

TRADE MARK OFFENSIVE 2017 - AMENDMENTS TO THE AUSTRIAN TRADE MARK PROTECTION ACT ("MARKENSCHUTZGESETZ")

New regulations to the EU's Trade Mark Law were established with Regulation EU 2015/2424 of the European Parliament and of the Council and Directive EU 2015/2436 of the European Parliament and of the Council from 16.12.2015, which entered into force as of 1 October 2017. By implementing the Trade Mark Directive, the Austrian legislators have adapted the Austrian Trade Mark Protection Act (MSchG) to the European requirements within the amendment BGBl I Nr. 124/2017 from 1.8.2017 comprehensively. The amendment to the Trade Mark Protection Act has been in effect since 1 September 2017 for the most part and facilitates the application process in a number of ways.

The purpose of the Directive is to bring national regulations within the member states as well as their laws into harmony with the Regulation to the EU Trade Mark Law. The adjustment is intended to modernise and simplify national trade mark protection to guarantee faster registration proceedings and to sustain the national trade mark as a viable alternative to the EU trade mark.

The major amendments in the Trade Mark Protection Act (MSchG) are the modification of the start of the ten-year trade mark protection period, the option to divide a filed or registered trade mark, the implementation of a certification mark, the facilitation of amendments in the trade mark register and an adjustment to the official fees of the patent office.

NEW CALCULATION METHOD OF THE PROTECTION PERIOD STARTING 1.9.2018 – PROTECTION PERIOD STARTS ON THE APPLICATION DAY

According to § 19 para 1 MSchG, trade mark protection begins with the day of its registration in the trade mark register. Pursuant to the current legal situation, the protection period expires ten years after the trade mark was registered at the end of the month. With the implementation of the new regulation, the ten-year protection period starts with the day the trade mark was filed. A renewal after 1.9.2018 causes an adaption of the protection period, leading to a one-time reduction of the trade mark protection period. This reduction will be compensated by accelerated registration proceedings ("Fast-track proceedings", meaning that the obligatory similarity search of potential prior rights is omitted). The new calculation method of the protection period applies without exception to all trade marks in Austria, thus to registered and applied trade marks.

Example: A trade mark application was filed on 25.1.2009 and registered on 14.3.2010.

The protection period is effective until 31.3.2020. Upon the next renewal, the trade mark will be protected until 25.1.2029 "only" (10 years from the day of application), which causes a one-time reduction of the protection period. The economic disadvantage will be compensated for by a reduction of the renewal fees.

OPTION TO DIVIDE A FILED OR REGISTERED TRADE MARK

Since 1.9.2017, §§ 23a ff MSchG provide the option to divide the application/registration of a trade mark into two or more applications/registrations. The divisional application/registration has the same priority rights as the basic application/registration. For the division, a fee of EUR 200.00 will be charged, which must be paid within two months, otherwise the application for division will be considered as not filed. Such applications for division might be beneficial during the process of filing for trade mark protection, in which the patent office has concerns about the distinctiveness of parts of the trade mark. With the division of the trade mark application, the registration proceedings can move forward with the indisputable parts of the filed application.

Such a division cannot be filed between the registration of the trade mark in the trade mark register and the end of the objection period. Applications filed for division will be rejected during this phase. This regulation will prevent interferences or complications in case of enforcement of prior trade mark rights.

Regarding international trade marks with trade mark protection in Austria, the division will be available as of 1.2.2019 (§ 70a MSchG). Such applications for division must be filed at the Austrian Patent Office.

CERTIFICATION MARKS ON A NATIONAL LEVEL

As a counterpart to the EU Certification Mark, a national certification mark (quality mark) was implemented in the Austrian trade mark laws (§ 63a und §§ 65, 66a MSchG). The certification mark is appropriate for distinguishing goods or services in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, from uncertified products. Explicitly excluded from protection of the certification mark is the indication of the geographical origin. Certification marks can only be filed by persons who do not have an economic interest in the success of the mark. The regulations have also been in effect since 1.9.2017.

TRADE MARK ASSIGNMENTS WITHOUT NOTARIAL CERTIFICATION

Up until now, it was necessary, according to § 28 MSchG, to file a written application form along with the original documents or certified transcripts thereof, which provide evidence of the amendments to the rights on the trade mark, with the Austrian Patent Office in order to amend an entry in the trade mark register (for example the entry of licenses or a right of lien on a trade mark). The amendment of the MSchG brought essential simplifications in this regard. According to § 28 para 2 MSchG, the submission of uncertified copies of the original documents, on which basis the amendments should be

made, are sufficient for the application of amendments in the trade mark register. In the case the original document is a domestic or foreign document, which was not issued by a public authority, the current certification standards still apply, i.e. the signature as well as the authority of the authorized person to sign must be certified (and – in the case of foreign documents – also re-certified).

An exception to this regulation is the assignment of trade marks: Instead of the assignment document, a corresponding declaration of the parties (former and new trade mark owner) or their legal representatives suffices. The declaration of assignment can be filed within the assignment application or in a separate document and requires the signatures of both parties. These signatures no longer have to be certified by a notary. As a result, the proceedings of trade mark assignments at the Austrian Patent Office will be significantly easier.

However, according to § 28 para 3 MSchG, in cases of doubt, the patent office still has the option to demand further documents, originals or certified copies as evidence of the assignment of the rights on the trade mark.

REDUCTION OF OFFICIAL FEES AS INCENTIVE FOR START-UPS & SMEs

A crucial cost factor during the application of a trade mark used to be the obligatory similarity research on possible prior rights regarding prior trade mark rights performed by the Austrian Patent Office during the application proceedings. Beginning on 1.9.2017, this automatically performed research is no longer obligatory for the registration of a trade mark, which affects the official application fees for the application of a trade mark and is reflected in lower costs: EUR 304.00 for a written application and EUR 284.00 for an online application. However, the applicant is still able to request an optional similarity research. Further, the progressive fee structure regarding the renewal fees was removed. The renewal fees remain steady during the whole protection period. A list with the current fees of the Austrian Patent Office can be found under the following link:

<https://www.patentamt.at/en/trademarks/apply-for-trademarks/fees/>

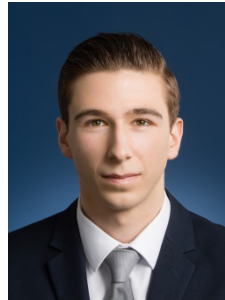
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