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**Council for Trade-Related Aspects  
of Intellectual Property Rights**

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**MAIN DEDICATED INTELLECTUAL PROPERTY LAWS AND REGULATIONS  
NOTIFIED UNDER ARTICLE 63.2 OF THE AGREEMENT**

**AUSTRIA**

The present document reproduces the text<sup>1</sup> of the Federal Law modifying the 1970 Patent Act, the Act Introducing Patent Treaties and the Utility Models Act, BGBl N° 175/1998, as notified by Austria under Article 63.2 of the Agreement, by means of a communication, dated 4 March 1999.

The text of the laws modified by the law reproduced below can be found in documents IP/N/1/AUT/P/1, IP/N/1/AUT/P/2 and IP/N/1/AUT/P/4. Earlier amendments to these laws can be found in document IP/N/1/AUT/P/6.

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**Conseil des aspects des droits de propriété  
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET RÉGLEMENTATIONS CONSACRÉES  
À LA PROPRIÉTÉ INTELLECTUELLE NOTIFIÉES  
AU TITRE DE L'ARTICLE 63:2 DE L'ACCORD**

**AUTRICHE**

Le présent document contient le texte<sup>1</sup> de la Loi fédérale portant modification de la Loi sur les brevets de 1970, de la Loi concernant les traités en matière de brevets et de la Loi sur les modèles d'utilité, BGBl n° 175/1998, notifiée par l'Autriche au titre de l'article 63:2 de l'Accord par une communication datée du 4 mars 1999.

Le texte des lois modifiées par la loi reproduite ci-dessous figure dans les documents IP/N/1/AUT/P/1, IP/N/1/AUT/P/2 et IP/N/1/AUT/P/4. Des modifications antérieures de ces lois sont contenues dans le document IP/N/1/AUT/P/6.

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**Consejo de los Aspectos de los Derechos de Propiedad  
Intellectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA PROPIEDAD  
INTELLECTUAL NOTIFICADOS EN VIRTUD DEL PÁRRAFO 2  
DEL ARTÍCULO 63 DEL ACUERDO**

**AUSTRIA**

En el presente documento se reproduce el texto<sup>1</sup> de la Ley Federal por la que se modifican la Ley de Patentes de 1970, la Ley de Incorporación de los Tratados sobre Patentes y la Ley de Modelos de Utilidad, BGBl N° 175/1998, notificada por Austria en virtud de lo dispuesto en el párrafo 2 del artículo 63 del Acuerdo, mediante una comunicación de fecha 4 de marzo de 1999.

Los textos de las leyes modificadas por la Ley que se reproduce a continuación figuran en los documentos IP/N/1/AUT/P/1, IP/N/1/AUT/P/2 e IP/N/1/AUT/P/4. Las modificaciones anteriores de esas leyes figuran en el documento IP/N/1/AUT/P/6.

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<sup>1</sup> In English only./ En anglais seulement./En inglés solamente.

GOVERNMENT BILL

Federal Law modifying the 1970 Patents Act, the Act  
Introducing Patent Treaties and the Utility Models Act

The National Council decided:

Article I

The 1970 Patents Act, Federal Law Gazette No 259, in the  
latest version as published in Federal Law Gazette  
No 181/1996, shall be amended as follows:

1. Section 3, Subsection 2 shall read:

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

1. patent applications on the basis of this Federal Law,
2. utility model applications on the basis of the Utility  
Models Act, Federal Law Gazette No 211/1994,
3. international applications in the meaning of section 1, Z 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,  
Z 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  
application 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.

2. Section 36, subsection 4 shall read:

If the person entitled to grant a license in accordance with  
subsections 1 to 3 refuses to do so although the applicant for  
the license has made efforts to obtain within a reasonable  
period of time on reasonable, commercial terms and conditions,  
the Patent Office shall at the request of the applicant for  
the license decide the matter under the procedure relating to  
the contesting of patents. If a license is granted, an

adequate remuneration shall be fixed, taking into account the economic value of the license. The security which may be required and any other terms governing use shall be fixed having regard to the nature of the invention and the circumstances of the case. The scope and duration of the license in accordance with subsections 1 to 3 shall be authorised predominantly for the supply of the domestic market and shall be limited to the purpose requiring the license. In the case of semiconductor technology the license shall only be granted for public noncommercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive."

3. Section 58, subsection 2 shall read:

"(2) The Patent Office shall consist of the President, his deputies (Vicepresidents) and the required number of legally qualified and technically qualified members just as other employees for the fulfilment of his tasks."

4. Section 58a shall read:

"Section 58.a(1) The Patent Office shall be a legal personality (partial legal capacity) insofar as it is entitled to acquire property and rights in the field of the protection of industrial property by the following customer and information services:

1. written information and information by electronic data carriers and media on data referring to filed and registered industrial property rights,
2. statistical evaluations of data in the field of the protection of industrial property,
3. assistance with search on the state of art and the preparation of expert opinions on the patentability of inventions for countries or international governmental or nongovernmental organisations engaged in tasks in the field of the protection of industrial property, in particular mediation, distribution, preparation, and execution,
4. assistance with search concerning property rights, in particular mediation, distribution, preparation, and execution,
5. written information and information by electronic data carriers and media within the scope of procedures for the filing of trade marks, or on the basis of special petitions as to whether a specific sign corresponds to, or possibly resembles filed or registered trade marks ("similarity search"),
6. translation of lists of goods and services for the international registration of trade marks,
7. classification of figurative elements of trade marks for national or international governmental or nongovernmental

- organisations, engaged in tasks in the field of the protection of industrial property,
8. distribution of information and information services of national or international governmental or nongovernmental organisations engaged in tasks in the field of the protection of industrial property,
  9. production, publication, distribution, and mediation of printed matter, software and pre-recorded audio, video and data carriers as well as,
  10. exhibitions, seminars, and similar events.

(2) The President of the Patent Office shall designate by decree, the customer and information services to be rendered by the Patent Office in accordance with subsection 1 within the scope of its partial legal capacity. On this occasion care shall be taken of the suitability of the individual customer and information service for being rendered within the scope of the partial legal capacity, and of avoiding any violation of interests of concealment worth of protection.

(3) Within the scope of its partial legal capacity the Patent Office shall also be entitled to:

1. to assign activities pursuant to subsection 2, accounting and the administration of property, personnel and inventory administration within the scope of partial legal capacity as well as auxiliary activities within the scope of the administration of the Patent Office to third parties, in particular also to federal administrative agencies, against reimbursement of expenses out of the property of the partial legal capacity,
2. to enter into legal transactions in connection with the activities pursuant to 2 1, and
3. to become, with the consent of the Federal Minister of Economic Affairs, a member of associations, other legal persons or intergovernmental organisations if this is in the interest of promoting the protection of industrial property.

(4) The Patent Office shall be entitled to make use of the property and the rights it has acquired within the scope of its partial legal capacity to perform its duties. The Federal Republic shall not be liable for any obligations incurred as a result of the activity of the Patent Office within the scope of its partial legal capacity."

5. Section 60, subsection 3, lit.d of the Patents Act shall read:

"d)the President's Division shall be responsible for matters reserved to the President and all matters not falling within the competence of another division."

6. Section 61, subsection 6 shall read:

"(6) The elocation of activities in the Technical Divisions and the Legal Divisions shall be determined by the head of the respective division."

7. Section 62, subsection 4, Z3 shall be cancelled; Z4 to 6 shall be designated "Z3 to 5".

8. Section 62, subsection 4, Z3 shall read:

"3. where a decision is to be taken on priority rights (section 93 to 95) the legal conditions of such claims being in doubt or contested."

9. Section 64, subsection 3 to 5 shall read:

"(3) Approval for a notice shall require the signature of the person approving. This provision may be dispensed with if the approving person can otherwise be established beyond doubt.

(4) All papers issued by the Patent Office shall be issued in the name of the "Austrian Patent Office", with the addition of the Division or administrative office, the library or accounting department; in matters reserved to the President the words "the President" should be included. Written communications shall be dated and signed. Collective decisions shall be signed by the chairman. The signature may be replaced by an official certification to the effect that the copy delivered is a true copy of the document in question and that the original contains the signature required. Further particulars shall be settled by order.

(5) For written copies produced automation-assisted the addition of the name of the person approving shall be sufficient; no attestation by the office shall be required."

Section 70, subsection 5 shall read:

"(5) Similarly, no separate appeal shall lie against interim decisions of the Nullity Division but an amendment of the rapporteur's preparatory acts (subsection 4) may be applied for in all three Divisions and an amendment of interim decisions of the Appeal or the Nullity Division may be applied for in the Division concerned."

11. Section 81, subsection 4 shall read:

"(4) Files relating to expert opinions in accordance with section 57a shall be open to inspection by third parties only with the consent of the requesting party. The consent shall not be required for any person against whom the requesting party has referred to the expert opinion."

12. The following sections 93a and 93b shall be inserted after section 93:

" Section 93a. 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 patent 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 93b. 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 Law Gazette No 399/1973."

13. Section 94, subsection 1 shall read:

"(1) Separate priorities for separate parts of the subject of the application (partial priorities) may be claimed only on the basis of sections 93a or 93b or 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 application."

14. Section 95, subsection 1 shall read:

"(1) The rights of priority granted on the basis of sections 93a or 93b or intergovernmental agreements must be expressly claimed. The date and the country of the application the priority of which is claimed, shall be indicated (declaration of priority), as well as the serial number of the application.

15. Section 110 including the heading shall be cancelled.

16. Section 166, subsection 1 shall read:

"An application fee of ATS 700 shall be payable for a patent application."

17. The following sections 172b and 172c shall be inserted after the heading of part VI:

"Section 172b. 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 172c. The form chosen in this Federal Act for all designations referring to persons shall to both sexes."

18. Section 173, Z 2 shall read:

"2. in the case of section 49, subsection 4, sections 147 to 156, 158 to 162 and 165 the Federal Minister of Justice."

19. Section 174 shall be supplemented by the following subsections 6 to 7:

"(6) Section 3, subsection 2, section 58, subsection 2, sections 58a and 60, subsection 3, lit.d, section 61, subsection 6, section 62, subsection 4, Z 3 to 5, section 64, subsection 3 to 5, section 70, subsection 5, section 81, subsection 4, sections 93a, 93b and 94, subsection 1, section 95, subsection 1, section 166, subsection 2, sections 172b and 172c, and section 173 Z 2 in the version of the Federal Act, Federal Law Gazette I, No 175/1998 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 62, subsection 4, Z 3 in the version valid until now and section 110 including the heading shall cease to be in force.

(7) Section 36, subsection 4 in the version of the Federal Act, Federal Law Gazette I, No 175/1998 shall become effective on January 1, 1996.

## Article II

The Act Introducing Patent Treaties, Federal Law Gazette No 52/1979, in its latest modification as published in Federal Law Gazette No 181/1996, shall be modified as follows:

1. The fullstop in Section 1, Z 7 shall be replaced by a comma. The following Z 8 shall be added:

"8. "GMG", the Utility Models Act, Federal Law Gazette No 211/1994."

2. Section 3 including the heading shall read:

"Information of the Public

Section 3(1) European patent applications published under article 93 EPC shall be laid open for public inspection by the Austrian Patent Office together with the translations filed for that purpose (section 4, subsection 2) until such time as a European patent is granted or the European patent application is rejected or withdrawn. Section 101, subsection 3 of the Patents Act shall apply accordingly.

(2) The European Patent Gazette, the published European patent applications and the European patent specifications shall be laid open for public inspection at the Austrian Patent Office.

(3) Registers shall be kept of published European patent applications and European patents which shall provide the public with rapid and reliable information in regard to the protective rights concerned.

3. Section 9 including the heading shall read:

"Conversion

Section 9.(1) At the request of the applicant for a European patent application the Austrian Patent Office shall initiate the procedures for the granting of a patent or for the registering of a utility model, if the European patent application is deemed to be withdrawn under article 77, subsection 5 of the EPC (Conversion request).

(2) Where the request for conversion has been forwarded to the Austrian Patent Office or has been filed at the Austrian Patent Office, if it was to be filed there, the applicant shall be requested to

1. pay the application fee (section 166, subsection 1 of the Patents Act; section 46, subsection 1 of the Utility Models Act, and
2. submit a translation into German of the European patent application if the application had not been filed in German, i.e. of the originally filed version and, where applicable, a modified version, which the applicant wishes to have the granting procedure before the Austrian Patent Office to be based on,

within an extendable period of two months.

(3) If the request in accordance with subsection 2 is not met within the foreseen period, the application shall be considered withdrawn.

(4) For patent and utility model applications converted in the manner prescribed the filing date of the European patent application shall be regarded as the filing date of the



application (section 87, subsection 2 of the Patents Act; section 13, subsection 1 of the Utility Models Act). Priority rights claimed for the European patent application shall remain in force for converted patent and utility model applications. In all other matters the provisions of the Patents Act and the Utility Models Act shall apply to converted patent and utility model applications."

Section 10, subsection 1 shall read:

"(1) European Patents may be revoked on the grounds specified in article 138, subsection 1, lit.a to d of the EPC, in section 48, subsection 1, Z 1 of the Patents Act in combination with section 3, subsection 2 of the Patents Act, and in section 48, subsection 1, Z 3 of the Patents Act and may be forfeited on the ground specified in article 138, subsection 1, lit.e of the EPC."

5. Section 10, subsection 3 shall be cancelled.

6. Section 15, subsection 2 shall read:

"(2) For every application under subsection 1a transmission fee of the same amount as the application fee (section 166, subsection 1 of the Patents Act) shall be paid. Payment of the fee shall be duly proved (section 169 of the Patents Act)."

7. The following sections 24a and 24b shall be inserted after the heading "Repeal and Transitional Provisions":

"24a. In as far as this Federal Law refers to provisions of other federal laws, the latter shall be applicable in the currently valid versions, unless otherwise indicated.

Section 24b. The form chosen in the federal law for all designations referring to persons shall apply to both sexes."

8. Section 25 shall be supplemented by the following subsections 4 and 5:

"(4) Section 1, Z 7 and 8, section 3, including the heading, section 9 including the heading, section 10, subsection 1, sections 24a and 24b, and section 26, subsection 5 in the version of the Federal Act, Federal Law Gazette I, No 175/1998 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 10, subsection 3, shall cease to be in force.

(5) Section 15, subsection 2, in the version of the Federal Act, Federal Law Gazette I, No 175/1998 shall become effective on July 1, 1998."

9. Section 26 shall be supplemented by the following subsection 5:

"(5) Section 10, subsection 1 and 3 in the wording valid before the entry into force of the Federal Act Federal Law Gazette I, No 175/1998, shall continue to be applicable to European patents with a date of application before January 1, 1994."

### Article III

The Federal Act on the Protection of Utility Models (Utility Models Act), Federal Law Gazette No 211/1994, shall be modified as follows:

1. Section 3 shall read:

"Section 3.(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 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, Z 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, Z 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 application 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 patentability 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, Z 2, or in such a 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."

2. Section 4, subsection 3 and 5 shall lapse; the previous subsection 4 shall be designated "(3)".

3. The following section 15a including the heading shall be inserted after section 15:

#### "Branching off

Section 15a. (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 months after the patent application is considered withdrawn, or
2. two months after the entering into effect of the decision of refusal of the patent application, or
3. two months after the patent is considered as granted in accordance with section 107 of the 1970 Patents Act, or
4. eleven months after the entry into effect of the decision on the granting of the European patent in the absence of any objection, or
5. two months upon legal validity of the decision on an 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 months 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."

4. Section 16, subsection 2 shall read:

"(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 day of arrival of the application at the Patent Office is decisive for the priority of a feature of the application. More than one priority may be requested for one claim."

5. The followings paras 16a and 16b shall be inserted after section 16:

"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."

6. Section 17, subsection 1 shall read:

"(1) The rights of priority granted on the basis of sections 16a or 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 to the application."

7. Section 28, subsection 1, Z 2 shall be cancelled; the previous Z 3 and 4 shall be designated "Z 2 and 3."

8. Section 28, subsection 3 shall read:

"(3) By the final declaration of nullity the effects of the utility model specified in section 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 (section 32 subsection 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."

9. Section 33, subsection 2, Z 5 shall read:

"5. the President's Division shall be responsible for matters reserved to the President and all matters not falling within the competence of another division."

10. Section 38, subsection 6 shall read:

"(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."

11. Section 52 shall read:

"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."

12. The following section 52a be inserted after section 52:

"Section 52a. The form chosen in this Federal Act for all designations referring to persons shall apply to both sexes."

13. Section 53 shall be supplemented by the following subsection 3:

"(3) Sections 3, 4, subsection 3, section 15a including the

heading , section 16, subsection 2, section 16a, 16b and 17, subsection 1, section 28, subsection 1, Z 2 and 3, section 28, subsection 3, section 33, subsection 1, Z 5, section 38, subsection 6, and sections 52 and 52a in the version of the Federal Act, Federal Law Gazette I, No 175/1998 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, Z 2, in the version valid until now shall cease to be in force."

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