Lawyers acting as strawmen to clear out the deadwood from the Austrian trademark register

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When doing clearing searches for new trademarks, companies often find themselves facing one or several old trademark registrations that are subject to the use requirement and apparently not in use. Thus, they may consider bringing a **cancellation action for non-use** against the trademark(s) in question. Companies are sometimes hesitant to bring such actions because they do not wish to wake "sleeping dogs". However, there are a couple of good reasons to do so nevertheless:
The most important reason to bring a non-use cancellation is to **avoid** the risk that **use of the old registration is** later **resumed**. In Austria, under current law, such resumed use would cure the non-use and re-establish full protection of the old registration (to the extent and for the goods/services for which genuine use can be established), counting back to the priority date. While the old, formerly unused, mark could not be held against the validity of a later EUTM that was obtained while the Austrian mark was vulnerable, the use of that EUTM could be blocked. And later Austrian marks would be completely defenceless.

This will change once the new Trademark Directive (Directive (EU) 2015/2436, short "new TMD") is implemented in Austria. However, it is yet unclear when this will occur. The transposition deadline is 14 January 2019 (Art. 54 (1) new TMD). Once the regime of the new TMD will apply, its **Articles 18 and 46** will **prevent**

the owner of such a “dormant” old registration as contemplated here from taking **action against** the **registration and use** of the new trademark, because it was filed at a time when the old registration was vulnerable to cancellation for non-use.

The later trademark (the “**intervening right**”) will therefore be safe. That said, the result is **coexistence** between the two registrations (the old registration and the intervening right). This is usually not desirable, and besides, the owner of the intervening right will often be prevented from new filings for the same or a slightly modified trademark if the owner of the old registration (the one that has been “revived”) objects.

When considering whether to bring a cancellation action for non-use against an Austrian trademark registration, the interested party should also bear in mind that it need not necessarily reveal its identity: rather, “***anyone***” may bring a cancellation for non-use request before the competent Austrian Patent Office, without there being a need for legal standing. Accordingly, the request may be brought by a **strawman**, including a **lawyer** (instructed correspondingly), who can bring the cancellation request **in his own name**. The same, by the way, applies on EUIPO level.

There used to be a downside in using a “lawyer strawman” in Austria. While normally the prevailing party in cancellation proceedings gets costs reimbursed from the other party, the Austrian Patent Office took the view that there was **no cost reimbursement** for a successful lawyer who acted in his own name, except for the office fees. Fortunately, the Higher Regional Court Vienna has recently rectified this, clarifying that **also a lawyer acting in his own name is entitled** to full reimbursement according to the Austrian Tariff of Attorneys’ Fees (OLG Wien, 5.12.2016, 34 R 109/16y [unpublished]).

On balance, both under the regime of the current and the new Trademarks Directive, being able to file cancellation actions for non-use in Austria anonymously can work to the advantage of a trademark owner who tried to clear his mark, especially with a medium to long-term view.