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Patents 2016

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Austria

Fiebinger Polak Leon Attorneys-at-Law

Karina Hellbert



1 Patent Enforcement

1.1 How and before what tribunals can a patent be enforced against an infringer?

Section 162 of the Austrian Patent Act (*Patentgesetz*, PatG) stipulates that the Commercial Court of Vienna has exclusive jurisdiction for all cases relating to Civil Patent infringement cases. They are handled by a three-judge senate consisting of one technical lay judge (patent attorney) and two professional judges. The Austrian system also provides that a patent infringer can be prosecuted before the Criminal Court. In such a case, the regional Criminal Court of Vienna has exclusive jurisdiction.

In both cases, appeals can be filed to the Higher Regional Court of Vienna. After the decision of the Higher Regional Court of Vienna, a further appeal is possible to the Supreme Court as the last and final instance, whereby only the Supreme Court will deal with the matter. If a question of fundamental legal relevance is an issue, the lower courts deviate from the Case Law established by the Supreme Court.

1.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

There are no mandatory procedure rules that need to be adhered to in a pre-trial negotiation or the like, before proceedings can go to the courts. In practice, the other side is normally contacted and required to sign a cease and desist claim and reimburse the patent owner for the costs of involvement of an attorney. The upside of such an approach would be that the infringers are warned that they can prepare themselves for the trial.

1.3 Can a defence of patent invalidity be raised and if so how?

The invalidity defence is normally the main defence to be relied upon by the infringing party. The procedure rules stipulate that the court primarily assesses the question of validity and can require the party raising this defence to apply for an opinion from the Patent Office, whether the Patent Office considers the patent as invalid, or not. As for the period until the Patent Office has rendered its opinion, the proceedings will be suspended. Such an approach is not possible in interim injunction proceedings, where the court has to base the interim injunction on its preliminary assessment, whether the patent is valid or not. The Austrian Patent Office still

has exclusive competence to declare patents invalid; however, such decision can be reviewed by the Supreme Court.

1.4 How is the case on each side set out pre-trial? Is any technical evidence produced and if so how?

Because there is no specific pre-trial procedure, it is up to the parties to prepare any evidence they consider necessary for proving their case. It is good practice that the plaintiff, at least, provides two expert opinions by either patent attorneys or university professors concerning why the other party is actually infringing the product and with respect to the validity of the patent. The Austrian Patent Office can also draft an opinion with respect to validity, however, normally this is done by a private party. On the other hand, the defendant will prepare the expert opinions that state why no infringement has occurred. Thus, the defendant will prepare the expert opinions that state why the patent is invalid, therefore, not novel and not obvious, respectively no inventive step is given. The potential evidence to be relied upon is regulated in Section 292 *ff.* of the Civil Procedure Court (*Zivilprozessordnung*, ZPO), and comes from documents related to witness interrogations and from house searches, for instance, of violating premises. Article 7 of the Enforcement Directive requires that Member States implement a procedure for preservation of evidence before the main proceedings are initiated. This was implemented by Section 151b of the Patent Act. We are not aware that the Supreme Court has issued a decision with respect to Section 151b of the Patent Act.

1.5 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

The Civil Procedure Court provides the guidelines for submitting and presenting the evidence. In the main proceedings, the plaintiff will file the claim and will also provide sufficient evidence to support the claim so that it is not rejected *a limine*. Within four weeks, the plaintiff has to file the brief also providing sufficient evidence. Seven days before the oral hearing has taken place, the parties can file so-called “preparatory briefs”. In the first oral hearing, the time schedule for the trial will be discussed, as well as whether further evidence is necessary. Also, it will be discussed whether, in addition to the technical lay judge, a court appointed expert is needed. After this, briefs are only allowed to be submitted if so ordered by the court. They will normally also be accepted by the court, if not ordered, if the other side does not pay the costs for this brief. Also, newly provided evidence will not delay the trial. From the moment the judgment is rendered, no new evidence can be filed due to the

prohibition to file new facts; however, the provision of new legal arguments is always possible.

1.6 How long does the trial generally last and how long is it before a judgment is made available?

There is no legally provided deadline within which a judge has to render a decision. Thus, how long the trial in the first instance will take depends on the complexity of the technical issues involved. If only a mere question of law is involved, this can be solved in a couple of months, if there is really a technical issue involved, first instance proceedings can last for years. All proceedings with the Patent Office take a long time. As a rule of thumb, proceedings in the first instance vary between 18 months to two years; a decision by an appellate court is normally reached within one year; and a decision of the Supreme Court (except in interim injunction proceedings) can take up to one year.

In case of criminal proceedings, this can also vary largely.

For preliminary injunction proceedings, one normally takes into account that a decision will be rendered between six and 12 months in the first instance, six months in the second instance, and also six months to one year in the third instance. Normally in Austria, it is the case that an application to obtain an interim injunction is combined with the proceedings on the merits. However, first, the courts will deal with the preliminary injunction issues and only afterwards with the main case.

1.7 Are there specialist judges or hearing officers and if so do they have a technical background?

Please also see our answer to question 1.1. In the first instance, the senate will at least include one technical lay judge, this will also be the case in the second instance. Only at the third instance will no technical judge be involved. In case of criminal proceedings, this is handled by a single judge but normally the single judge will appoint a court expert to assist him.

1.8 What interest must a party have to bring (i) infringement (ii) revocation and (iii) declaratory proceedings?

- (i) **Infringement:** The plaintiff must prove that he is either the owner of the patent or the exclusive licensee of the patent, and must submit evidence with respect to the infringement of its patent rights.
- (ii) **Revocation:** Here it depends, whether the applicant asks for a revocation because the conditions for granting a patent were not met, or that the content of the application, the description drawings, models, etc. were derived from another person without having obtained proper consent from this person. With respect to the first point see our answer under question 1.14.
- (iii) **Declaratory Proceedings:** Any person who manufactures, markets, or is using a certain procedure, can request the Patent Office declare that such person is not violating a specific pattern (negative declaratory proceedings). On the other hand, also any patent owner or exclusive licensee can request the Patent Office states that this conduct could indeed infringe the patent (Second Paragraph). Both applications must be rejected, if already infringement procedures initiated before the court. The costs have to be paid by the applicant, as long as the other party has not set any steps, which would have triggered such a conduct.

1.9 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Discovery procedures *à la* American are not foreseen in Austria. However, if a party refers to certain evidence, the party has to submit such evidence to the court and, thus, furnish the other party also with the evidence. If not done so, the judge can freely evaluate such conduct and it will be held against the party not providing the documents, because then it simply did not prove the facts relevant for establishing the case.

1.10 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of but not all of the infringing product or process?

Section 22 para 3 of the Patent Act contains the necessary provision with respect to contributory infringement. If a person is aware of or it is obvious from the circumstances that infringement could mean the supply of essential elements of a patent is prohibited, if such essential elements can be used for infringing the protected invention. However, this relates only to essential features. Thus, parts which are not of a mere subordinate relevance for the invention, and it also does not relate to parts which can be purchased in any supermarket or home improvement store. In addition, any person who actively helps or supports the infringer may be held liable and the patent owner can file a cease and desist claim ("*Störerhaftung*").

1.11 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

This is also regulated by Section 22 of the Patent Act. If the patent relates to a process, also products produced by relying on this patented process are covered. Thus, if in Austria a patent exists relating to the process, also the putting on the market of the so-produced products, even outside of Austria, constitutes an infringing act.

1.12 Does the scope of protection of a patent claim extend to non-literal equivalents?

This has to be judged by taking into account the claims of the patent. However, the drawings and descriptions used in the patent can be relied upon when interpreting the actual scope of the claims. In this context, the protocol on the interpretation of Article 69 of the European Patent Convention must be taken into account. According to Austrian Case Law, which is quite similar to German Case Law, equivalent use of a patent invention is then given, when a person skilled in the art, with general knowledge in the field at the priority date and also taking into account the prior art, takes the replaced features from the patent claims and this is done without any inventive effort, as the features have the same technical functions. The Austrian Supreme Court, thus, has established a three-steps test:

- **Equal/Same Effect:** If the technical issue can be solved by the patent it can be solved by other means having objectively the same effect.
- **Obviousness:** If the person skilled in the art is able to find the embodiment in question by similar means but having the same effect.

- **Same Value:** In essence this means that any thoughts/considerations necessary for persons skilled in the art, in order to find modified but comparable means are considered as having the same value as the solution of the embodiment according to the patent.

The court requires that all three questions must be cumulatively fulfilled.

1.13 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

The reasons for validation are included in Section 48 of the Austrian Patent Act and are as follows:

- The subject matter of the patent was not patentable according to Sections 1 to 3 (i.e. excluded subject matter, lack of industrial application, etc.).
- The patent is insufficiently disclosed, so that an expert in the field cannot carry out such invention.
- The subject matter of the patent goes beyond the content of the original obligation.
- The biological material is not permanently accessible.

The Novelty Division of the Austrian patent is still competent to declare the patent invalid, however, the decision can be appealed to the Higher Regional Court of Vienna.

1.14 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

See the answer to question 1.13.

1.15 What other grounds of defence can be raised in addition to non-infringement or invalidity?

The defences amongst others are as follows:

- Authorisation by a licence agreement.
- The patent owner has exhausted his rights already.
- Prior use right.
- Intermediary use right.
- Formstein objection: the embodiment which allegedly infringes the patent is state of the art in a prior act and occurred before the priority date.

1.16 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Both are available.

- With respect to preliminary injunction, the rules can be found in Section 151b of the Patent Act in conjunction with Section 381 of the Austrian Enforcement Code. With respect to the enforcement code for patent proceedings, the applicant does not have to evidence any endangerment of the claim or irreparable harm. Also, full proof has to be given with respect to the validity of the patent and the infringement. However, the downside is, if the interim injunction is afterwards for whatever reason lifted, the applicant has to compensate the other party for the damages that occurred. The court also has to decide on the validity on its own and cannot suspend the proceeding for obtaining an opinion by the Patent Office. In Austria, it is current practice that the other side will always be heard in interim proceedings.
- The court will decide on the merits after the plaintiff has provided sufficient proof and evidence that the patent is

valid, as well as that infringement has occurred or will occur imminently. Danger of occurrence must also be proven but it's always legally presumed that, if a single infringement has taken place, that also further infringement acts are set.

1.17 On what basis are damages or an account of profits estimated?

This is regulated by Section 150 of the Patent Act and it really depends on the intent of the infringing party which monetary remedies are available:

- **Adequate Remuneration:** Here the courts rely on the licence analogy, meaning that the patent owner will be compensated by the fact that the infringer must pay an appropriate licence fee. The amount of the licence fee is calculated on a case-by-case basis, taking into account the losses of the patent owner, duration of infringement, sales, etc.
- **Culpable Infringement:**
 - Damages including lost profits: The court will award the difference between the financial status of the patent owner with/without an infringement occurring ("differential method"). So the damage can either be considered as compensation for lost profits, or for the non-achievement of a licence fee.
 - Profits gained by the infringer: In practice, this is not typically relied upon because normally, the accounts of the infringer do not show any substantial profits.
- **Gross-Negligence or Fault:** Twice the amount of the actual damage, irrespective of any proof of any damages.

In essence, the patent owner must choose which method he relies on for calculating its damages. Immaterial damages are possible to trial but this hardly ever happens.

1.18 What other form of relief can be obtained for patent infringement?

The following further reliefs are available, among others:

- Destruction of the infringing product.
- Accounting.
- Publication of the favourable judgment.
- Information with respect to the source of the supplier.

In Austria, as already mentioned, the wilful patent infringement can also be prosecuted as a criminal offence under Section 159 of the Patent Act.

1.19 Are declarations available and if so can they address (i) non-infringement and/or (ii) claim coverage over a technical standard or hypothetical activity?

See our answer to question 1.8.

1.20 After what period is a claim for patent infringement time-barred?

The claims, as mentioned under question 1.18 and respectively question 1.17, are normally time-barred of the period of three years starting from the moment the patent owner has knowledge about the damage and the person infringing the patent. This period is interrupted by filing a civil action or by filing a declaratory petition to the Patent Office (see Section 154 of the Austrian Patent Act). The time bar is normally not an issue in Austria, as long as the process of infringement persists, such limitation cannot start to run.

1.21 Is there a right of appeal from a first instance judgment and if so is it a right to contest all aspects of the judgment?

The first instance decision can be appealed to the Higher Regional Court of Vienna. It can be appealed in total or only partially. However, the appellant is not entitled to introduce new evidences or new facts after the decision was rendered in first instance. A further appeal is possible to the Supreme Court; however, this must be of legal importance.

1.22 What are the typical costs of proceedings to first instance judgment on (i) infringement and (ii) validity; how much of such costs are recoverable from the losing party?

The court fees are calculated on the amount claimed. If the amount claimed does not exceed EUR 210,000, the court fees in the first instance would be EUR 2,779, in the second instance EUR 4,088 and in the third instance EUR 5,450. The plaintiff has to transfer the court fees when filing the action. If the plaintiff prevails, the defendant has to reimburse the plaintiff for the costs.

With respect to legal costs for the representation, the Civil Procedure Court normally states that at the beginning each party has to pay its own costs. The prevailing party will be reimbursed for its costs, but only according to the attorney's tariff fee regulation. Normally, these costs will not cover the fees incurred by the legal representative.

Patent Office Proceedings: Also, here the fees are related to an ordinance. With respect to invalidation proceedings, the costs amount to EUR 700 and if an oral hearing will be scheduled EUR 219 will be due. For appeals to the Higher Court of Vienna against the decision of the Nullity Department, an amount of EUR 680 will be charged. If a decision of the Technical Department is appealed and it is only a one party proceeding, this means that a fee of EUR 355 will be charged.

1.23 For countries within the European Union: What steps are being taken in your country towards ratification, implementation and participation in the Unitary Patent Regulation (EU Regulation No. 1257/2012) and the Agreement on a Unified Patent Court? For countries outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your country?

Austria has ratified the Unitary Patent Regulation and Agreement on a Unified Patent Court already in 2013. However, because the regulation is still not ratified by Germany and the United Kingdom, it has not entered into force.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant and if so how?

The Austrian Patent Act does not contain a similar provision as in Article 150a of the European Patent Convention with respect to limitation/amendment proceedings. Thus, the patent owner can only "amend" its claim by leaving partially or all of his rights to the patent (Section 46 of the Patent Act). Such an application has to be sent to the Patent Office.

2.2 Can a patent be amended in *inter partes* revocation proceedings?

An applicant is free to request that the patent is nullified in total or that only parts of the patent shall be nullified. An infringement claim can also be based on such partially invalidated patent even if official proceedings with respect to the (partial) limitation has not been formally initiated with the patent office. This is only possible if the limitation relates to a narrowing of the patent subject matter.

2.3 Are there any constraints upon the amendments that may be made?

Please see our answers above.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

The Patent Act does not regulate the issue with respect to licence terms. This is more of a competition issue, thus, the terms of the license must comply with the relevant European Union and national competition provisions.

3.2 Can a patent be the subject of a compulsory licence and if so how are the terms settled and how common is this type of licence?

Compulsory licence does not play a role in Austria. However, section 36 of the Patent Act regulates the requirements for the granting of a compulsory licence.

Compulsory licence will be granted if the new patent cannot be used without violation of the older patent and the newer patent constitutes a technical development of significant economic relevance. The patent owner of the older patent must have refused to grant the licence to the newer patent owner and taking into account the public interest, the Patent Office can grant a compulsory licence if the newer patent owner is willing to pay an appropriate fee.

4 Patent Term Extension

4.1 Can the term of a patent be extended and if so (i) on what grounds and (ii) for how long?

The maximum term of patent protection is 20 years from filing the patent application as regulated in Section 28 of the Patent Act. For medicinal products and plant products an extension of this term can be granted in accordance with the relevant supplementary protection certificate regulation. The term will be a maximum of five years. An extension of six months is permissible if the requirements of the Pediatric Regulation are fulfilled.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable and if not what types are excluded?

After the implementation of the TRIPS, a patent shall be granted for

any invention which is new, not obvious to a person skilled in the art and fit for industrial application. Thus, also medicinal products, as well as biotechnology inventions can be covered by a patent. The excluded subject matters are regulated in section 1 to 3 of the Patent Act and are as follows:

- discoveries, any scientific series and mathematical methods;
- the human body in each state of its evolution and development;
- the mere discovery of the human body including DNA sequences or parts thereof;
- aesthetic creations;
- schemes, rules and methods of performing mental acts for playing games or for doing business and programs for computers; and
- the presentation of information.

Section 2 of the Patent Act contains various reasons why a patent will not be granted because such inventions are normally considered against public morals, for example:

- the cloning of human beings;
- methods for amending genetic identity by interfering with the genomes of human beings;
- the use of human embryos;
- methods for changing the genetic identity of animals which would lead to the suffering of these animals without any essential medical benefit for human beings or animals; and
- methods for treatment of humans or animals by surgery, therapy and diagnostic method practice.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

The Patent Office does not have such a duty.

5.3 May the grant of a patent by the Patent Office be opposed by a third party and if so when can this be done?

This is regulated by Section 102 of the Patent Act. A third party can rely on the following grounds for filing an opposition:

- The subject matter of the patent is not patentable according to Section 1 to 3 of the Patent Act.
- The invention is not sufficiently disclosed.
- The subject matter exceeds the content of the patent application as originally filed.
- The biological material as disposed is not permanently available.

A third party has four months to file an opposition.

5.4 Is there a right of appeal from a decision of the Patent Office and if so to whom?

As of January 3rd, 2014 any decision of the Patent Office can be appealed to the Higher Court of Vienna (*Oberlandesgericht Wien*).

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

If the patent application is referring to third parties' descriptions, drawings, etc., this third party can request transfer of the patent (Section 49 of the Patent Act). If an inventor was not mentioned

at all, this person can also apply to the Patent Office to be named as an inventor.

5.6 Is there a "grace period" in your country and if so how long is it?

There is no grace period for filing a patent, a grace period is only granted if the fees are not paid in due time. With respect to the novelty requirement, there is such "grace" because:

- under certain circumstances if information normally destroying novelty is revealed no later than six months before the application is filed and the revealing party has revealed the information in an abusive manner to the applicant or the applicant's predecessor; or
- the applicant or the predecessor has exhibited the invention at an official or officially recognised exhibition of the Convention relating to the International Exhibition Society in Paris on November 22, 1928, then novelty will not be destroyed.

5.7 What is the term of a patent?

20 years from the filing of the application which can be extended under certain circumstances (see also our answer to question 4.1).

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products and if so how quickly are such measures resolved?

Regulation (EU) 608/2013 of the European Parliament and of the Council concerning customs enforcement of intellectual property rights and the Austrian Product Piracy Act 2004 regulate potential seizures of infringing products. For certain products, in particular medicinal products, specific rules also kick in, namely the rules concerning counterfeit products as stipulated in the Medicines Act. In this case, the authorities have to comply with both sets of rules triggering seizure of such products and have to balance the interest of the public and those of the IP holder. One can honestly say that the cooperation with custom authorities is very effective and swift.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

This has to be judged by European Competition Law and Austrian Competition Law. We are not aware of any case law by Austrian courts providing some guidance with respect to the misuse of patent rights.

7.2 What limitations are put on patent licensing due to antitrust law?

The new competition rules for the assessment of technology transfer agreements are laid down by the Commission Regulation (EU) No. 316/2014 of March 21st, 2014 on the application of Article 101 (3) of Degree on the Function of the European Union to Categorise Technology Transfer Agreements as well as further explanations from the European Commission concerning guidelines of the

application of Article 101. Austria has not implemented additional rules. We are not aware of any Supreme Court decision dealing with these new recommendations.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

Austria finally decided to apply for local division with respect to the unitary patents. Controversially, this was quite substantially discussed in Austria. In addition, on November 1st, 2014 the Austrian Patent Office joined the Patent Prosecution Highway Pilot Programme allowing the sharing of search and/or examination results between the participating offices. This sought to accelerate the patenting process overall. Other Member States of the Patent Prosecution Highway Pilot Programme are the United Kingdom, Hungary, Australia, Japan and the United States of America.

8.2 Are there any significant developments expected in the next year?

After having implemented the new appeal mechanism in 2014 no new significant developments are expected for 2015/2016.

8.3 Are there any general practice or enforcement trends that have become apparent in Austria over the last year or so?

Currently all involved players familiarise themselves with the new appeal mechanism and gain experience. It has to be seen whether the new system constitutes an improvement to the old system.



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