

Implementation of the Trademarks Directive in Austria: Noteworthy amendments and other novelties of interest

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As already noted by fellow bloggers in respect to a number of countries, the new Trademarks Directive [Directive (EU) 2015/2436 of 16 December 2015], short "TMD" also required amendments to the Austrian Trademark Law Act. Austria opted for an implementation in two steps: the first set of amendments already entered into force (mostly) on 01 September 2017, the second on 14 January 2019, just in time with the transposition deadline of the TMD (Art. 54 (1)). Additional changes aim to make trademark protection in Austria more attractive and accessible, in particular to SMEs, and to eliminate unnecessary formalities.

Readers of this blog will be familiar with the mandatory amendments required by the TMD, such as the elimination of the requirement for graphical representation of a trademark, the adoption of provisions regarding geographical indications and designations of origin, or provisions on intervening rights, etc., or the (voluntary) introduction of certification marks. A number of changes, in particular in their interplay with existing provisions, however, are likely unexpected for practitioners outside Austria and thus shall be briefly outlined here:

- **Applications for word marks** previously had to consist only of capitals or numbers (and certain other signs) but are now – like at the EUIPO – also

admissible for words consisting of capital and small letters. Office fees for a filing in 3 classes were reduced to € 280,00 (e-filings, and € 300,00 for paper filings).

- Since 1 September 2018, **renewal periods** are calculated from the filing date, instead of the registration date. This is required by the TMD. What's special is that Austria chose to have a long transition period for the new regime, as renewal periods that were already running on 1 September 2018 remain unaffected until after their next renewal. If the application proceedings for a mark took more than a year, there will be proportionate discounts for the first renewal fees (of currently € 700,00) under the new regime, so as to duly reflect the shorter period of protection.
- **Extension of possible grounds in opposition proceedings:** Austria has had *administrative* post-registration opposition proceedings since 2010. So far, oppositions could only be based on prior trademark registrations and applications, and their likelihood of confusion with the opposed trademark. Now, oppositions can also be based on earlier trademark registrations or applications with a reputation, on well-known trademarks within the meaning of Article 6^{bis} of the Paris Convention as well as on designations of origin or geographical indications with protection in Austria. Bad faith filings can only be challenged in cancellation proceedings. Also owners of prior trade names, company names, copyrights or unregistered rights have to resort to **cancellation proceedings**.
- The parties to opposition proceedings may jointly request a kind of **"cooling-off" period** in order to find an amicable solution. The request has to be filed within two months from delivery of an opposition to the trademark owner and allows an extension of the trademark owner's deadline for filing a response or requesting proof of use by up to 6 months. It is to be expected that (but ultimately remains to be seen if) the Austrian PTO will also grant further (reasoned) unilateral or joint extension of time requests.
- **Cancellation proceedings: Prior rights** cancellation requests can now also be based on designations of origin or geographical indications with protection in Austria, as well as on copyrights or designs. Trademark owners under attack may **request** the cancellation applicant to **prove use** of its earlier mark, whereas previously, it would have had to bring a

revocation action against the prior trademark.

The following amendments are unrelated with the TMD, but appear worth mentioning:

- **Administrative proceedings and appeals:** Austria already complies with the TMD in that opposition proceedings and cancellation proceedings are administrative proceedings at first instance. Appeals against the decisions of the PTO (i.e. of the legal department for trademarks, respectively, the invalidity department) may be brought at the Higher Regional Court Vienna, and revision appeals at the Austrian Supreme Court (OGH). Deadlines are longer and fees lower than in regular appeals in civil law matters.
- The provision relating to the refusal of trademarks on **absolute grounds** which are identical with or similar to the signs of certain **international organizations**[*] was amended: Previously, they could not be registered in Austria irrespective of whether their use for certain goods and services was likely to confuse the public. Now, such trademarks applications can only be refused if their registration as a trade mark could cause the public to believe that it has a connection with the organisation concerned or could mislead the public as to the existence of such a connection.
- Finally, the formal requirements for the recordal of trademark assignments were softened, in particular, a notarized signature of the Assignor and (often also) Apostille are usually no longer necessary.

[*] to which a member state of the Paris Convention for the Protection of Intellectual Property is a member, provided that the marks have been published in the Federal Law Gazette.