



**SONN & PARTNER**  
SINCE 1851

## **Patent marking on products and in advertisements**

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Whether or not a product is marked as being patented does, in Austria, not affect the patent owner's rights. There is no legal requirement to mark a product with the patent or patent application number in order to prosecute a third party for infringement of the patent rights, to obtain a preliminary injunction to preliminarily hinder further infringement of the patent rights or to obtain damages for infringing activities.

On the other hand, there are legal requirements in case of such a marking of a product. According to sec. 165 Austrian Patents Act any person who designates objects in a manner suitable to give the impression that they enjoy patent protection shall, upon request, give information on what protective right such designation is based on.

If a product is marked with a patent number (and stating the respective country!) or simply by using "patent", "patent protection" or "protected by a patent" a valid patent being in force on this product in or for Austria or important industrial countries must exist. As far as the marking relates only to a patent application a product will only be allowed to be marked with the patent application number or by the words "patent application", if the application has been published and is therefore able to be verified by file inspection.

In this connection it should be noted, that according to the old law in Austria, for Austrian patent applications to which the decision to publish the application has not been issued, which applications are therefore not published, no marking is allowed with the Austrian patent application number or with „patent application pending“. Such patent applications will, however, be published shortly after the 1st of July, 2005.

With respect to „younger“ Austrian patent applications – after the new respective provisions of the Austrian Patents Act come into force (July 1, 2005) – the product could be provided with the marking „patent application“ after publication of the patent application; that is soon after 18 month from the application (priority) date.

The same applies to products to which an European or International Patent Application has been filed; such products may therefore be marked with the publication number or the term "European Patent application filed" or „International Patent application pending“ as soon as the application is in fact published, e.g. normally also 18 months after the date of filing or the priority date.

According to the old case law the date of publication was the decisive date because then the examination on patentability by the Austrian Patent Office was completed, which was regarded as being a certain guarantee for the consumer for the presence of an innovation in a patent-related product. With the changes of the Patents Act coming into force on the 1st of July, 2005, the decision of issuance of publication falls away and with it the „quasi declaration of a guarantee“. The stages are now: filing – publication – grant – opposition, if any.

Since the supposition that the Austrian Patent Office would give a sort of guarantee on the patentability is not really justified, because neither opposition nor the later declaration on invalidity are considered, and, moreover, it seems to be doubtful, that the circles in commerce addressed by the advertisement do see an official „declaration of guarantee“ in the indication „patented“, it's time, after this modernisation in the patent procedure, to acknowledge the real content of declaration of such a patent marking. It exists, namely, in the claim of the applicant and the patent holder against any person that there is a protectable invention, the same as in respect to a copyright marking or in respect to unexamined utility models or designs, which claim in all of these cases is combined with certain rights. Whether the claim on such a protection is justified will be solved in later proceedings on a dispute or already within the substantial examination procedure to a patent application. Because a different treatment of a marking in relation to an unexamined copyright, utility model or design and of a marking in relation to a patent application is not justified by the understanding of the consumer, a true marking also as a patent application must be admissible. The content of a copyright claim can directly be seen, those of a patent may not be directly seen. In order to guarantee the persons interested a possible information, the accessibility by publication should be provided. With this, a patent marking prior publication would, further on, remain inadmissible. With utility models and designs this accessibility is present upon registration, so that from that time onwards a respective marking is permissible.

The benefits of marking a product in such a way are primarily their function as advertisement. Such advertising will be examined with respect to possible misleading of the consumers according to §2 UWG (Law against Unfair Competition), e.g. also the most unfavourable interpretation of the advertisement must give the consumer a correct information. For example, the marking with "world patent" where only an international patent application in a few countries exists was forbidden (ÖBl. 1992, 126). In a younger decision of 12. September 2001 (4Ob183/01t) the Austrian Supreme Court forbid the marking of "European wide patent protection" since this is not equivalent to a European Patent, and for the term "European wide" a European patent for the states Germany, Austria, Liechtenstein, Spain and Italy is too little since the most important other industrial states are left out.

Another decision of the Austrian Supreme Court of 4 February 1999 (ÖBl. 1999, 186) concerning the marking of patented products considers the expectations of the customers in the common market. According to this decision it is sufficient to hold a valid patent in a member state of the European Union in order to be able to mark a patented product by "Pat and Pat Pend" and selling this marked product in Austria, even if there does not exist a valid patent in Austria. In the reasoning of this decision it is, however, mentioned that no valid Austrian patent is necessary, because in that specific case valid patents in

Great Britain, Germany and France existed; since these countries are big, technically leading countries it does not make any difference to the consumer if a valid patent in Austria exists or does not exist.

Because advertisements must basically be true, also the content of the patent/the patent application is to be regarded. The above mentioned general marking is, of course, only true, if the entire product or its for the consumer relevant parts is/are under patent protection. If there are merely individual parts patented, the marking is to be precised, such as „with patented electric drive“. There are products, such as cars or phones, which are as a whole not patentable any more. In these cases, a clarification is to be done, so that the advertisement with the patent protection remains true.