

# Trademarks 2022

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# Trademarks

## 2022

**Contributing editors**

**Theodore H Davis Jr and Olivia Maria Baratta**  
Kilpatrick Townsend & Stockton LLP

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Lexology Getting The Deal Through is delighted to publish the eighteenth edition of *Trademarks*, which is available in print and online at [www.lexology.com/gtdt](http://www.lexology.com/gtdt).

Lexology Getting The Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique Lexology Getting The Deal Through format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes a new chapter on the United Kingdom.

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Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Lexology Getting The Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editors, Theodore H Davis Jr and Olivia Maria Baratta of Kilpatrick Townsend & Stockton LLP for their continued assistance with this volume.



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# Austria

Peter Israiloff

Barger Piso & Partner

## LEGAL FRAMEWORK

### Domestic law

1 | What is the primary legislation governing trademarks in your jurisdiction?

- The Austrian Trademark Act 1970, as amended; and
- Regulation (EU) No. 2017/1001 (the EU Trademark Regulation).

### International law

2 | Which international trademark agreements has your jurisdiction signed?

- The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks;
- the Madrid System (including the Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol); and
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks.

### Regulators

3 | Which government bodies regulate trademark law?

- The Austrian Patent Office;
- the Vienna Commercial Court;
- the Vienna Upper Provincial Court; and
- the Austrian Supreme Court.

## REGISTRATION AND USE

### Ownership of marks

4 | Who may apply for registration?

Any physical or legal person, alone or in combination, may apply for a trademark, irrespective of running a related business. Collective marks and guarantee marks may be applied for by associations with legal personality as well as by corporate bodies.

### Scope of trademark

5 | What may and may not be protected and registered as a trademark?

Trademarks may consist of any signs as long as they are distinctive and may be presented in any way (ie, not only graphically) in particular words, including personal names, designs, letters, numerals and the shape or style of the goods, provided that such signs are capable of distinguishing the goods or services of one enterprise from those of other enterprises.

Three-dimensional marks and sound marks are protectable when fulfilling the above-mentioned criteria.

Haptic or olfactory trademarks are still not registrable.

Signs that exclusively consist of state coats of arms, national flags or other national emblems or of the coats of arms of Austrian provincial or local authorities, official test or guarantee signs and signs of international organisations to which a member country of the Paris Convention belongs are excluded from registration.

Further excluded signs include those:

- that lack distinctiveness;
- that are descriptive;
- that have become customary in the current language;
- that consist exclusively of the shape of the goods resulting from their nature or necessary to obtain a technical result or giving them a substantial value;
- that violate public policy or accepted principles of morality;
- that are deceptive;
- that contain or consist of protected geographical indications or designations of origin;
- that resemble traditional terms for wine or specialities; and
- that are terms for plant varieties.

### Unregistered trademarks

6 | Can trademark rights be established without registration?

Non-registered trademarks are termed in Austria as (mere) 'signs' and may have protection according to article 9 of the Austrian Law Against Unfair Competition under the following conditions.

Names of establishments or premises, outlets, etc, as well as domain names (ie, sub-level domains) are considered as 'special designations' provided they do not correspond with the name or firm name itself. They, therefore, enjoy protection if misused by a third party in the course of business. However, direct protection is only accepted in the case of distinctiveness per se. Otherwise, acquired distinctiveness has to be proven. Special designations are considered (eg, names of establishments or premises and outlets) as well as domain names (ie, sub-level domains) as long as they do not correspond with the name or firm name itself. Business symbols and other devices used to distinguish one enterprise from another, particularly the shape of goods, their packaging or wrapping and business papers (eg, letters showing the letterhead, the firm's logo or name, firm stamps on letters) that are recognised as being representative of the enterprise by the trade involved are also deemed to constitute special designations of an enterprise. However, they enjoy protection only with proof of acquired distinctiveness among the business circles involved, which depends on the specific case and may sometimes encompass the whole population of Austria, or, on the contrary, only a limited circle of specialists.

The injured party may sue the infringing party at the Vienna Commercial Court to refrain from misuse, whereby the usual remedies

are available. The claim for injunctive relief and elimination lapses, however, after six months from the end of the infringement. For all other claims there is a limitation period of three years. The claim for injunctive relief lapses after five years of knowledge of the infringement of the sign, provided that the infringer has not acted in bad faith.

### Famous foreign trademarks

**7 | Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?**

The owner of a famous foreign trademark can act against an applicant or user of an identical or confusingly similar registered or unregistered domestic trademark by claiming that the domestic applicant or user acts in bad faith to hinder the foreign owner to enter the domestic market. Any appropriate evidence for the fame of the foreign trademark is accepted.

Based on a senior well-known trademark in the sense of article 6-bis of the Paris Convention, which does not need to be registered or effective in Austria, opposition against a junior domestic trademark can be filed.

### The benefits of registration

**8 | What are the benefits of registration?**

A registered trademark confers on its owner the exclusive right to prevent third parties that do not have his or her consent from using, in the course of trade:

- a sign that is identical to the trademark in relation to goods or services that are identical to those for which the trademark is registered;
- a sign that is identical or similar to the trademark in relation to goods or services that are identical or similar to those for which the trademark is registered, if a likelihood exists of confusion on the part of the public, including the likelihood of association between the sign and the trademark; or
- a sign that is identical or similar to the trademark in relation to goods or services that are not similar to those for which the trademark is registered, where the latter is well known in Austria and where use of that sign, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the trademark.

An owner of a registered trademark can stop the transfer of goods from third countries where they were brought into the market without his or her consent (ie, he or she can more effectively act against product piracy). The entitlement for prevention lapses, however, if the declarant of the goods can prove, in the course of the product piracy suit, that they can lawfully be brought into the market in the country of final destination. It can also act in advance against designation means (eg, packaging and labels, etc) comprising the trademark or to which the trademark can be adapted well before these means are brought into contact with the goods and services.

A registered trademark is prima facie evidence of an existing right before any administrative authority or court. However, in a trial, a court may examine the validity of a registered trademark in suit as a preliminary question.

On the basis of a registered trademark, one may apply for border seizures of counterfeit goods.

### Filing procedure and documentation

**9 | What documentation is needed to file a trademark application? What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?**

A trademark application must be filed in writing. Electronic filing is available, accompanied, if applicable, by any data carrier presenting the trademark and the goods or services. Trademark searches are available. In the course of an application a search can be requested when paying an additional fee. The official fee for a single hardcopy (paper) trademark application is €300; for an online application, it is €280. For collective or certification marks the official fees are €480 and €460 respectively. No additional documentation referring to the applicant is needed. An appointed domestic representative requires a power of attorney.

### Registration time frame and cost

**10 | How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?**

If there are no complications, a registration can be obtained within two to six months; otherwise, it can take several years. Costs for up to three classes (official and attorneys' fees) total between €1,500 and €2,200. Extra costs may arise for further classes (multi-class applications are possible) or in the case of complications (eg, adaptation of lists of goods, professional efforts in the case of objections and complaints about rejection decisions). Registration comes formally into effect on the date of entry into the Trademark Register.

### Classification system

**11 | What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?**

Goods and services are classified according to the Nice Classification. Class headings as well as items from the published list of goods and services (11th edition) may be used. Terms not contained in the list often encounter objections. Multi-class applications are available and might save, depending on the number of classes, up to about 50 per cent of the total costs in comparison with an equivalent number of theoretical single-class applications.

### Examination procedure

**12 | What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?**

Applications are not examined for conflicts with other trademarks. Thus, parties cannot interfere in the application procedure. There is only an examination as to formalities (eg, the correct classification) and absolute bars. Objections raised by the Patent Office may be responded to by the applicant. An official similarity report is released upon request by the applicant.

Senior (trademark) rights are no bar to registration but may give rise to opposition or cancellation action after registration of the new trademark.

### Use of a trademark and registration

**13** Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Pre-use of a trademark is not required for registration. Therefore, no proof of use has to be submitted. Based on a foreign application, one can claim, within six months, priority for a domestic application, irrespective of whether the foreign application leads to registration. Mere use in a foreign country does not give rise to priority.

Starting from the end of the opposition period or the end of opposition proceedings respectively, a trademark owner has a five-year grace period within which the trademark cannot be contested on the grounds of non-use. After that period, anyone may file a cancellation action based on non-use. In such a case, maintenance of the trademark will depend on proof of use or justification of non-use.

### Markings

**14** What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

The indication of a trademark is not compulsory and therefore has no legal effect. Analogous to foreign regulations, some trademark owners use an ® or the letters ™ in a circle to indicate that the trademark is registered. However, such indication has no benefit.

On the other hand, it might be deceptive if, for example, the symbol ® appears after the word of a registered combined word-design mark, when the word per se does not enjoy protection. It also might be regarded as deceptive when the symbol ® is used in combination with a trademark not yet registered (pending application).

### Appealing a denied application

**15** Is there an appeal process if the application is denied?

Recourse can be made to the Vienna Upper Provincial Court in respect of the rejection of an application. Against a negative resolution, revisional recourse can be lodged at the Supreme Court of Austria, provided that all prerequisites are fulfilled.

### Third-party opposition

**16** Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

An opposition may be filed within three months starting from the publication date of a registered Austrian trademark, or within three months starting with the first day of the next month after the publication of

a registered international trademark covering Austria, respectively. Opposition may be based on:

- a senior trademark application or registered trademark (ie, Austrian trademark, international trademark valid in Austria and EU trademark);
- a senior trademark well known in Austria and covering dissimilar goods or services;
- a senior notorious trademark (which does not need to be registered or effective in Austria); or
- a senior designation of origin or geographical indication.

The opposition procedure is generally conducted in written form. At the request of one of the parties an oral hearing must be held. An oral hearing may also be held ex officio. A plea of lack of use of the trademark on which the opposition was based may be brought forward. In that case the opposer need not furnish full proof of use but must only show prima facie evidence of use. In the case of an action (eg, based on non-use) against the trademark on which the opposition is based the opposition proceedings shall be suspended.

If there are several oppositions against the same trademark, the most promising opposition may be continued, whereas the other oppositions will be suspended. Upon a joint application of both parties it is possible to get a cooling-off period of six months at the most. An opposition proceeding is deemed terminated on the day a suspension agreement of both parties is received by the Patent Office or appeal court (Vienna Upper Provincial Court or Supreme Court). The decision on an opposition is rendered by a single member of the Legal Department of the Austrian Patent Office. If an opposition is partly or fully granted the opposed trademark is quashed (not cancelled) from the beginning of its duration of protection. Recourse can be made to the Vienna Upper Provincial Court in respect of an opposition decision. In opposition proceedings, each party must bear its own costs, which may be about €1,100 if no proof of use or oral hearing is requested.

After registration, a third party may file a cancellation action with the Nullity Department of the Austrian Patent Office.

Any third party may base its action on:

- absolute grounds (lack of distinctiveness, descriptiveness, deceptiveness or generic name, etc) at the time of application;
- bad faith in the course of the application (in the foregoing two cases, the trademark will be deleted retroactively from the date of registration);
- development of the trademark to become deceptive or generic after registration (in these cases the cancellation will be effective from the proven date of the finalised development);
- non-use (in this case the cancellation will have effect from five years before the date of filing the cancellation action, but not earlier than five years after registration);
- bad faith, for example, purported by a foreign brand owner whose brand, either identical or similar, is registered in Austria by someone else with the intention to hinder the foreign brand owner from entering the Austrian market;
- a senior designation of origin or geographical indication;
- a claim for discontinuance according to the Copyright Act (eg, title of a work as word mark); and
- a claim for discontinuance according to the Design Act (eg, planar design as (part of) a design mark).

The holder of a prior right (registered or unregistered trademark or trade name, etc) may base a cancellation action on relative grounds, namely, confusing similarity between the senior sign and junior trademark in respect of the registered goods and services. In the case of a well-known senior right, cancellation may also be demanded for dissimilar goods and services. In these cases, the cancellation has retroactive

effect from the date of registration. However, the right to file a cancellation action by a prior rights holder based on relative grounds is forfeited after five years from the date of knowledge of the use of the younger trademark.

In cancellation proceedings, an oral hearing is scheduled after prior exchange of the applicant's writ and trademark owner's counter-writ. The final decision of the Nullity Department of the Patent Office may be appealed at the Vienna Upper Provincial Court. Costs for a cancellation action in each instance may be about €5,000.

### Duration and maintenance of registration

**17** | How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

The trademark right is effective from the date of registration in the trademark register.

The period of protection of trademarks registered from 1 September 2018, lasting 10 years from the day of application, may be extended repeatedly for 10-year periods by paying a renewal fee.

The protection period of trademarks registered before 1 September 2018 ends 10 years after the end of the month in which the trademark was registered. Whenever the period of such trademarks ends, the next period will be calculated from the respective application date and the renewal fee will be reduced in relation to the reduction of the next following period.

Besides the renewal fee, no other requirements, such as proof of use, are necessary. The Austrian Patent Office does not release a renewal certificate, so the payment receipt is the only proof of renewal besides an extract from the trademark register. The payment can be effected during the last year of the 10-year period or, with an excess fee, within six months of expiry thereof.

### Surrender

**18** | What is the procedure for surrendering a trademark registration?

A trademark owner can surrender his, her or its trademark either by filing a request with the Austrian Patent Office or by non-payment of the renewal fee.

### Related IP rights

**19** | Can trademarks be protected under other IP rights?

Further IP rights accord trademark protection as follows:

- trademarks, especially non-registered ones, can be protected by the Unfair Competition Act;
- names of physical or legal persons, including pseudonyms, are protected by the General Civil Act;
- company names or designations of enterprises are protected by the Company Act;
- trademarks that are regarded as a 'work' in the sense of the Copyright Act (Creator's Act) have protection by that act; and
- if a trademark resembles a two- or three-dimensional design, it may also claim protection by the Design Act.

### Trademarks online and domain names

**20** | What regime governs the protection of trademarks online and domain names?

The protection of registered or non-registered trademarks, names, designations, signs – irrespective of whether they are on- or offline – is governed by one and the same regime (ie, overwhelmingly by the

Trademark Act, the Unfair Competition Act and the General Civil Act). In a conflict between domain names and trademarks on the one hand and priorities on the other, the respective fields of business or goods and services are crucial for evaluating against a risk of confusion.

## LICENSING AND ASSIGNMENT

### Licences

**21** | May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement?

A trademark may be the subject of an exclusive or non-exclusive licence covering the whole or part of Austrian territory and, in respect of the complete list of goods or services, part of it. The licence may be recorded in the trademark register. However, the registration has only declaratory character (ie, only serves to inform the public) and is not decisive for the legal validity or effect of the licence (eg, whether the licensee has a right of action against an infringing third party depends only on the content of the licence agreement and not on the registration of the licence in the trademark register).

The benefit of a recorded licence lies in the fact that trademark infringers cannot successfully argue, if decisive, that they did not know about the licence.

A licence agreement typically includes, besides the usual provisions, duties and rights of the licensor and licensee, especially with regard to any violations of the trademark.

### Assignment

**22** | What can be assigned?

A trademark may be assigned with or without goodwill or the business concerned for all or part of the registered goods and services. Where the assignment would deceive the public, the assignee must consent to any restrictions to remedy the deception.

### Assignment documentation

**23** | What documents are required for assignment and what form must they take? What procedures apply?

Two options exist.

A deed of assignment or a document referring to the assignment is needed as the original or a copy. The signature of the assignor must be notarised, whereby the notary public must state that the person signing the document is entitled to sign on behalf of the assignor on the date of signing in a legally binding manner. Depending on the countries involved, the notarisation needs to be super-legalised diplomatically or by a Hague apostille. The signature of the assignee requires no legalisation.

Instead of an assignment document, a unanimous assignment declaration by the parties or their representatives, which does not require any legalisation, may be submitted to the Patent Office. The Patent Office still reserves, however, the right to request any originals, certified copies or further documents. In both cases, representatives just require a non-legal power of attorney. Professional representatives may simply rely on their power of attorney without filing it with the Patent Office.

### Validity of assignment

**24** | Must the assignment be recorded for purposes of its validity?

Recording an assignment is not mandatory. However, until such time as the transfer of the mark has been recorded, the right to the mark may not be asserted before the Patent Office, and all communications

concerning the mark served on the registered owner of the mark shall have effect with regard to the mark's acquirer.

### Security interests

**25** | Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

Licences, liens and other security interests may be recorded in the trademark register. However, that register is only declaratory (serving to inform the public). This means that the entry of such interests, etc, in the trademark register is not identical to the acquisition of the right and is not binding on third parties.

The signature of the licensor or pledgor, etc, must be notarised, whereby the notary public must state that the person signing the document is entitled to sign on behalf of the licensor or pledgor, etc, on the date of signing in a legally binding manner. Depending on the countries involved, the notarisation needs to be super-legalised diplomatically or by a Hague apostille. The signature of the licensee or pledgee, etc, requires no legalisation.

The application for registration may be filed either by the licensor or pledgor, etc, or by the licensee or pledgee, etc, on the basis of an original document or a copy thereof. Any representative needs a respective power of attorney.

It is not necessary to file the complete licence contract or lien document, etc. For registration, a simple licence declaration or lien declaration from which the essential conditions can be gathered is sufficient.

## ENFORCEMENT

### Trademark enforcement proceedings

**26** | What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Infringers (dilutive users are also regarded as infringers) of Austrian trademarks or of international trademarks covering Austria may be sued in the first instance at the Vienna Commercial Court or the Vienna Provincial Court for Criminal Matters, or both, on the basis of Austrian Trademark Act 1970, as amended, which contains civil and criminal claims against trademark infringements. The second instance is the Vienna Upper Provincial Court. If admissible, for example, if questions of general importance are touched on, then the third instance is the Supreme Court of Austria.

Infringements of EU trademarks may be sued in the first instance at the Vienna Commercial Court or the Vienna Provincial Court for Criminal Matters.

Seizures of counterfeit goods may be effected upon request by the Austrian Customs Authorities according to EU regulations and the Austrian Product Piracy Act. The withheld goods shall be destroyed if the importer does not oppose the seizure. If it does oppose, however, it is up to the trademark owner to launch, within a given term, a civil or criminal proceeding; otherwise, the counterfeit goods are released.

### Procedural format and timing

**27** | What is the format of the infringement proceeding?

In civil matters, a single judge decides in the first instance. In the second or third instance, the decision is released by a board or senate. Any type

of suitable evidence is permitted, including live testimony. There is no discovery procedure. Each party may rely on private experts and their opinions. The court may appoint an official expert, for example, when acquired distinctiveness is questionable.

In each instance, a decision in the regular proceedings may be expected after about one year. In preliminary injunction proceedings, the periods may be shorter.

Criminal trademark matters are also heard in the first instance by a single judge.

### Burden of proof

**28** | What is the burden of proof to establish infringement or dilution?

The full burden of proof lies with the plaintiff; that is, the trademark owner or (if empowered) his, her or its licensee. Any type of evidence that is deemed to be appropriate may be brought forward.

### Standing

**29** | Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

Remedy may be claimed by anybody whose rights to a trademark are infringed, namely, by the trademark owner or a derivative thereof (the licensee, etc). The original or derived trademark right is to be proved to the court.

Criminal complaints may be raised by the injured physical or legal person within six weeks of the knowledge of the action and the offender.

### Border enforcement and foreign activities

**30** | What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?

Based on trademark rights (Austrian, EU or international trademarks), an owner may file a request with the Austrian customs authorities for seizure of counterfeit goods in import, export and transit. When the goods were brought into the market of a third country without consent of the trademark owner, the owner's entitlement for prevention of the transfer lapses, however, if the goods' declarant can prove, in the course of the product piracy suit, that they can lawfully be brought into the market in the country of final destination.

In general, foreign activities cannot support a charge of infringement or dilution. However, for example, if a company has a prior foreign (registered or unregistered) trademark and a competitor files in Austria a similar or identical junior trademark to hinder the first company from entering into the Austrian market, then the first company may successfully sue the competitor for having registered its trademark in bad faith so that the junior trademark will be cancelled *ex tunc*.

### Discovery

**31** | What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

In accordance with Directive 2004/48/EC (enforcement of intellectual property rights), which was introduced into domestic law, the Vienna Commercial Court may order that the infringing party should submit well-defined evidence that it holds. Preliminary injunctions may not only be released for securing of the claim itself but also for preservation of evidence. Such preliminary injunctions may even be released without

hearing the defendant if the injured party may probably suffer a non-repairable damage or if there is a risk that evidence will be destroyed. Searching of premises under civil law (as well as under criminal law) may be ordered.

### Timing

**32 | What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?**

In provisional proceedings claiming a temporary injunction, a decision in the first instance may be expected within a couple of months. For each instance of appeal, the time frame is, at most, one year. In main proceedings, each instance might last about one year.

### Limitation period

**33 | What is the limitation period for filing an infringement action?**

The right of a trademark owner to sue an infringer is forfeited after five consecutive years of knowledge and toleration of the infringement, as long as the infringement has not occurred in bad faith.

### Litigation costs

**34 | What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?**

Costs depend on the value of the litigation. In the first instance, the overall costs range from about €7,000 to about €14,000. In the instances of appeal, one should calculate at least €10,000 per instance. A successful plaintiff can recover part of the costs from the infringer. It is generally regulated by law that the losing party must refund the costs of the procedure and representation to the winning party on basis of the value of litigation. However, these costs are usually lower than the overall costs of the proceedings.

### Appeals

**35 | What avenues of appeal are available?**

Recourse or appeal to the Vienna Upper Provincial Court may be made in respect of resolutions and judgments at first instance (the Vienna Commercial Court). If admitted, another appeal (revision or revisional recourse) to the Supreme Court of Austria may be launched. If not admitted, an extraordinary appeal to the Supreme Court may be filed.

### Defences

**36 | What defences are available to a charge of infringement or dilution, or any related action?**

Substantive defence arguments may be:

- the trademark in suit is not valid;
- the allegedly infringing sign is not used as a trademark;
- lack of confusion (no similarity between the trademark in suit and the alleged infringing sign, or no similarity of goods and services);
- the trademark in suit is not well known;
- fair use of the allegedly infringing sign with due cause;
- prior rights in respect of the trademark in suit on the basis of qualified pre-use;
- exhaustion of the trademark right;
- bad faith of the plaintiff; or
- limitation or forfeiture of the right to sue.

### Remedies

**37 | What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?**

The civil remedies available include:

- ceasing of the infringement (preliminary or permanent injunction);
- claim for elimination of the circumstances constituting the violation of the law (eg, destruction of the infringing goods);
- rendering of account;
- publication of the judgment; and
- monetary relief, namely:
  - adequate remuneration (licence analogy);
  - twice that remuneration in the event of gross negligence or intention; and
  - damages, in the event of wilful infringement, including the profits of which the plaintiff has been deprived, or surrender of the profits realised by the infringer through the trademark infringement.

If the trademark in suit has been registered for more than five years, a preliminary injunction is only granted if it is substantiated that the trademark is not vulnerable to cancellation owing to non-use.

The available criminal remedies are:

- a monetary fine of up to 360 times the per diem rate for calculating fines; and
- imprisonment for up to two years in the case of professional infringement.

### ADR

**38 | Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?**

Alternative dispute resolution techniques are commonly used and an attempt is first made to settle the pending dispute by negotiations. Sometimes mediation is accepted by the parties or they agree to contact a local or international arbitration board. The benefits of such techniques lie in saving time and money. The risks are that all these measures do not exclude eventually going to court.

## UPDATE AND TRENDS

### Key developments of the past year

**39 | Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?**

#### Amendment of the Austrian Patent Attorney's Act

On 14 May 2021, an amendment of the Austrian Patent Attorney's Act was published and came into force on the following day (Federal Gazette I, No. 88/21). The amendment's main focus was to bring its act into conformance with EU regulations, especially to mixed partnerships and patent attorney societies (eg, patent attorneys with attorneys at law, patent attorneys with tax advisors, etc), which must bear in their name a reference to the professions performed.

#### Unlawful use of a trademark

Caused by a famous ski racer's career coming to an end, a bank placed, in electronic and print media, an insert showing next to its own logo the helmet of the ski racer. The helmet showed an emblem, protected by a trademark, of a rival bank that sponsored the racer. The rival bank requested the release of a preliminary injunction to prohibit the first bank from advertising itself using the emblem of the rival bank.

Moreover, because the logo of the first bank was placed in the foreground, an incorrect impression was given suggesting that the first bank might also sponsor the ski racer.

The court of first instance (the Vienna Commercial Court) rejected the request for the injunction on the grounds that the emblem of the rival bank had not been used to designate the origin of services of the first bank. The court of recourse (the Vienna Upper Provincial Court (VUPC)) granted, however, the request for the injunction. It held that the first bank had used the trademark of the rival bank for the purpose of its own promotion and, therefore, the rival bank had a claim for discontinuance due to unlawful use of a trademark (VUPC, 20 January 2020, 133 R 132/19p – Austrian Gazette for IP and Copyright 2020, 226).

### Trademark as keyword

The owner of the word-design mark 'TAXICOMPANY, driving your business' for transportation services sued a competing taxi service enterprise for discontinuance because the latter had marked the word 'taxicompany' on Google as a keyword and, therefore, was listed on the first page of the Google search results. However, the competing taxi service did not provide on its website an explanation that a commercial relationship between the companies did not exist. Moreover, the competing taxi service had used the slogan 'we drive your business' in its advertisements.

The plaintiff succeeded in all three instances. The Austrian Supreme Court confirmed the interdictions that were ordered by the lower instances on the grounds that the use of a trademark or part of it as a keyword interferes with the rights of a trademark owner when the probability of deception is not excluded and when the promotional slogan is confusingly similar to the trademark (Austrian Supreme Court, 21 February 2020, 4 Ob 30/20w).

In another case, the Austrian Supreme Court stated that keyword advertising does not infringe trademark rights if an ordinarily informed and adequately alert internet user can easily recognise, on the basis of the search results, that the goods or services promoted in the advertisement do not originate from the trademark owner or from a commercially allied enterprise (Supreme Court, 20 October 2020, 4 Ob 152/20m – ÖBl 2021, 125).

### Non-use cancellation of a trademark

Two design trademarks that depicted a sitting flying bull and were registered, among others, for casino appliances, and services of casinos, restaurants and hotels faced cancellation proceedings based on alleged similarity to senior trademarks. These proceedings were launched two years after registration but were interrupted due to the unclear validity of the senior trademarks. At the end of the five-year grace period of use, cancellation actions based on alleged non-use were filed, to which the trademark owner responded by justification of the non-use due to the cancellation actions filed before. The Nullity Department of the Austrian Patent Office accepted this argumentation for some of the goods and services, whereas the court of appeal (VUPC) rejected it completely. The VUPC held that filing a cancellation action against a trademark does not hinder the trademark owner from using it because a collision with the senior rights of third parties belongs, by tendency, to the normal risk of an entrepreneur and is, therefore, not a justified reason for non-use of the trademark (VUPC, 20 May 2020, 33R20/20h – Patent Bulletin 2020, 66).

### Collision between firm name and trademark

A foreign enterprise with the name 'RAT PACK Filmproduktion', which produces cinema and television films, filed a cancellation action against the word mark 'RAT PAC'. The latter was registered for the production and financing of films and for providing food, drinks and temporary accommodation. The cancellation action was completely successful

before the Nullity Department of the Austrian Patent Office. Upon appeal by the trademark owner, the VUPC amended, however, the final decision of the Nullity Department in that the trademark was upheld in the scope of providing food, drinks and temporary accommodation. In this connection, the VUPC pointed out, among other statements:

*The right of an entrepreneur to act against a trademark which could entail in the course of business confusion with his firm name does not depend on a registration in the Austrian Register of Companies but on long-term domestic use of the firm name in commercial business.*

The question of risk of confusion is to be determined on basis of the commercial field of the entrepreneur, and the registered goods and services of the trademark. A remote commercial field excludes the risk of confusion (VUPC, 28 April 2020, 33R5/20b – Patent Bulletin 2021, 6).

### Name and trademark as meta tags

The provider of a web portal that listed physicians residing in Austria was sued by a doctor on the basis of an alleged violation of her rights of name and trademark, as well as unfair competition. The doctor argued that the web portal used her name or trademark, respectively, as meta tags to optimise its search engine results (ie, to gain a primary ranking for the web portal).

The corresponding claim for a temporary injunction was dismissed in all three court instances (the Vienna Commercial Court, the VUPC and the Supreme Court) because the use of another designation as a meta tag does not violate fairness law or trademark law, provided that there exists a justified interest in the use of the designation. Moreover, no prioritisation of the defendant's website in relation to that of the plaintiff occurred on any search engines, so the reproach of parasitic exploitation had already failed on the level of facts (Supreme Court, 19 December 2019, 4 Ob 223/19a – ÖBl 2020, 261).

### Exhaustion of trademark right

An online shop for perfumery and cosmetic products delivered branded products in cartons, on which several trademarks, the promotional slogan 'BEAUTY FOR LESS' and the designation 'easyCOSMETIC' were printed. The shop was sued for discontinuance by the licensee of a trademark owner because, according to the trademark owner's opinion, such use was inconsistent with the image of luxury trademarks and therefore violated the justified interests of the trademark owner.

The court of first instance (the Vienna Commercial Court) granted the request for release of a temporary discontinuance order, whereas the two upper instances (the VUPC and the Supreme Court) dismissed it. It was held that the trademark right of the trademark owner was exhausted and that there were no justified grounds to prohibit further distribution. The advertising material of the online shop was admissible and did not give the misleading impression of a commercial connection between that shop and the trademark owner (Supreme Court, 22 August 2019, 4 Ob 127/19h – ÖBl 2020, 265).

### Geographical indication

The word-design mark 'Sophienwald' (AT 285 107) for, among other goods, glassware was, upon the request of a third party, classified as a geographical indication by the VUPC. This was confirmed by the Austrian Supreme Court (in the course of a rejected extraordinary revision) and was therefore cancelled ab initio. Before that, the Nullity Department of the Austrian Patent Office denied the classification as a geographical indication on the grounds that the public would be unlikely to associate the trademark with glassware. The VUPC assumed, however, that even though outdated and historical designations ('Sophienwald' has been well known for glassware since the 19th century in Austria) are

excluded from trademark protection, if the public involved still understands them as place names, a connection between the place and the products is established. Therefore, not only the average informed and alert consumer is decisive, but also the respective business people who have a broader knowledge of all the circumstances of the geographical localisation of the production of the goods are to be considered (VUPC, 11 July 2019, 133 R 20/19t; VUPC, 26 November 2019, 4 Ob 152/19k).

#### **Distinctiveness v descriptiveness or promotional statements**

The publisher of a newspaper named 'DER STANDARD', which has long been sold in Austria, filed a respective trademark application that was rejected by the Austrian Patent Office on the grounds that 'DER STANDARD' is regarded as a mere promotional description. The VUPC confirmed this decision, whereas the Supreme Court overturned it and held that 'STANDARD' is a common word with different meanings. The Supreme Court held that the public involved could not immediately derive an unequivocal relation between the term and the quality of the products in question (printed matter, newspapers etc) because that affords mental activities that might lead to different results, even if the designation would be regarded by the public as an advertising message (Austrian Supreme Court, 22 December 2020, 4 Ob 198/20a).

#### **Similarity between bicycles and automobiles**

The owner of EU trademark No. 311 449 KONA for 'bicycles and their parts' (class 10) opposed the protection of international trademark No. 1 331 235 KONA for 'automobiles' (class 12) and succeeded before the Austrian Patent Office and the VUPC. The latter held that a risk of confusion is present if the trade involved would assume that the offered cars originate from a bicycle producer and vice versa. Similarity of goods also depends on whether such products are usually produced in one and the same enterprise. Big automobile producers often also offer bicycles under their brand, although perhaps sometimes as mere merchandising articles. Therefore, bicycles and automobiles do not differ enough for the public to exclude, in any way or at least predominantly, that they, when branded with an identical trademark, originate from one and the same enterprise, thus creating a risk of confusion (VUPC, 21 May 2019, 133 R 42/19b – Patent Gazette 2020, 4).

#### **Lack of similarity of trademarks**

During opposition proceedings, the VUPC denied the similarity of senior trademark 'AMINOVA' to junior trademark 'AMINEO' (both for similar goods). It argued that the different endings 'OVA' and 'EO' (or – when pronounced – 'NOVA' and 'NEO') may clearly be delimited so that the common beginning of the words is secondary, as the endings of words are generally more prominent. In addition, the VUPC held that the identical meaning of 'NOVA' and 'NEO' (ie, new) was not to be considered or neglectable, respectively, due to a lack of risk of confusion. This decision is not comprehensible (VUPC, 28 August 2019, 133 R 68/19a – Patent Gazette 2020, 32).

#### **Genuine trademark use**

During a cancellation action based on alleged non-use against Austrian trademark 'CERESOL' (for edible oils and fats of class 29), the trademark owner brought evidence of use of its trademark 'CERES' (for the same goods) and argued that 'OL' is, on one hand, a common ending without contribution to the distinctiveness and, on the other hand, insinuates an association with the term 'oil'.

The Nullity Department of the Austrian Patent Office, confirmed by the VUPC, cancelled the trademark 'CERESOL'. The VUPC held that an overall evaluation of both signs, considering pronunciation and recognised meaning, leads 'CERES' phonically and conceptually away from the registered mark 'CERESOL', and the trade involved has no reason to regard both as one and the same mark. The ending 'OL' in 'CERESOL' has

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no descriptive meaning. In connection with the registered goods (oils and fats), the public would not be likely to understand this ending as a usual ending for alcohols and phenols in organic chemistry. Moreover, a person who knows the meaning of the ending 'ol' or who associates 'sol' with the sun would be less of the opinion that 'CERES' and 'CERESOL' carry the same meaning (VUPC, 22 November 2019, 133 R 86/19z – Patent Gazette 2020, 38).

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