

Austria

Administrative procedure

Opposition

Anyone may bring an action within four months from the date on which mention of grant is published (Section 102 PA). The decision is taken by the “Senate” (Head of Technical Department, one examiner and one further member who, depending on the case, has to be technically or legally qualified (Section 62(3), (4) PA)). If the opposition action is withdrawn, the proceedings are closed.

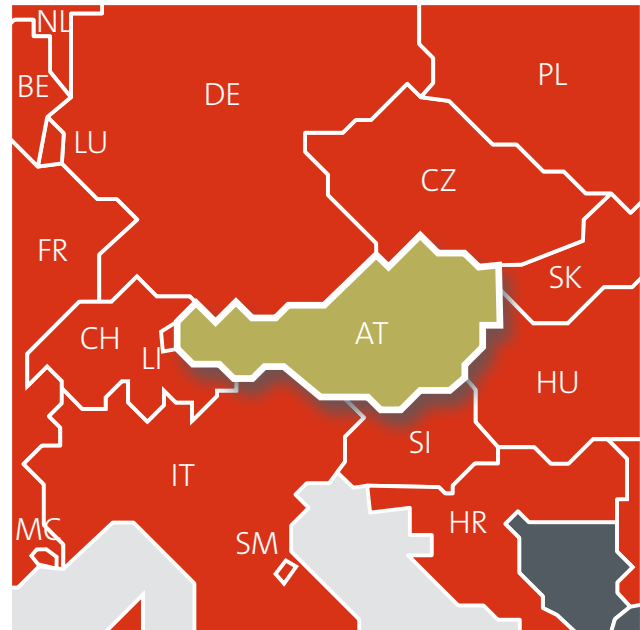
Appeal

The appeal must contain a formal request and be substantiated. Every decision of a technical or legal department may be contested by an appeal. There are *ex parte* (e.g. negative decision on a patent application) and *inter partes* proceedings (e.g. appeal against an opposition decision). Appeals must be lodged within two months of notification of the decision which is challenged; the opposing party will be notified and will have the opportunity to submit objections (Section 139 PA).

First instance: the department which issued the decision at first instance may grant the appeal under the provisions of Section 139 PA. This is usually done to correct an obviously erroneous decision, where there is no need for further proceedings or for parties to be heard. Such a decision by the first instance is mainly justified in *ex parte* proceedings if the arguments of the appeal can be followed completely, e.g. in case of clerical errors. In *inter partes* proceedings (opposition) the situation is more complex and therefore such a decision by the first instance is rarely reasonable.

Higher Regional Court (of Vienna): appeal from the decision of the Technical and Legal Department (Section 138 PA). New facts and evidence may only be introduced to support or refute facts and evidence submitted at first instance (prohibition of amendment – Section 139 PA). A case of serious procedural defect will be referred back to the department of first instance.

Higher Regional Court (of Vienna): appeal from the decisions of the Nullity Department (Section 141 PA). Appeals have suspensive effect.



Nullity/revocation

The Nullity Department functions as a first instance. It is composed of two legally and three technically qualified members of the Austrian Patent Office (hereinafter the “Patent Office”) (Section 63 PA).

The proceedings can be continued if the action is withdrawn (Section 112(1) PA).

Decisions have retroactive effect. Partial nullification is available.

Any party which considers itself adversely affected by a decision of the Nullity Department may appeal to the Higher Regional Court, within two months from the decision (Section 141 PA). Patent claim amendment is allowable under certain conditions, but does not often occur.

Civil procedure

Infringement

Infringement disputes are dealt with before the Commercial Court of Vienna. Any person (registered and non-registered patent owner, exclusive licensee) who has suffered infringement of one of the rights belonging to him under a patent or who fears that such infringement might occur may bring an action (Section 147 PA).

An infringement claim is subject to civil law; however, criminal proceedings (Section 159 PA) before the Regional Court for Criminal Matters in Vienna may also be initiated in the case of wilful infringement.

If the Patent Office or the appeal instances have taken a decision on the validity or effectiveness of a patent different from the evaluation by the court in infringement litigation, an action for a re-trial (Section 530(1) of the Code of Civil Procedure) may be based thereon (Section 156(6) PA).

Nullity/counterclaim for revocation

During infringement proceedings, invalidity of a patent may be used as a defence, which will be considered by the court as a preliminary issue (Section 156 PA). Optionally, the court may request an opinion from the Patent Office on whether nullity is likely (Section 156(3) PA).

The court has to suspend proceedings if it considers the patent likely to be invalidated. In that case, the defendant has one month to prove that s/he has applied for nullification of the patent or has filed an opposition at the Patent Office, is already party to such proceedings or has entered as an intervenor. If the defendant fails to do so, the claimant may re-establish the infringement proceedings and the court has to take the decision irrespective of the question of nullity (Section 156 PA).

Remedies

Remedies include preliminary injunctions, destruction of infringing products, publication of the decision, compensation, and damages (Sections 148-152 PA).

Other actions

Any person who industrially produces, places on the market, offers for sale or uses an article, industrially applies a process or intends to take such measures may apply to the Nullity Department for a declaratory decision against the owner of a patent or its exclusive licensee, to the effect that the subject-matter of the process or product marketed or to be marketed is neither partially nor wholly covered by the patent.

A patent owner or its exclusive licensee may apply to the Nullity Department for a declaratory decision against any person who industrially produces, places on the market, offers for sale or uses an article, industrially applies a process

or intends to take such measures, to the effect that the subject-matter of the process or product marketed or to be marketed is partially or wholly covered by the patent.

Appeal

A decision at first instance may be appealed. An appeal on points of law and fact is available from the decision of the Commercial Court of Vienna at first instance. Incomplete taking of evidence and/or incomplete assessment thereof will be referred back to the first instance for completion of the procedure for the taking of evidence.

Parallel proceedings

There is a general provision in the Code of Civil Procedure (Section 190) to allow staying of proceedings, if the decision in national court proceedings depends on the result of other parallel proceedings.

See also "Nullity/counterclaim for revocation" above.

Arbitration/mediation

According to national law (Code of Civil Procedure), proceedings concerning the infringement of patents are in principle open to arbitration. Arbitration is not available for requests for patent invalidation.

Enforcement

A bailiff is responsible for the enforcement of the decision.

Compulsory licence

A compulsory licence may be issued by the Nullity Department in cases of dependent patents, non-working of patents, or public interest (Section 36 PA). Under certain circumstances a patent may be revoked if the grant of a compulsory licence for non-working is not sufficient (Section 47 PA).

Relevant national law

Patent Act – Patentgesetz 1970, BGBl 1970/259 as amended by BGBl I 2018/37 [cited as: PA]

Competent authorities or courts

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