

## **Amendments to Austrian Trademark Law**

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Recently, the Austrian Trademark Protection Act (MSchG) was amended in order to partly implement the EU Trademark Directive 2015/2436 and to better adapt the national provisions to the needs of trademark owners – "Trademark Initiative 2017" by the Austrian Intellectual Property Office (IPO). Most of the amendments have been in force since 1 September 2017.

In particular, the harmonised calculation method of the protection period of trademarks was transposed. Certification marks and the possibility to divide a trademark application or registration were introduced. Furthermore, the Austrian legislator lowered the official fees, streamlined the application procedure and facilitated amendments in the trademark register.

### **Calculation of due date and reduction of renewal fees**

The ten-year protection period of national Austrian trademarks (=due date for renewal) will be calculated from the date of application. This provision is applicable from 1 September 2018 and puts an end to the Austrian particularity of calculating the protection period from the end of the month in which the trademark was registered.

The protection period of trademarks with due dates on or after 1 September 2018 will be calculated according to the new method. Thus, the renewal of trademarks registered after August 2018 will be due ten years after their application. As regards trademarks with registration date before September 2018, their current protection period remains unchanged, but upon the next renewal, the date of application will serve as the basis for calculating the following due date. This will lead to a one-time curtailment of the duration of protection amounting to the time which lapsed from the filing of the trademark application to its registration. To offset this disadvantage, a gradual reduction of the renewal fee is provided if the protection period is curtailed by more than one year.

A uniform fee of EUR 700 for individual marks and EUR 1,300 for collective marks and certification marks will replace the current fee scale (which depended on the previous duration of registration) for the renewal of trademarks with a due date on or after September 2018. For detailed information on renewal fees, please see the [Austrian IPO's information sheet](#).

### **Faster and cheaper trademark application procedures**

The registration fees were reduced to a total amount of EUR 284 for online applications for individual marks and EUR 464 for collective marks and certification marks. Applications filed by paper cost EUR 20 more. As before, the application fees cover up to three classes; an extra fee of EUR 75 is incurred for each additional class. Availability searches are no longer part of the application procedure, but can be requested by applicants for an extra fee of EUR 40.

The Austrian IPO introduced so-called "fast track applications" for the same fee, which lead to registration within two weeks if no further interaction is necessary. This procedure is available for the application of word/figurative individual marks which are filed and paid online and exclusively contain terms of the harmonised database to specify the goods and services.

"Pre-check", which comprises a reasoned trademark similarity search, a commercial register search and an assessment of protectability, is another new service offered by the Austrian IPO.

### **Introduction of certification marks**

Certification marks were introduced in Austria on 1 September 2017, one month prior to their introduction in the EU trademark system. This new kind of mark does not indicate the origin of the goods and services, but their compliance with certain standards. These standards are defined by the trademark owner and may concern quality, material, mode of manufacture of goods or performance of services, accuracy or other characteristics, except geographical origin. The owners' duty is to certify and monitor the use of the certification mark. They must not have an own interest in the economic success of the certified goods and services.

### **Facilitation of records in the trademark register**

To facilitate electronic communication, the requirements for records in the trademark register were eased. In general, it is sufficient to enclose copies of the document evidencing transfer of ownership, rights in rem or licences. Trademark transfers may be requested by submitting corresponding declarations made by the parties or their representatives, for which notarial confirmation of the signature is no longer necessary.

### **Possibility to divide a trademark application or registration**

Since 1 September 2017, national trademark applications or registrations may be divided into two or more separate applications or registrations which will bear the original application or priority date. A fee of EUR 200 has to be paid within two months upon filing. Divisions which affect goods and services subject to an opposition or cancellation proceeding may only be effected after termination of those proceedings. The division of Austrian designations of International Registrations is possible from 1 February 2019 and leads to a national fee of EUR 100 plus CHF 177 for the entry in the WIPO's register.

### **No subsequent extension of the list of goods and services**

To prevent technical and legal difficulties in an advancing harmonisation of national trademark systems, Austria eliminated its worldwide unique possibility to extend the protection of an existing trademark to additional goods and services.

### **Further amendments next year**

To entirely transpose the Trademark Directive 2015 in Austria (transposition due by January 2019), further amendments to the national law will be necessary next year.

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