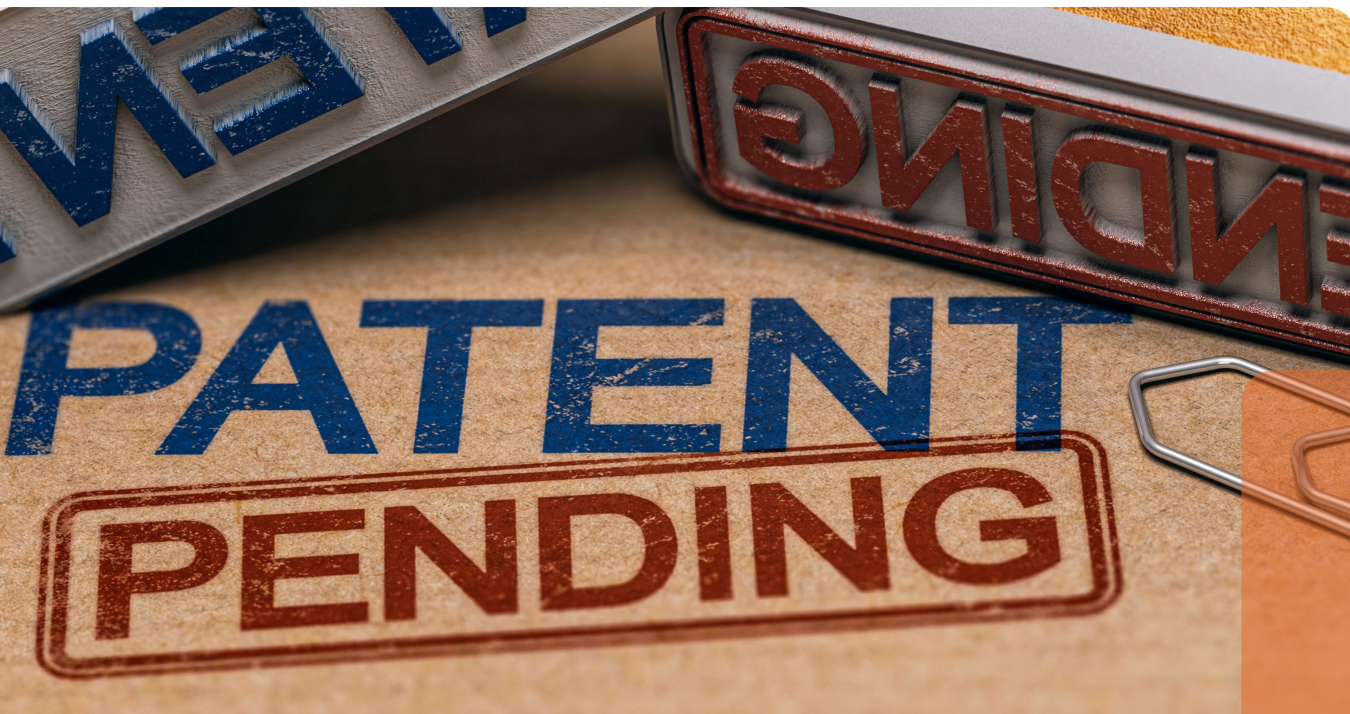


**International
Comparative
Legal Guides**



Patents

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14th Edition

Contributing Editor:
Katharine Stephens
Bird & Bird LLP

glg Global Legal Group

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Austria

GRAF ISOLA Rechtsanwälte GmbH
REDL Life Science Patent Attorneys



Claudia Csáky



Gerda Redl

1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

Pursuant to Sect 162 (1) Patent Act, the Commercial Court of Vienna ("court") has exclusive jurisdiction for infringement claims in relation to patents.

1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

The parties to court proceedings cannot be required to undertake mediation before commencing court proceedings. The judge may propose mediation, but if one of the parties denies the proposal a mediation does not take place.

1.3 Who is permitted to represent parties to a patent dispute in court?

Legal attorneys and/or patent attorneys can each individually represent parties in patent disputes in the first and the second instance. In front of the Supreme Court, a legal attorney must be involved.

1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

In order to commence proceedings on the merits, the plaintiff must file an action with the court. The court fee depends on the value in dispute. If the claims raised do not consist of claims for money, the plaintiff must evaluate the value of the claims (Sect 59 JN). The court fee must be paid when filing the action. In proceedings on the merits, it generally takes six to 12 months to reach the trial stage after commencement of the proceedings. Interim injunctions can be obtained more quickly.

1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

There is no discovery under Austrian law. However, the Austrian civil procedure is shaped by the principle of substantive truth-finding. In order to achieve this, the parties are obliged to contribute to the truthful collection of material and to support each other. Among other things, the rules of evidence procedure, which cover almost all evidence, are characterised by the fact that (also) the party not burdened with evidence is obliged to cooperate in the evidence procedure. Moreover, any person whose rights under a patent have been infringed may request information about the origin and the distribution channels of the infringing goods and services, provided that this would not be disproportionate to the gravity of the infringement and would not violate statutory duties of confidentiality; the infringer and the persons who (i) commercially have had infringing goods in their possession, (ii) made use of infringing services, or (iii) have provided services used for infringement must provide the relevant information. The duty to provide information includes, as appropriate, information on: (i) the names and addresses of the manufacturers, distributors, suppliers and other previous owners of the goods or services, as well as the commercial customers and points of sale for which they were intended; and (ii) the quantities of the goods produced, delivered, received or ordered and the prices paid for the goods or services (Sect 151a Patent Act).

1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

There are no specific steps a party must take pre-trial. Each party must ensure that it is entitled to enforce the patent and is able to prove the allegations made. Thus, for practical purposes, the plaintiff as well as a potential defendant are strongly advised to prepare all technical evidence that support their respective positions pre-trial.

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

The plaintiff must present the arguments in the claim brief and must indicate the evidence on which it will rely to support its

claim. Evidence need not be submitted with the claim brief. The same goes for the defendant.

The parties must submit documentary evidence prior to the trial hearing and name the persons to be heard as parties (representatives of parties), witnesses or expert witnesses at trial. Parties, witnesses and expert witnesses are heard at the trial by the trial judge. The parties' representatives may question the persons interviewed. Under certain circumstances, it is possible that the taking of witness evidence is carried out by an appointed or requested judge.

The parties can request that visual evidence be taken. If no such request is made by the parties, but the judge deems visual evidence relevant, the court can order the taking of such evidence *ex officio* without restriction. The same goes for expert evidence that can also be ordered by the court *ex officio*.

A party can change its pleaded arguments before and/or at trial in the first instance.

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

The duration of a trial depends on the facts of a case. If the facts are disputed and a number of parties, witnesses and/or expert witnesses have to be heard and/or visual evidence has to be taken, the trial can stretch over a prolonged period of time. It depends on the judge handling the matter whether the hearings take place in a streamlined manner within a short period of time, e.g. within one or two weeks, or whether they are divided into individual hearings that take place within a longer period of time. Generally, a judgment is rendered between one or two years after the closure of the proceedings by the judge.

1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

Apart from proceedings to obtain an interim injunction, there is no alternative procedure available.

1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

Judgments of the Supreme Court are published in an anonymised form. Judgments of the Appeals Court in Vienna (second instance) and the court (first instance) are sometimes published, provided they become final.

Third parties cannot request copies of an unpublished judgment.

1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?

Courts are not obliged to follow precedents from previous similar cases as a matter of binding authority. In practice, however, the courts follow precedents from previous similar cases. The courts might consider decisions of other jurisdictions but are not obliged to do so.

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

Pursuant to Sect 162 in connection with Sect 146 Patent Act, patent matters are decided in the first instance by a panel consisting of a professional judge and a lay judge with a technical background. In the second instance the panel consists of two professional judges and one lay judge and in the third instance of three professional judges and two lay judges. Generally, patent attorneys with the required technical background are appointed as lay judges.

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

Any person (legal entity) can initiate infringement proceedings with the court against a person or legal entity that has infringed its patent (protection certificate).

Any person (legal entity) can initiate revocation proceedings with the Patent Office if they believe that a patent is null and void. The grounds for nullity of a patent are pursuant to Sect 48 Patent Act: if the subject-matter of the patent was not patentable under Sects 1 to 3 (i.e. a patent has been granted for an invention that does not fall in a field of technology, if the invention was not new; if the invention was obvious to a person skilled in the art from the prior art or if it is not susceptible to industrial application); the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art; the subject-matter of the patent goes beyond the content of the application as originally filed; or the biological material deposited was not permanently accessible.

Any person (legal entity) who manufactures, markets, offers for sale or uses an article in the course of her business, or applies a process in the course of her business, or intends to do so, may apply to the Patent Office for a declaration against the proprietor of a patent or the exclusive licensee that the article or process is not covered, in whole or in part, by the patent (Sect 163 (1) Patent Act).

Likewise, the proprietor of a patent or the exclusive licensee may apply to the Patent Office for a declaration that the subject-matter or process is wholly or partly covered by the patent against any person who manufactures, puts on the market, displays or uses subject-matter or applies a process in an industrial or commercial manner or intends to do so (Sect 163 (2) Patent Act).

The Patent Office will reject such application for a declaratory decision if the defendant proves that an infringement action concerning the same subject-matter or the same process is pending before the court between the same parties.

1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

Declarations can address non-infringement or infringement (see above). A party can provide expert opinions, e.g. of a certified court expert who can provide an opinion on validity/invalidity or infringement/non-infringement.

1.15 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?

A party can be liable for infringement as a secondary infringer if it offers or supplies means relating to an essential element of the invention for the use of the invention to persons other than those entitled to use the invention, provided such third party knows or it is obvious from the circumstances that such means are suitable and intended to be used for the use of the invention. A party can infringe by supplying part of, but not all of, the infringing product or process (Sect 22 (3) Patent Act).

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

Pursuant to Sect 22 (2) Patent Act, a patent granted for a process extends to the products directly manufactured by this process. Therefore, if a process is carried out outside of Austrian jurisdiction and the first product manufactured according to the patented process is imported into Austria, an infringement of the process patent takes place in Austria.

1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?

The scope of protection of a patent can extend to non-literal equivalents in relation to infringement.

1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

The defendant may raise a nullity defence in infringement proceedings. If a nullity defence is raised, the court must, in proceedings on the merits, examine the question of the validity independently. The court typically asks a certified court expert (a patent attorney) to provide a legal opinion, but may also request the Patent Office to prepare a written opinion as to whether, on the basis of the documents submitted in the court proceedings, it is probable that the patent is invalid. If the court considers the invalidity of the patent probable on the basis of the evidence (or the respective legal opinion), the proceedings must be interrupted and the defendant must prove within one month that either an application for a declaration of invalidity has been filed with the Patent Office or invalidity proceedings between the parties are already pending or that she has joined such proceedings as an intervening party (or an opposition pursuant to Art 99 EPC). Failing such proof, the court continues the proceedings on the merits at the request of the plaintiff. The case will then be decided without regard to the plea of nullity. If, however, the patent is declared invalid before the conclusion of the oral proceedings, such a decision must be taken into account.

A defendant may also raise the nullity defence in interim proceedings but must be able to provide evidence straight away, which in general consists of a respective expert opinion of a patent attorney (typically made by a certified court expert). The court must decide without recourse to the Patent Office whether

the nullity defence is valid. According to case law, the defendant must demonstrate the patent to be highly likely invalid in order to be successful.

1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the “Formstein defence”)?

The defendant can raise the *Formstein* defence in infringement proceedings, thus arguing that the equivalent would have lacked novelty or an inventive step over the prior art at the priority date of the patent.

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

Grounds for invalidity of a patent, apart from lack of novelty and inventive step, are that a patent has been granted for an invention that is exempted from patent protection, the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, the subject-matter of the patent goes beyond the content of the application as originally filed and the biological material deposited was not permanently accessible (Sect 48 Patent Act).

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

If a nullity defence is raised in infringement proceedings on the merits, it is at the court’s discretion to stay the proceedings during the invalidity proceedings conducted by the Patent Office. If the court believes that the patent is likely invalid, it must stay the proceedings (Sect 156 (3) Patent Act).

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

Apart from the defences of non-infringement and invalidity a defendant could, if applicable, raise (i) a “prior use” defence, (ii) an “interim right of use” defence, and (iii) a “right of further use” defence.

Pursuant to Sect 23 Patent Act, the effects of a patent do not apply to a person (natural or legal person) who has already created and used a foreign patent-protected invention in her own business before the priority date of the invention. The right of prior use originates and exists alongside the patent as a separate right to the invention.

Pursuant to Sect 136 Patent Act, a person who has been prevented through no fault of her own from complying with a time limit set by the Patent Office and due to which a patent (patent application) has lapsed may apply for reinstatement in the prior state. If granted, the patent in question would become effective again. A third party acting in good faith who, relying on the lapse of the patent (patent application), had used the subject-matter of the patent (patent application) before the grant of the reinstatement, is protected by an interim right of use. The interim right of use basically corresponds to the prior-use right.

Under specific circumstances, proceedings that led to the revocation, withdrawal or declaration of invalidity of a patent may be resumed. If a resumption is granted, persons who had

used the subject-matter of the patent (patent application) prior to the granting of the resumption are protected by interim rights of use (Sect 127 Patent Act).

If the Patent Office entered by mistake the revocation of a patent in the patent register, it must order the cancellation of this entry and publish it. In such a case, third persons who acquired rights in good faith in the meantime can rely on an interim right of use.

If someone has manufactured the subject-matter of the invention in the period between the filing of the patent application and the publication of the invention applied for, said person is entitled to continue to use the lawfully produced subject-matter of the invention under Sects 22 and 101 Patent Act. This “right of further use” only protects what the honest intermediate user has actually created in reliance on the patent freedom, but does not give a right to further use of the invention as such.

1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available? (c) Is a public interest defence available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device?

Preliminary injunctions are available on (i) an *ex parte* basis, and (ii) an *inter partes* basis. Interim injunctions are issued at the request of the party at risk without hearing the opposing party if the party at risk would probably suffer irreparable damage as a result of a delay or if there is a risk that evidence will be destroyed (Sect 151b (4) Patent Act).

Interim injunctions may be issued to secure claims for injunctive relief and removal even without certifying that the claims are at risk.

Pursuant to Sect 390 (2) Enforcement Code (“EO”), the court may – even if the claim is sufficiently certified – make the granting of the interim injunction dependent on a corresponding security deposit by the plaintiff if, according to the circumstances of the case, there are concerns about profound interference with the interests of the defendant.

Pursuant to Sect 391 (1) EO, the court must determine an exemption amount when granting the interim injunction if it believes that the deposit of said exemption amount is sufficient to secure the plaintiff according to the nature of the case. If the defendant pays the exemption amount or provides other security that appears sufficient to the court, the defendant may apply for the interim injunction to be lifted (Sect 399 (1) EO).

Austrian law does not accept protective letters.

Final injunctions are not available. If an interim injunction is granted before the commencement of proceedings, the order must specify a reasonable period within which proceedings should be commenced. If the time limit expires without result, the interim injunction will be revoked upon application or *ex officio* (Sect 391 (2) EO).

If the granting of a licence to a patented invention is required in the public interest, everyone is entitled to a non-exclusive licence to the invention for their business (Sect 36 (5) Patent Act). The requirement to obtain the consent of the person entitled to grant a licence may, however, be waived in the event of a national emergency or other circumstances of extreme urgency (Sect 37 (3) Patent Act). In this case, provisional authorisation to use the invention can be granted by the nullity department of the Patent Office by interim decision (Sect 60 (3) no 3 Patent Act). The law does not regulate whether a third party may successfully argue in infringement proceedings that it

would be entitled to a compulsory licence under Sect 36 (5) and therefore an infringement must be denied. So far, there also seems to be no case law relating to this issue. As Sect 37 (3) Patent Act expressly provides for an interim decision of the Patent Office, it would appear that a defendant would need to obtain an interim decision in order to argue non-infringement due to the right to be granted a compulsory licence. See also the answer to question 3.2.

1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive/flagrancy damages available?

Whether or not damages or an account of profits are assessed at the same time as issues of infringement/validity depends on the facts of the case. If the court believes it is likely that the patent will be deemed invalid, it must stay the proceedings and give the defendant the opportunity to lodge nullity proceedings in front of the Patent Office (Sect 156 (3) Patent Act). Once the issue of validity has either been clarified by the Patent Office or through failure of the defendant to lodge or join proceedings pending with the Patent Office, the court will decide on the issue of infringement. If the plaintiff raised a claim for rendering account, the court will decide first on the infringement claim and the claim for rendering account in an interim judgment. Once the interim judgment has become final, the claim for damages will be dealt with.

The plaintiff must prove that the damages were caused by the infringement of the patent, the negligence of the infringer (generally no issue) and the amount in damages claimed (the damage claim includes a claim for loss of profit). Instead of claiming damages, the plaintiff can also claim a reasonable licence fee (no fault on the part of the defendant required). In case the defendant acted with gross negligence, the plaintiff may claim twice the reasonable licence fee.

Punitive/flagrancy damages are not available.

1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

Claims for money are enforced by various means depending on the assets the debtor has (e.g. creation of a lien on a real estate, compulsory administration of a real estate, foreclosure auction, execution of moveable property, execution on monetary claims).

Cease-and-desist claims are enforced by levying punitive fines upon application of the plaintiff if, and as long as, the defendant does not meet its obligation (Sect 355 EO).

1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

If an infringement of an Austrian patent or the Austrian part of a European patent is at stake, enforcement will take place only in regard to the Austrian patent/part.

1.27 How common is settlement of infringement proceedings prior to trial?

In patent cases, the plaintiff generally applies for an interim injunction. If the plaintiff wins, the parties more often than not settle the case before trial.

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

Claims for money are time-barred after three years from knowing the infringer and the damage (Sect 154 Patent Act in combination with Sect 1489 General Civil Code). The same goes for the claim for rendering account. The law does regulate as to when cease-and-desist claims become time-barred. The general view is after three years from the end of the infringing activities. As long as the infringement continues, claims cannot be time-barred.

1.29 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?

Judgments by the court can be appealed to the Appeals Court in Vienna. All aspects of the judgment can be contested. However, the appeal brief must meet strict formal requirements.

1.30 What effect does an appeal have on the award of: (i) an injunction; (ii) an enquiry as to damages or an account of profits; or (iii) an order that a patent be revoked?

An appeal does not have any effect on an injunction already granted. If a judgment concerning the rendering of account of profits is appealed, the defendant must render account only after the judgment has become final. The same goes for claims for money.

1.31 Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

Appeal proceedings are generally conducted in writing unless the Appeals Court believes that an oral hearing is necessary. New evidence must not be produced on appeal.

1.32 How long does it usually take for an appeal to be heard?

It usually takes one to two years until an appeal is heard.

1.33 How many levels of appeal are there? Is there a right to a second level of appeal? How often in practice is there a second level of appeal in patent cases?

The parties may be able to lodge an appeal to the Supreme Court. There are, however, stringent prerequisites for such further appeal. Appeals to the Supreme Court in patent cases are rare.

1.34 What are the typical costs of proceedings to a first instance judgment on: (i) infringement; and (ii) validity? How much of such costs are recoverable from the losing party? What are the typical costs of an appeal and are they recoverable?

The costs of proceedings strongly depend on the complexity of the matter. If expert opinions are necessary, the costs of first instance proceedings can easily reach up to EUR 100,000 or more. The winning party has a claim for reimbursement of the

legal costs, including patent attorney costs. The costs are calculated on the basis of the Ordinance on Attorney's Fee (the calculation basis is the value in dispute). The cost to be reimbursed rarely covers the actual costs.

1.35 For jurisdictions within the European Union: What is the status in your jurisdiction on ratifying the Unified Patent Court Agreement and preparing for the unitary patent package? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

The Unified Patent Court Agreement came into force in Austria on June 1, 2023. The Austrian Local Division is based in Althanstrasse 39–45, 1090 Vienna.

2 Patent Amendment

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

Pursuant to Sect 91 (3) Patent Act, the description, claims, drawings and abstract may be amended until the decision to grant is taken. If the amendments affect the essence of the invention, they are excluded from the application and, if the applicant wishes to obtain protection also for them, they must be filed separately. Pursuant to Sect 46 (2) Patent Act, the patentee may abandon or limit the patent or individual parts of the patent. In the latter case, the patent remains valid with respect to the remaining parts, provided that they can still form the subject-matter of an independent patent.

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

The patentee can request limitation of the patent at any time.

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

Amendments under Sect 91 (3) Patent Act must not exceed the original disclosure and must not extend the scope of protection of the patent.

3 Licensing

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

There are no laws limiting the terms of a patent licence agreement.

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?

Sect 36 Patent Act provides for a compulsory licence. Pursuant to Sect 37 (1), an appropriate remuneration shall be determined, taking into account the economic value of the licence.

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 term of a patent cannot be extended. However, it is possible to obtain supplementary protection certificates for approved active pharmaceutical ingredients or plant protection products that are covered by a patent. The maximum duration of a supplementary protection certificate is five years.

5 Patent Prosecution and Opposition

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

Pursuant to Sect 1 (3) Patent Act, inventions that concern the following are not regarded as inventions (non-exhaustive list):

1. discoveries, as well as scientific theories and mathematical methods;
2. the human body at the various stages of its formation and development;
3. the simple discovery of one of the elements of the human body, including the sequence or partial sequence of a gene;
4. aesthetic creations;
5. schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers; and
6. presentations of information.

In addition, Sect 2 Patent Act excludes patent protection in respect to:

- (a) inventions the exploitation of which would be contrary to “*ordre public*” or morality. Within this meaning, the following, in particular, is considered unpatentable:
 - (i) processes for cloning human beings;
 - (ii) processes for modifying the germ line genetic identity of human beings;
 - (iii) uses of human embryos;
 - (iv) the production and exploitation of chimeras generated from germ cells, totipotent cells or cell nuclei of human beings and animals; and
 - (v) processes for modifying the genetic identity of animals that are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes;
- (b) methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods; and
- (c) plant or animal varieties, as well as for essentially biological processes for the production of plants or animals. Inventions that concern a microbiological or other technical process or a product obtained by means of such a process are patentable.

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?

There is no duty to disclose any relevant prior disclosures or documents.

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?

Third parties may oppose the grant of a patent within four months from the date of publication of the grant of the patent.

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

Decisions of the Patent Office can be appealed to the Appeals Court in Vienna (Sect 138 Patent Act).

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

Pursuant to Sect 49 Patent Act, a patent lapses by revocation if (i) the patentee was not entitled to the grant of the patent, or (ii) the essential content was taken from the application of another person or from a process used by him without his consent.

5.6 Is there a “grace period” in your jurisdiction, and if so, how long is it?

There is a grace period of six months in respect to a disclosure of the invention before the filing of the patent application, provided (i) the disclosure is attributable to an obvious misuse to the detriment of the applicant, or (ii) the applicant has exhibited the invention at official or officially recognised exhibitions. In the latter case, the applicant must comply with certain conditions to be able to rely on the grace period.

5.7 What is the term of a patent?

Twenty years from the filing date of the application (Sect 28 Patent Act).

5.8 Is double patenting allowed?

Under Austrian law, double patenting is allowed.

5.9 For jurisdictions within the European Union: Once the Unified Patent Court Agreement enters into force, will a Unitary Patent, on grant, take effect in your jurisdiction?

A Unitary Patent will, on grant, take effect in Austria.

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?

Applications for actions can be filed with the Customs Authority in Villach, which is competent to receive and process such applications. If goods are seized, the declarant or holder of goods has 10 days to challenge the withholding/destruction of the goods. In case of a challenge, legal proceedings must be conducted.

7 Antitrust Law and Inequitable Conduct

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

Antitrust law can be deployed to prevent relief for patent infringement being granted.

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

The conditions of a patent licensing agreement must not violate the antitrust ban (Art 101 AEUV, Sect 1 Cartel Act) or entail an abuse of a dominant position or a violation of the core restrictions of the Technology Transfer Regulation.

7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts set FRAND terms (or would they do so in principle)? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

Technical trials on patent validity of standard essential patents are heard separately from proceedings relating to FRAND licences. In infringement cases, a FRAND defence may be raised. FRAND terms would not be set by the courts. So far, there seems to be no case law in Austria concerning FRAND injunctions.

8 Current Developments

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

A significant development in relation to patents is the coming into force of the Unified Patent Court (“UPC”) Agreement.

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

Apart from the European Commission’s patent package, none.

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

No, there are not.

Note

The answers provided herein refer to Austrian national proceedings, not to proceedings before the UPC (which has exclusive jurisdiction regarding European Patent Office patents, unless an Opt-Out is requested).



Claudia Csáky heads the IP and IT practice group of GRAF ISOLA. She has more than 25 years' experience in the entire field of IP law with a focus on trademark, copyright, patent law and competition law, as well as IT. Claudia also has specific expertise and experience in litigation and enforcement including patent litigation. She also has a strong focus on life science matters and advises a number of leading enterprises, including in regulatory matters. In the field of trademark law, she advises well-known domestic and foreign clients across all sectors. She also often advises on IP aspects in the course of corporate restructuring and transactions. Claudia is a member of the German Association for the Protection of Intellectual Property ("GRUR") and the Bulletins Committee of the International Trademark Association ("INTA"), the Education Committee of MARQUES and the Austrian Association for the Protection of Intellectual Property ("ÖV"). She represents MARQUES on the Examination Board of the EUIPO Trade Mark and Design Education Programme ("ETMD EP"). Claudia is also a lecturer at the Master Programme Magister Lvcentinvs EUTM Intensive Seminar, Alicante, Spain.

GRAF ISOLA Rechtsanwälte GmbH
Stadiongasse 2
A-1010 Vienna
Austria

Tel: +43 1 40117 67
Email: c.csaky@grafisola.at
URL: www.grafisola.at



Gerda Redl is an Austrian and European Patent Attorney, a Trademark and Design Attorney, and Representative before the UPC, qualified as a European Patent Litigator with a diploma from the University of Strasbourg. She is a Sworn Certified Court Expert for patent affairs, in particular chemistry and biotechnology.

Gerda is a patent attorney with more than 20 years' experience in the life sciences industry. Her technical expertise is in the fields of biotechnology, biochemistry and chemistry including protein engineering, biologicals and small molecules, biomarkers, antibodies, alternative scaffolds and libraries. She graduated as a biochemist and received her Ph.D. in microbiology from the Technical University of Vienna.

Prior to founding REDL Life Science Patent Attorneys, she held senior management positions in biotech, mid-sized pharma and big pharma companies. Over the course of more than 20 years of work in the life science industry, she has built a strong network throughout Europe, the US, and Asia, including decision makers and gate keepers responsible for licensing and partnering.

REDL Life Science Patent Attorneys
Donau-City-Strasse 11
1220 Vienna
Austria

Tel: +43 1 93466 05
Email: office@redlpatent.com
URL: www.redlpatent.com

GRAF ISOLA was founded in 1994 and is a commercial law firm with offices in Vienna and Graz. As a full-service law firm, GRAF ISOLA advises a broad cross-section of Austrian and international clients in all aspects of business law. GRAF ISOLA cooperates with international law firms across the globe. With a legal staff of over 25 experts, several of whom are also foreign-trained, GRAF ISOLA combines many years of international experience and a specialist approach to delivering bespoke solutions. GRAF ISOLA has broad experience in a number of practice areas, including IP & IT, Banking and Finance, Competition and Antitrust, Compliance/White-Collar Crime, Corporate/M&A, Data Protection, Dispute Resolution & Litigation, Employment Law & Expats, Estate Planning/Trust & Estates, Insolvency and Restructuring, International Trade/Foreign Trade Law and Sanctions, Real Estate & Construction, Regulatory. GRAF ISOLA has been, for many years, listed as a top law firm by prominent independent legal directories such as *Chambers*, *The Legal 500*, *IFLR1000* as well as *JUVE Handbook*.

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