

Austria

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1. Legal framework

National

The laws governing trademarks in Austria are as follows:

- the Trademark Act;
- the Federal Act against Unfair Competition;
- the Product Piracy Act;
- the Act on Quality Marks;
- the Regulation on the Implementation of the Relevant Acts for Patents, Designs, Trademarks and Utility Patents; and
- the Patent Office Regulation on Applications and Procedures.

International

The following international treaties are applicable in Austria:

- the Paris Convention for the Protection of Industrial Property;
- the Madrid Agreement on the International Registration of Marks;
- the Madrid Protocol;
- the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights.

2. Unregistered marks

Protection

Unregistered marks are granted protection in the following circumstances:

- Pursuant to Section 31 of the Trademark Act, the user of an unregistered mark is entitled to claim for cancellation of a similar or identical registered trademark where there is proof of prior use for identical or similar

goods or services and proof of secondary meaning. Such a claim has to be filed within five years of the start of the registered trademark's use.

- Section 9(3) of the Federal Act against Unfair Competition protects unregistered marks for goods or services against the use of confusingly similar marks, registered or unregistered, where there is proof of prior use for identical or similar goods or services and proof of secondary meaning.
- Unregistered marks that lack secondary meaning may be protected against unfair competition pursuant to Section 1 of the Federal Act against Unfair Competition if the use of identical or similar marks is against good morals.

Use requirements

A requirement for the protection of unregistered marks is secondary meaning. A mark has acquired secondary meaning if the relevant participants in the market identify certain goods or services as belonging to the mark owner. Secondary meaning must be analyzed with reference to:

- the level of recognition (do the market participants involved know the mark at all?);
- the level of identification (do the market participants involved consider the mark as identifying one enterprise or one product or service?); and
- the level of attribution (do the market participants involved recognize the enterprise whose goods or services are identified by the mark?).

The decisive factor is usually the level of identification.

The level of secondary meaning necessary for protection of an unregistered mark varies and therefore cannot be generally defined; the less distinctive the mark, the more secondary meaning has to be proven. For example, protection has been granted to the unregistered

marks LEGO (91% secondary meaning) and HEIZÖL LEICHT SCHWECHAT 2000 (61% attribution among potential customers); whereas the marks NEW LINE for shoes (50% level of recognition) and VOLLRAHM for cream (71% level of recognition in the core distribution area but below 50% in the remaining Austrian territory) were denied protection.

3. Registered trademarks

Ownership

Trademarks may be owned by natural and legal persons, regardless of nationality or seat of residence.

Scope of protection

Any sign that can be graphically represented can be registered as a mark, including:

- words (including personal names);
- images;
- letters and characters;
- figures;
- designs;
- sounds; and
- colours.

The following types of mark cannot be registered as, for practical reasons, they cannot be represented graphically:

- fragrances; and
- flavours.

4. Procedures for registered marks

Searches

An official similarity search by the Patent Office including company names and/or slogans is not available. However, trademark searches can be conducted by a (private) entity closely affiliated with and located in the Austrian Patent Office

independently from the filing of an application for trademark registration. No interpretation of search results is provided by the Patent Office. Trademark searches can be requested either for all filed and registered trademarks or separately for either filed or registered trademarks only. Searches can also be limited to certain classes. These searches attract the following costs:

- standard search (results within three to five working days) for both registered and filed trademarks – €122;
- standard search for registered trademarks only – €74;
- standard search for filed trademarks only – €53;
- express search (results within 24 hours) for both registered and filed trademarks – €143;
- express search for registered trademarks only – €84;
- express search for filed trademarks only – €63;
- periodical monitoring similarity search for both registered and filed trademarks – €90;
- monitoring search for registered trademarks only – €50; and
- monitoring search for filed trademarks only – €45.

Examination

Applications for registration of a mark are subject to formal examination proceedings by the Patent Office, reviewing, in particular, formal irregularities (eg, inaccurate or overly wide description of goods and services, missing fees) and absolute grounds for refusing registration (eg, lack of distinctiveness or descriptiveness).

Where there is doubt as to an application's compliance with all registration criteria, the Patent Office will issue an office action to which the applicant may reply.

Opposition

Austrian trademark law does not provide for opposition proceedings. Prior conflicting marks do not constitute an obstacle to registration.

Neither the owner of an earlier registered trademark nor third parties are entitled to oppose the mark during the course of registration. Before registering the mark the Patent Office will transmit a search report of potentially conflicting prior marks in the requested classes upon a mere advisory basis. Owners of a prior trademark or third parties can claim for cancellation once the trademark has been registered.

Registration

Applications for national trademarks have to be filed in written form with the Patent Office. Where a trademark does not consist exclusively of words or figures, 20 images of the trademark have to be attached. The overall timeframe from application to registration is usually between two and six months.

Trademark applications and registrations are subject to a minimum fee of €329. This can be broken down as follows:

- an application fee of €80;
- a class fee for the first three classes of €20;
- a protection period fee of €200;
- a printing charge of €25; and
- a fee for authentication and registration for €4.

The following additional fees may apply:

- Registrations in four or more classes attract a fee of €25 for each additional class; and
- The fee for an international registration designating Austria is €100.

A document fee will apply for submissions to the Patent Office in the course of the registration process. The document fee is not calculated and invoiced by the Patent Office until after the conclusion of the proceeding. Since this fee is dependent on the type and number of submissions involved in the process of registration, the exact amount of the document fee varies. The fees are:

- submissions – €13; and
- attachments – €3.60 per sheet up to a maximum of €21.80.

Trademark protection comes into effect as of the date of registration and lasts for a renewable period of 10 years. Protection can be renewed by timely payment of the renewal fee (currently €500); the renewal fee can be paid one year before the end of the registration term and has to be paid within six months of the end of the registration term. Renewal fees paid after the end of the registration term are subject to a 20% surcharge.

Once the trademark has been validly registered, changes with regard to the actual status of ownership are of a declaratory nature only. The trademark owner is entitled to apply for changes to the register entry upon presentation of official documents (eg, an official company register extract from the Commercial Court) or documents with legalized signatures. In particular, the registration of changes to the actual Trademark Register entry are recommended in cases such as:

- assignment of the trademark;
- merger of the trademark holder with another entity; or
- change of the trademark owner's name.

Removal from register

Cancellation of a trademark may be initiated, depending on the grounds for cancellation, by:

- the trademark owner;
- a third party; or
- the Patent Office *ex officio*.

Upon request of the trademark owner, a trademark will be cancelled and removed from the Trademark Register (surrender of the trademark by the trademark owner).

An interested third party can also request the cancellation of a trademark where it:

- conflicts with a prior registered mark;
- conflicts with a prior unregistered mark;
- conflicts with an earlier company name;

- has been registered by an agent or representative of the trademark owner in its own name in Austria without the mark owner's authorization; or
- should have been subject to an *ex officio* cancellation action.

Any third party is entitled to claim for cancellation under the final criterion outlined above in the following cases:

- An absolute ground for refusal has emerged subsequent to registration;
- The trademark has been registered for at least five years but has not been used in Austria during an uninterrupted five-year period. However, a mark owner can defeat such a claim if it can justify the non-use of the mark;
- The trademark has become a sign that should be commonly available (ie, it has become the common name in trade for a product or service in respect of which it is registered);
- The trademark has become deceptive (ie, the mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of goods or services in respect of which it is registered); or
- The trademark was registered maliciously.

A trademark will be cancelled *ex officio* if the renewal fee is not paid on time.

5. Enforcement

Complexity

In the case of infringement of a registered or unregistered trademark, the mark owner should file a civil claim. Such claims have to be filed with the commercial courts. Wilful infringement of a registered mark can also be the subject of a criminal action and can result in a fine of up to 360 times the infringer's average daily income or a sentence of up to two years' imprisonment.

Owners of registered trademarks can file a civil claim if a third party in the course of business, without the prior trademark owner's consent:

- uses a mark identical to the prior registered trademark for identical goods or services;
- uses an identical or similar mark for identical or similar goods or services, where such use creates a likelihood of confusion; or
- uses an identical or similar mark for goods or services not similar to those covered by the prior registered trademark, where the prior registered mark is well known in Austria and the use of the later mark takes unfair advantage of, or is detrimental to, the distinctive character or repute of the earlier trademark.

In the above-mentioned cases the owner of a registered trademark may seek:

- a cease and desist order;
- removal of infringing goods;
- rendering of accounts;
- adequate consideration or, in the case of negligence or intent, compensation for non-material loss and surrender of profits. The owner of the mark can claim double the amount of consideration as compensation without having to prove the actual amount of damages; and
- publication of the verdict.

A claim for infringement of registered trademark rights can be combined with a claim for a preliminary injunction.

Infringing use of a prior unregistered mark in the course of business entitles the mark owner to almost all of the claims available to the proprietors of registered marks. However, injunction claims under the Federal Act against Unfair Competition shall become statute barred six months after the person entitled to sue obtained knowledge both of the infringement and of the infringer's identity, or, without regard thereto, three years after the infringement occurred.

Timeframe

The timeframe from the filing of a claim to a decision at one instance ranges from one to two years, depending on the judge and the complexity of the procedure.

Decisions on a motion for a preliminary injunction usually are handed down within one or two weeks.

6. Ownership changes – legalization requirements

The following changes or encumbrances of ownership rights related to trademarks are available under Austrian trademark law:

- assignments;
- licences;
- pledges of rights; and
- chattel mortgages.

Registration in the Trademark Register is a precondition to assert trademark rights with respect to the Patent Office. Proof of any transfer of rights can be furnished by way of either official documents or a written form with legalized signatures. However, registration of any transfer of rights is not a precondition to assert trademark rights with respect to third parties.

7. Related rights

Related rights with areas of overlap to trademark rights are as follows:

- A right to a name (Section 43 of the General Civil Code) – the owner of a name can be a natural person, a legal entity, or a commercial or private partnership. Use of a mark (registered or unregistered) that has an impact on

someone's right to a name can be subject to a cease and desist claim and, in the case of negligence or intent, damages. A precondition to a cease and desist claim and/or damages is not only the use of a mark identical or similar to the name, but also a use sufficient to cause confusion (eg, to evoke the impression of a relation between a mark and the owner of the name).

- A registered company name pursuant to Section 17 of the Code of Commercial Law – the entire company name and parts thereof are protected if they are distinctive or have acquired secondary meaning. The company name is protected under the right to a name as well as pursuant to the Federal Act against Unfair Competition.
- An unregistered company name (Section 9 of the Federal Act against Unfair Competition) – the entire company name and parts thereof are protected under the Federal Act against Unfair Competition provided that they are distinctive or have acquired secondary meaning.
- A title of a work of art or literature (Section 80 of the Copyright Act) – such titles are protected if they are distinctive or have acquired secondary meaning. Pure descriptions of the content (eg, 'local telephone book') do not benefit from protection under Section 80. In particular, titles of print media (eg, periodicals, journals, magazines) can be protected under this section.
- Designs – trademarks or parts of trademarks may also be registered as designs under the regime of the Design Act, provided that they are new and have an individual character.
- Copyright-protected work – provided a trademark qualifies as such a work, it may enjoy protection under the regime of the Copyright Act (eg, slogans as works of literature, design marks as works of fine art, sound marks as music works).

8. Online issues

There are no particular legal provisions governing trademark rights in respect of use on the Internet. The general provisions apply.

Examples of established case law:

- Domain names can be protected under Section 9 of the Federal Act against Unfair Competition as unregistered marks.
- The use of a registered trademark as a domain name is considered to infringe upon trademark rights if the domain name is used with respect to goods or services similar to those covered by the trademark.
- The registration of a domain name without any other interest than to block the trademark owner from using its trademark as a domain is considered 'domain grabbing' and qualifies as unfair competition pursuant to Section 1 of the Federal Act against Unfair Competition.

However, in Austria domain names are registered on a first come, first served basis. This means that they are registered without any prior examination concerning infringement of third-party rights. It is therefore recommended to reserve domain names corresponding to trademark registrations at the same time in order to protect the registered trademark from abuse on the Internet.

In the case of disputes with regard to Austrian domain names, arbitration proceedings are available on a voluntary basis. A specialized arbitration institution for '.at' country-code top-level domain names, the Arbitration Office for '.at' Domains, was set up in 2003. The advantages of submitting a dispute to this specialized arbitration office are that the proceedings are relatively short and the office can directly transfer the domain to the prevailing complainant.

