
Cancellation and nullity actions at administrative and judicial level

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Austria

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Which differences? How to choose the right way?

Exclusive Competence

- § declaration of revocation/invalidity: exclusive competence of the Nullity Department of the Austrian PTO (§ 35, 39 ATMA)
- since the APTO took over competence of the TM register in 1934 - no amendment in view of the TM Directive 2015
 - very long tradition of administrative revocation/invalidity proceedings
 - until 1.1.2014 „internal“ appeal proceedings to the „Supreme Patent and Trademark Tribunal“
 - Since 1.1.2014:
 - Appeal: Vienna Appeal Court (special division responsible for all appeals from the APTO)
 - Final Instance: Supreme Court – only allowable if admitted by the CoA or in case a question relevant to the unity, consistency or development of Austrian law can be demonstrated (extraordinary appeal)

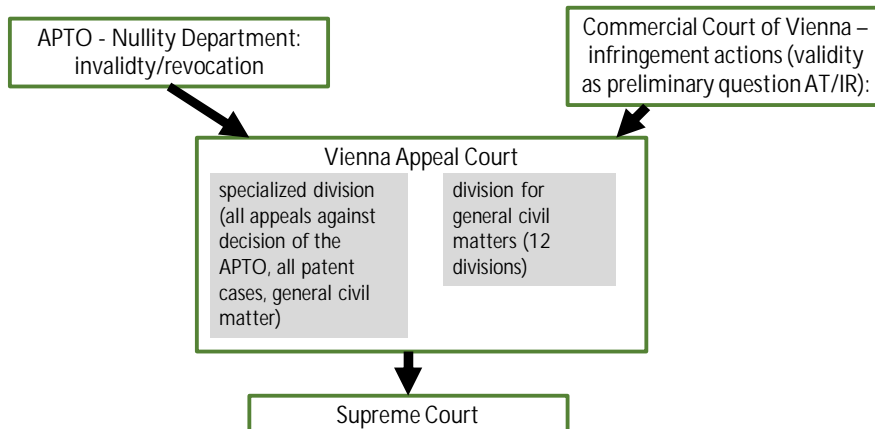
Exclusive Competence

- § The competence for all grounds of revocation /invalidity lies with the Nullity Department:
- elder registered TM/elder unregistered sign/elder company name
 - agent's mark
 - PDO/GI (new)
 - copyright (new)
 - design right (new)
 - absolute grounds
 - non-use
 - generic or misleading indication
 - bad faith

Juridical Competence (1st Instance)

- § Exclusive competence of the Commercial Court of Vienna:
- infringement actions claiming injunctive relief, destruction, damages, etc.
 - validity of the TM in dispute:
 - AT, IR:
 - if the invalidity of the TM in dispute is invoked, the courts are allowed to judge the validity as a preliminary question (*inter partes*)
 - in case invalidity/revocation proceedings are pending the court may stay infringement proceedings (discretionary decision)
 - if infringement proceedings were stayed, the infringement court is bound by the revocation/invalidity decision
 - EUTM:
 - counterclaim or request for invalidity/revocation required (defense of invalidity not sufficient)
 - stay of proceedings mandatory unless there are special grounds for continuing the hearing (Art 132 EUTMR)

Competences (Overview)



Procedural Rules before the ND

- § its own procedural rules enacted in the Austrian Patent Act
 - in addition: civil procedural rules (ZPO) are applicable
 - attention: affidavits not accepted as evidence according to the Austrian ZPO (contrary to opposition proceedings)
- § basic provisions:
 - written procedure:
 - request/response
 - further writs allowed: preparatory writs before the oral hearing usual
 - oral hearing: mandatory
 - attendance of the parties not mandatory

Procedural Rules in Appeals against Decisions of the ND

- § civil procedural rules (ZPO) applicable
- § only appeal writ and response allowed (further writs will be rejected)
- § generally no oral hearing
 - only if the Court of Appeal adjourns a hearing at its own motion (extremely rare)
- § attention: strict prohibition of introducing new matter in appeal proceedings

Duration

- proceedings before the ND:
 - 2 – 4 years
- appeal proceedings before the CoA:
 - 6 - 9 months

Costs

- cost award to the winning party according a fixed fee schedule (attorneys tarif act)
- official fees: 1st instance: EUR 550.-; appeal: EUR 800.-
- fixed amount depending of the value of the case for each writ and oral hearing depending on the duration
- typical cost award in TM invalidation/revocation proceedings:
 - about € 3.000 to € 6.000 1st instance
 - about € 1.500 to € 3.000 appeal proceedings
 - typically equals about 50% to 60% of the actual costs
- if the TM owner renounces the TM within the due date for filing a response -> termination of the proceedings
 - cost award granted only if the TM owner was given a chance for voluntary cancellation -> letter of request generally advisable

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Thank you
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Questions?

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