WORLD TRADE ORGANIZATION

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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 of the Patents Act 1970[1], as amended, as notified by Austria under Article 63.2 of the Agreement (see document IP/N/1/AUT/1/Rev.1).

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

PRINCIPALES LOIS ET REGLEMENTATIONS CONSACREES A LA PROPRIETE INTELLECTUELLE NOTIFIEES AU TITRE DE L'ARTICLE 63:2 DE L'ACCORD

Autriche

Le présent document contient le texte de la Loi de 1970 sur les brevets[1], notifiée par l'Autriche au titre de l'article 63:2 de l'Accord (voir le document IP/N/1/AUT/1/Rev.1).

Consejo de los Aspectos de los Derechos de Propiedad Intelectual relacionados con el Comercio

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

Austria

En el presente documento se reproduce el texto de la Ley de Patentes, de 1970[1], modificada, que Austria ha notificado en virtud de lo dispuesto en el párrafo 2 del artículo 63 del Acuerdo (véase el documento IP/N/1/AUT/1).

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[1]English only/anglais seulement/inglés solamente.

PATENTS ACT 1970

as amended

I. GENERAL PROVISIONS

Patentable Inventions

1. (1) Upon application patents shall be granted for inventions which are new (Section 3), which, having regard to the state of art, are not obvious to a person skilled in the art and which are susceptible of industrial application.

(2) The following in particular shall not be regarded as inventions:

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 computers;
4. presentations of information.

(3) The provisions of subsection (2) shall exclude patenting of the subject matter or activities referred to in that subsection only to the extent to which protection is demanded for them as such.

Exceptions to Patentability

2. Patents shall not be granted in respect of:

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 or animals by surgery or therapy and diagnostic methods practiced on humans or animals; 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) or essentially biological processes for the production of plants or animals; these exceptions shall not apply to microorganisms as such nor to microbiological processes and the products obtained by means of such processes.

Novelty

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) The state of art shall also be held to comprise the contents of

(a) patent applications on the basis of the present Federal Act of an earlier priority date,

(b) European patent applications and international applications of an earlier priority date within the meaning of Sec. 1 para. 4 and 6 of the Act Introducing Patent Treaties, Federal Law Gazette No. 52/1979, as amended, and

(c) utility model applications of an earlier priority date on the basis of the Utility Models Act, Federal Law Gazette No. 211/1994, as amended,

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 subsections (1) and (2) if these are intended for use in a method referred to in Section 2 (2) and unless their use in any of these methods is part of the state of art.

(4) For the application of subsections (1) and (2) a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months prior to the filing of the application and if it was directly or indirectly due to

1. an evident abuse to the prejudice of the applicant or his legal predecessor, or
2. the fact that the applicant or his legal predecessor has displayed the invention at official or officially recognized exhibitions within the meaning of the Convention on International Exhibitions, Federal Law Gazette No. 445/1980, as amended.

(5) Subsection (4) 2 shall apply only if the applicant states, when filing the application, that the invention has been displayed at the exhibition and files a certificate of the management of the exhibition within four months after filing. The date of the opening of the exhibition and the date of the first disclosure, unless it is the same date, shall be indicated in such a certificate. A description of the invention provided with an attestation clause of the management of the exhibition shall be attached to such a certificate.

Right to a Patent

4. (1) Only the inventor or his successor in title shall have a right to the grant of a patent. Until the contrary is proved the first applicant shall be regarded as the inventor.

(2) Where an improvement or other further modification of an invention which is already protected by a patent or for which a patent has been applied

for and is eventually granted is the subject of an application by the patentee of the parent patent or by his successor in title, the patentee or his successor in title may apply either for an independent patent for such improvement or other further modification or for a patent of addition dependent on the parent patent.

(3) Where the industrial application of an invention for which a patent has been applied for entails the full or partial use of an invention which is protected by a patent enjoying the earlier priority date or by a utility model enjoying the earlier priority date as defined by the Utility Models Act, Federal Law Gazette No. 211/1994, as amended from time to time, the owner of the earlier right may request that a patent be granted on the invention for which an application has been filed with the addendum that it is dependent on the earlier patent or utility model which must be clearly specified (declaration of dependence). Such addendum shall also be included in the publication regarding the grant of the patent and in the letters patent.

5. (1) The first applicant shall not, however, be entitled to the grant of a patent where he is not the inventor or his successor in title, or where the essence of his application has been usurped from the descriptions, drawings, models, implements or installations of a third person or from a process used by him and where, in the first case, the inventor or his successor in title or, in the second case, the injured party opposes the grant of the patent.

(2) In the case of several persons who have usurped an invention one after the other, an earlier possessor of the invention shall, in the event of dispute, have priority over a later one.

Employees' Inventions

6. (1) Employees shall also be entitled to the grant of a patent (Section 4) for inventions they have made during their employment relationship, unless otherwise provided by contract (Section 7 (1)) or in the circumstances of Section 7 (2).

(2) "Employees" shall mean salary and wage earners of every kind.

7. (1) Agreements between employers and employees under which any future inventions of the employee are to belong to the employer or which grant the employer a right to use such inventions shall be valid only if the invention is a service invention (subsection (3)). To be valid, the agreement must be in writing; this requirement shall be satisfied if the agreement is included in a collective agreement (Article 2 (1) of the Law on the Organization of Labor, Federal Law Gazette No. 22/1979, as amended).

(2) Where a person is employed under public law, the employer may, even in the absence of agreement with the employee, claim the service inventions

of the latter completely or the right to use such inventions, such right being also binding on third parties. In such cases, the following subsection, Sections 8 to 17 and 19 shall apply *mutatis mutandis*.

(3) A service invention shall be one made by an employee which, by reason of its subject matter, falls within the activities of the enterprise in which the employee works, provided that:

(a) either the activity which has led to the invention forms part of the employee's employment obligations; or

(b) the invention was suggested to the employee by his work in the enterprise; or

(c) the invention was greatly facilitated by the use of the experience or resources of the enterprise.

8. (1) An employee shall be entitled to special and fair remuneration in any case where his invention becomes the property of his employer or subject to the employer's right of use.

(2) Where, however, the employee has been appointed expressly to create inventions in the employer's enterprise and where this was in fact his principal activity and where such activity has led to an invention, the employee shall be entitled to special remuneration only to the extent that the higher pay received under the employment contract in view of his inventive activity does not constitute adequate remuneration.

9. For the assessment of remuneration (Section 8), the following shall in particular be taken into account:

(a) the economic importance of the invention for the enterprise;

(b) any other exploitation of the invention in Austria or abroad;

(c) the role which the suggestions, experience, preparatory work or resources of the employer's enterprise or service instructions have played in bringing about the invention

10. (1) At the request of one of the parties, the remuneration may subsequently be varied, on an equitable basis, where the circumstances on which the remuneration was assessed have substantially changed. Payments received by the employee on the basis of an earlier assessment shall, however, in no case be refunded. Similarly, payments already made or becoming due on the basis of an earlier assessment may not subsequently be supplemented, except where remuneration is in the form of a non-recurring payment.

(2) The employee may also claim a variation of remuneration where the invention has been transferred by the employer to a third party, if the proceeds obtained by the employer through such transfer are manifestly disproportionate to the remuneration paid by the employer or if the employer continues to participate in the exploitation of the invention and obtains a

return manifestly disproportionate to the remuneration paid to the employee.

(3) The request (subsections (1) and (2)) may be made only after one year from the previous assessment of remuneration.

11. (1) Where the amount of remuneration (Sections 8 to 10) has been made dependent on the exploitation of the invention by the employer and where the employer fails to work the invention to an extent commensurate with its economic importance for the enterprise, the remuneration shall be assessed as if the employer had worked the invention to an extent commensurate with its economic importance for the enterprise.

(2) The remuneration shall be assessed in the same way where the employer has transferred the invention to a third party or has otherwise alienated it, unless the employee has given his consent to such transfer or alienation and fails to prove that such transfer or alienation was only a pretense.

(3) The employer shall be released from the obligation under subsection (1) to pay remuneration if he undertakes to assign the right to the use of the invention to a third party to be designated by the employee. The third party benefiting from such right shall compensate the employer for his share in the invention assessed on the basis of Section 9 *(c)*. A variation of such compensation may be applied for subsequently in accordance with Section 10.

(4) The claim (subsections (1) and (2)) may not be made if the employer, with due regard to the circumstances of the case, cannot be expected to work the invention at all or to a greater extent than he has done or could be expected to do had there been no transfer or other alienation. Where, however, the employer derives an advantage from the invention without working it, fair remuneration shall be payable to the employee.

12. (1) In the case of an agreement under which future inventions of the employee are to belong to the employer (Section 7), the employee shall immediately notify the employer of every invention that he makes other than those which clearly are not covered by the terms of the agreement. The employer shall, within four months of receiving such notification, inform the employee whether he claims the invention on the basis of the agreement as a service invention.

(2) Where the employee fails to make such notification, he shall be liable to the employer, without prejudice to the employer's right to the invention, for damages in respect of the loss, which shall also include loss of earnings. Where the employer fails to claim the invention or expressly does not claim it, the invention shall belong to the employee.

13. (1) The employer and the employee shall be under an obligation of secrecy with regard to inventions which are the subject of the notification and claim referred to in Section 12 (1).

(2) The employee's obligation of secrecy shall lapse where:
(a) the employer has failed to make the claim provided for in Section 12 (1) or expressly makes no claim within the period prescribed; or
(b) the employer has claimed the invention in time (Section 12 (1)) and has waived secrecy.

(3) The lapse of the obligation of secrecy in accordance with the above provision shall not affect any obligation of secrecy which may otherwise be incumbent on the employee.

(4) The employer's obligation of secrecy shall lapse where he has claimed the invention in time (Section 12 (1)) and the employee has not opposed that claim.

(5) The obligation of secrecy shall not preclude the employer and the employee from applying for a patent or from taking other steps to protect their rights.

(6) Any employer or employee violating the obligation of secrecy shall be liable to remedy the loss sustained by the other party, including loss of earnings.

14. Where an employer who has paid remuneration to an employee for a service invention finds that not this one, but another of his employees had in fact made the invention or that another of his employees had contributed to the invention the employer shall be under no obligation to pay the remuneration to the rightful claimant – either in its entirety or in proportion to the rightful claimant's share in the invention, provided that the employer has made payment in good faith and that the invention also belongs to him under his legal relationship with the rightful claimant.

15. (1) Where an employer has made an agreement with an employee in respect of a service invention, he may at any time wholly or partially waive his rights to the invention. In such case, the employee may request the assignment to him of the rights to the invention that have been waived.

(2) Where the employer waives the whole of his rights to an invention, the obligation to pay remuneration shall cease from the moment that the waiver is made. In the event of partial waiver, the employer may request a corresponding reduction of the remuneration to the extent that the rights assigned to the employee are capable of being assessed separately.

(3) The obligation to pay remuneration in respect of the period preceding the waiver shall remain unaffected.

16. The rights of the employer and employee arising from Sections 6 to 15 shall not be affected by the termination of employment.

17. The employee's rights under Sections 6 to 16 may not be withdrawn or restricted by agreement.