from the utility model application, to other forms of alienation of such right, to registered utility models - with the exception of the preparation of the search report and taking note of a waiver of the utility model - or the petitions for restoration of rights, to the extent that the Appeal or Nullity Division is not responsible;
3. the Appeal Division shall be responsible for the appeals procedure;
4. the Nullity Division shall be responsible for the procedure relating to petitions for declaration of nullity, lack of title, for a declaration of dependence, for the naming of a person as the inventor, for the recognition of the right of prior user and petitions for declaratory statements;
5. the President's Division shall be responsible for handling matters reserved to the President and all matters not falling within the competence of another division.

(2) The Sections 51 to 56, 57(2), Sections 57b to 59, 60(1), (2), (4) and (5), Sections 61, 64, 66 to 69, 76(1), (4) and (5), Sections 77 to 79, 82 to 86, 126 to 136 of the Patents Act 1970, Federal Law Gazette No. 259, shall apply mutatis mutandis.

### **Section 34**

(1) Decisions and orders within the purview of the Technical Division shall be the responsibility of the competent technically qualified member (examiner).

(2) Sec. 62(2) of the Patents Act 1970, Federal Law Gazette No. 259, shall apply mutatis mutandis to the decisions and orders of the Legal Division.

(3) Prior to decisions pursuant to subsection (1) the examiner shall obtain the opinion of the legally qualified member if a decision on the

protectability of the utility model on the basis of Sec. 2 or on an administrative or disciplinary penalty is to be made.

### **Section 35 Appeal**

(1) The decisions of the Technical Division and Legal Division may be appealed against. The appeal shall contain a substantiated formal petition for appeal and shall be lodged with the Patent Office within two months from the date when the decision was served.

(2) Appeals lodged in due time shall have suspensive effect. Appeals arriving after the time limit referred to shall be dismissed by the Division competent in the first instance. Inadmissible appeals as well as appeals which do not comply with the legal requirements shall, without further proceedings, be dismissed by the Appeal Division; in the case of defects of form, however, an appeal may be dismissed only after the appellant has failed, on request, to remedy the defects.

(3) The Appeal Division shall deliberate and take decisions in boards consisting of

1. three technically qualified members and one legally qualified member in cases of appeals against decisions of the Technical Division, and
2. of three members, two of whom being legally qualified members, in cases of appeals against decisions of the Legal Division.

(4) If decisions on appeals against decisions of the Legal Division are to be taken, the chairman of the Appeal Division shall be legally qualified.

(5) The presence of three members shall suffice for interim decisions of the Appeal Division.

(6) There shall be no further instance or an appeal to the Administrative Court against a decision of the Appeal Division. A petition for amendment of preliminary orders of the rapporteur and of interim decisions may, however, be filed with the Appeal Division itself.

(7) Sec. 71 subsec. 2 and 4 as well as Sec. 72 and 73 of the Patents Act 1970, Federal Law Gazette No. 259, shall apply mutatis mutandis.

### **Section 36 Procedure before the Nullity Division**

(1) The Nullity Division shall hear the petitions and claims referred

to in Sec. 33 subsec. (1) para. 4, subject to subsec. (3) applying Sec. 112 to 125 of the Patents Act 1970, Federal Law Gazette No. 259, mutatis mutandis in boards comprising two legally qualified and three technically qualified members.

(2) The chairmen of the Nullity Division shall be legally qualified. The presence of three members shall suffice for interim decisions in the Nullity Division.

(3) Unless the owner of the utility model files a counter-statement to the petition for declaration of nullity of the utility model (Sec. 28) within the time limit granted to him pursuant to subsec. (1) in connection with Sec. 115(2) of the Patents Act 1970, Federal Law Gazette No. 259, the Nullity Division shall declare the utility model null and void to the extent requested.

### **Section 37 Supreme Patent and Trademark Chamber**

(1) Appeals against final decisions of the Nullity Division may be lodged with the Supreme Patent and Trademark Chamber. The appeal shall be lodged with the Patent Office in writing within two months from the date when the decision was served. It shall contain a substantiated formal petition for appeal.

(2) Appeals lodged in due time shall have suspensive effect. Appeals arriving after the time limit referred to or appeals not containing a substantiated formal petition for appeal or which are not corrected within the time limit set by the Nullity Division shall be dismissed by the Nullity Division.

(3) No separate appeal may be lodged against preparatory orders and interim decisions of the Nullity Division, but their amendment may be requested from the Division itself. They may be contested by an appeal to the Supreme Patent and Trademark Chamber only if they have affected the final decision.

(4) The Sec. 74, 75, 138(4), Sec. 139 subsec. (1), (2), (4) and (5) as well as Sections 140 to 145 of the Patents Act 1970, Federal Law Gazette No. 259, shall apply mutatis mutandis.

### **Section 38 Inspection of the Files**

(1) The parties to proceedings may inspect the files relating to those proceedings.

(2) Any person may inspect the files relating to published utility models (Sec. 23).

(3) Third parties may not inspect the files relating to unpublished utility models without the consent of the applicant. The consent of the applicant shall not be required for any person against whom the applicant has invoked the rights under the utility model application. Upon publication of a utility model based on a separate application, any person may inspect the files of an earlier application without the applicant's consent.

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

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

(6) Records of deliberation and parts of files relating solely to internal administrative transactions shall not be accessible to the public. On request also parts of files not requiring a laying open to public inspection for information purposes may also be excluded, if they refer to a trade or industrial secret or if there is another good reason therefor.

### **Section 39 Representatives**

(1) Anyone acting as a representative in matters of utility model protection before the Patent Office or before the Supreme Patent and Trademark Chamber shall have his residence or place of business in Austria; however, professional laws and regulations shall apply to attorneys at law, patent attorneys and notaries. The representative shall prove his authorization by producing the original written power of attorney or a certified true copy thereof. A separate power of attorney shall be filed for each utility model application. The same shall apply if a representative is empowered with respect to a published utility model. If a power of attorney has been granted to a plurality of persons, each may solely act as a representative.

(2) If an attorney at law, patent attorney or notary acts as a representative, he may refer to the authorization granted to him without actually presenting documentary evidence. However, an authorization to assign a utility model shall in any case be proved by a written power of attorney which has to be duly certified.

(3) If a representative acts without a power of attorney or, in the event of subsec. (2), without referring to the authorization granted to him, the action in the proceedings taken by him shall be valid only on condition that he submits a proper power of attorney or refers to the authorization granted to him within the reasonable time limited prescribed therefor.

(4) Anyone having neither residence nor place of business in Austria may claim rights under this Federal Act before the Patent Office and before the Supreme Patent and Trademark Chamber only if he is represented by an attorney at law, patent attorney or notary; this shall not apply to the use of customer and information services of the Patent Office.

(5) The place in which the representative has his Austrian residence or his Austrian place of business and in the absence of a representative with an Austrian residence or Austrian place of business the place in which the Patent Office is established shall, in matters concerning the utility model, be deemed the residence or place of business of a utility model owner having neither his residence nor place of business in Austria.

(6) The authorization granted to an attorney at law, patent attorney or notary to act as a representative before the Patent Office shall empower him by law to exercise all rights under this Federal Act before the Patent Office and before the Supreme Patent and Trademark Chamber, in particular to file utility model applications, restrict or withdraw applications, waive utility models, file and withdraw petitions or appeals to be dealt with by the Nullity Division, conclude compromises, accept service of documents of any kind and receive payment of official fees and of the cost of proceedings and representation from the adverse party and appoint an agent.

(7) The authorization pursuant to subsec. 6 may be limited to a particular right and to representation in particular proceedings. However, it shall not expire on the death of the principal or as a result of a change in his legal capacity.

(8) If a representative other than an attorney at law, patent attorney or notary is to have also the power to waive a utility model in whole or in part, he must be expressly authorized to do so.

**Section 40 Utility Model Gazette**

The Patent Office shall issue periodically an official Utility Model Gazette (Gebrauchsmusterblatt) containing in particular promulgations pursuant to Sec. 23, publications as to the end of utility model protection, partial waivers, changes of name and changes of the person of the utility model owner as well as publications to be made pursuant to Sec. 33(2) applying Sections 128 and 133(3) of the Patents Act 1970, Federal Law Gazette No. 259, mutatis mutandis.

## **VI. INFRINGEMENTS OF UTILITY MODELS AND PETITIONS FOR DECLARATORY DECISIONS**

### **Section 41 Utility Model Infringements**

Any person who has suffered an infringement of his utility model (Sec. 4) shall be entitled to demand an injunction, elimination, publication of the judgment, reasonable compensation, damages, surrender of the profits realized and accounting; any person who worries that such an infringement might take place may also demand an injunction. Sections 147 to 164 of the Patents Act 1970, Federal Law Gazette No. 259, shall apply mutatis mutandis.

### **Section 42**

(1) Any person who infringes a utility model shall be condemned by the court to a fine of up to 360 times the per diem rate for calculating fines.

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

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

(4) Sections 160, 161 and 164 of the Patents Act 1970, Federal Law Gazette No. 259, shall apply to the criminal proceedings mutatis mutandis.

### **Section 43 Obligation to Provide Information**

Any person who designates products in a manner likely to give the impression that they enjoy utility model protection shall on request provide information regarding the utility model on which such designation is based.

### **Section 44 Jurisdiction**

(1) The Commercial Court of Vienna shall have exclusive jurisdiction for actions and injunctions under this Federal Act. The board (Sec. 7(2) first sentence, Sec. 8(2) of the Rules of Jurisdiction) shall decide irrespective of the value of the matter in dispute. The same shall apply to injunctions.

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

#### **Section 45 Petitions for Declaratory Decisions**

(1) Any person who produces industrially, who puts on the market, offers for sale or uses an object, applies a process on an industrial scale or intends to take such steps may apply to the Patent Office for a declaration against the owner of a utility model or an exclusive licence, stating that the object or the process is not covered either completely or partly by the utility model.

(2) The owner of a utility model or of an exclusive licence may apply to the Patent Office for a declaration against any person who produces industrially, puts on the market, offers for sale or uses an object, applies a process on an industrial scale or intends to take such steps, which declaration shall state that the object or the process is covered either completely or partly by the utility model.

(3) Petitions under subsections (1) and (2) shall be rejected if the party opposing the petition proves that an infringement action concerning the same utility model and the same object or process instituted between the same parties at an earlier date is still pending or has been finally completed.

(4) The petition for a declaratory decision may relate to only one utility model. The petition shall be accompanied by an accurate and clear description of the object or process and drawings, where necessary, in four copies. One copy of this description, and of the drawing if any, shall be attached to the final decision.

(5) When assessing the scope of protection of the utility model which is the subject matter of the declaration proceedings the Patent Office shall take into account the contents of the application files and the prior art proved by the parties.

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

(7) In all other respects the provisions on the procedure before the Nullity Division (Sec. 36) shall apply to the declaration procedure.

## VII. FEES

### Section 46 Application Fee, Publication Fee, Surcharge

(1) An application fee of € 50.- shall be payable on filing an application for a utility model. The application fee shall not be refunded.

(2) A publication fee of € 72.- shall be payable on publication of a utility model.

(3) A surcharge of € 50.- shall be payable for the accelerated publication and registration of a utility model (Sec. 27).

### Section 47 Annual Fees

(1) Annual fees shall be payable for each utility model for the second and every subsequent year, calculated from the last day of the month in which the application was filed. If the utility model is not published and registered before the expiration of one year, calculated from the last day of the month in which the application was filed, annual fees shall be payable only for the years after the publication and registration.

(2) The annual fee shall be

for the second year	€ 43.-
for the third year	€ 65.-
for the fourth year	€ 87.-
for the fifth year	€ 109.-
for the sixth year	€ 130.-
for the seventh year	€ 152.-
for the eighth year	€ 174.-
for the ninth year	€ 196.-
for the tenth year	€ 218.-

(3) The annual fees shall be payable for the next year on the last day of the month which bears the same name as the day of the application. The annual fees may be paid three months before their due date at the earliest. They shall be payable not later than six months after their due date. Whenever payment is made after the due date, a surcharge of 20 per cent of the annual fee shall also be paid. There shall be no surcharge for the first annual fee payable to the Patent Office.

(4) A lump sum of € 261.- may be paid instead of the annual payment of

the annual fees including that for the fifth year. The due date of that fee as well as the time limits for payment shall correspond to the provisions applicable to the first annual fee payable to the Patent Office (subsec. (1) and (3)). There shall be no surcharge in the event of payment after the due date.

(5) A lump sum of € 784.- may be paid instead of the annual payment of the annual fees for the sixth to tenth year. The due date of that fee as well as the time limits for payment shall correspond to the provisions applicable to the annual fee for the sixth year (subsec. (1) and (3)). In the event of payment after the due date a surcharge of 20 per cent of that fee shall be paid.

(6) Payment of the fees under the subsections 2, 4 and 5 may be made by any person interested in the utility model.

(7) All fees pursuant to subsec. 2, 4 and 5 which have been paid, but have not yet become due shall be refunded if the utility model is waived or becomes otherwise null and void before the due date.

#### **Section 48 Procedural Fees**

(1) The following procedural fees shall be payable:

1. for the filing of an appeal (Sec. 35) € 65.-
2. for any petition to be dealt with by the Nullity Division € 210.-
3. for an appeal (Sec. 37) € 319.-
4. for a petition for entry of the right of prior user (Sec. 5(5)), for an assignment inter vivos (Sec. 10), for the entry of a license or the transfer of a license or for any other entries in the Utility Model Register provided for in Sec. 32(1) € 58.-
5. for a petition for an entry relating to a dispute (Sec. 32(3)) € 23.-

(2) The fees provided for in subsec. (1) para. 1 to 5 shall be paid for every application and for every utility model which is the subject of the appeal or petition.

(3) The fee for an appeal (subsec. (1)1.) shall be refunded if the appeal is essentially successful and if the proceedings have been conducted without an adverse party. Half of the fees provided for in subsection (1)2, and 3, shall be refunded if the petition to be dealt with by the Nullity Division or the appeal is dismissed or the proceedings are terminated without any

hearing. Half of the fees provided for in subsec. (1)4 and 5, shall be refunded if the petition is withdrawn before a decision is taken.

(4) Special fees for official publications, certifications, extracts from the Register, utility model certificates, priority documents and official certificates may be laid down by ordinance. In the determination of the fees for each particular case, which shall not exceed € 23.-, account shall be taken of the labor and material required for the official service involved. To the extent to which fees depend on the number of pages or sheets, Sec. 166(10) of the Patents Act 1970, Federal Law Gazette No. 259, shall apply mutatis mutandis.

(5) Petitions for official publications and petitions which may be accepted only after official publication under this Federal Act shall be refused if the relevant fees are not paid in time.

#### **Section 49 Method of Payment of Fees**

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

#### **Section 50 Stamp Duty**

Utility model certificates issued under this Act shall be exempt from stamp duty. In all other respects the provisions regarding stamp duty and direct charges shall remain unaffected.

## VIII. UTILITY MODEL APPLICATIONS ON THE BASIS OF THE PATENT COOPERATION TREATY

### Section 51

(1) If utility model protection is sought on the basis of an international application as defined by Sec. 1(6) of the Act Introducing Patent Treaties, Federal Law Gazette No. 52/1979, Sec. 16, 17 and 20 to 23 of the Act Introducing Patent Treaties shall apply mutatis mutandis and the application fee pursuant to Sec. 166(1) of the Patents Act 1970, Federal Law Gazette No. 259, which is referred to in Sec. 16 of the Act Introducing Patent Treaties shall be replaced by the application fee pursuant to Sec. 46(1) of this Federal Act.

(2) The provisions of this Federal Act shall apply to applications pursuant to subsec. (1) in addition to the provisions of the Patent Cooperation Treaty, Federal Law Gazette No. 348/1979, and the provisions of the Act Introducing Patent Treaties which is referred to in subsec. (1).

## **IX. FINAL PROVISIONS**

### **Section 52**

In as far as this Federal Act refers to provisions of other federal laws, the latter shall be applicable in the currently valid versions, unless otherwise indicated.

### **Section 52a**

The form chosen in this Federal Act for all designations referring to persons shall apply to both sexes.

### **Section 53**

(1) This Federal Act shall enter into force as of April 1, 1994.

(2) Ordinances on the basis of this Federal Act as amended may be enacted at any day following the promulgation of the Federal Act to be implemented; they shall not become effective prior to the entering into force of the provision to be implemented.

(3) Section 3, 4, subsection 3, section 15a including the heading, section 16, subsection 2, section 16a, 16b and 17, subsection 1, section 28, subsection 1, para. 2 and 3, section 28, subsection 3, section 33, subsection 1, para. 5, section 38, subsection 6, and sections 52 and 52a in the version of the Federal Act, Federal Law Gazette I, no. 175/1988 shall enter into force as of the beginning of the second month following the promulgation of the Federal Act, Federal Law Gazette I, no. 175/1998. Simultaneously, section 4, subsection 3 and 5 and section 28, subsection 1, para. 2, in the version valid until now shall cease to be in force.

(4) Section 46, subsection 1 to 3, section 47, subsection 2, 4 and 5, section 48, subsection 1 and 4 in the version of the Federal Act Federal Law Gazette I, No 143/2001 shall become effective on January 1, 2002.

### **Section 54**

The following shall be responsible for the implementation of this Act:

1. in the case of Sec. 4(5) in connection with Sec. 24(2) of the Patents Act 1970, Federal Law Gazette No. 259, the Federal Minister of Finance in agreement with the Federal Minister of Economic Affairs and the Federal Minister of Defense,
2. in the case of Sec. 4(5) in connection with Sec. 29(4) of the Patents

Act 1970, insofar as it relates to the determination of the request for compensation, Sec. 29(4), Sec. 41 to 44 in connection with Sec. 147 to 156 and Sec. 160, 161 and 164 of the Patents Act 1970 the Federal Minister of Justice,

3. in the case of Sec. 33(2) in connection with Sec. 51 of the Patents Act 1970 the Federal Government,

4. in the case of Sec. 33(2) in connection with Sec. 57(2) of the Patents Act 1970 the Federal Minister of Economic Affairs in agreement with the Federal Minister of Foreign Affairs,

5. in the case of Sec. 33(2) in connection with Sec. 126 of the Patents Act 1970 and in the case of Sec. 37(4) in connection with Sec. 74(2) and (3) of the Patents Act, insofar as it relates to the appointment of judges, the Federal Minister of Economic Affairs and the Federal Minister of Justice,

6. in the case of Sec. 48(4) the Federal Minister of Economic Affairs in agreement with the Federal Minister of Finance,

7. in the case of Sec. 50 the Federal Minister of Economic Affairs and the Federal Minister of Finance,

8. in the case of all other provisions of this Federal Act the Federal Minister of Economic Affairs.