L.N. 283 of 2000

TRADEMARKS ACT, 2000
(ACT NO. XVI OF 2000)

Trademarks (Provisions and Fees) Rules, 2000

IN exercise of the powers vested in him by articles 65 and 66 of the Trademarks Act, 2000, the Minister for Economic Services has made the following rules:-

1. (1) The title of these rules is the Trademarks (Provisions and Fees) Rules, 2000. Title and commencement.

(2) These rules shall come into force on the 1st January, 2001.

2. (1) In these rules, "the Act" means the Trademarks Act, 2000, and the words and expressions used shall have the same meaning as is given to them in the Act, and "Office" shall be construed as the Office of the Comptroller. Interpretation.

(2) References to any article in the marginal notes to these rules shall be deemed as references to any article, or subarticle or paragraph thereof, of the Act and include any power to make rules by virtue also of the same article.

3. The fees to be paid in respect of any application, registration or any other matter under the Act and these rules shall be those prescribed in the Schedule of Fees to these rules. Provision relating to fees.

4. The Comptroller may request the submission of documentary evidence before undertaking any act required of him by law. Supporting documents.

5. (1) The applicant or his attorney shall be informed of any disclaimer or limitation by the Comptroller. Registration subject to disclaimer or limitation. Art. 13 (2) and (3).

(2) If the applicant or his attorney is not in agreement with the disclaimer or limitations, or part of the disclaimer or limitation, he shall inform the Comptroller accordingly and state his reasons for his disagreement. If the applicant or his attorney does not submit grounds for disagreement within 60 working days from the date of the notification of the disclaimer or limitation, the disclaimer or limitation will be considered as accepted by the applicant, and the Comptroller shall proceed to issue the registration of the mark with the disclaimer or limitation.

(3) In the case of disagreement, the Comptroller shall reconsider the limitation or disclaimer on the basis of the grounds of disagreement laid down by the applicant or his attorney; and in this regard he may -

(a) waive the limitation or disclaimer; or

(b) alter the disclaimer of limitation as he sees fit; or

(c) insist on the disclaimer or limitation.

(4) The Comptroller shall communicate his decision in writing to the applicant or his attorney.

(5) If within 20 working days from the date of the communication of the Comptroller's decision, the Comptroller does not receive an indication in writing from the applicant or his attorney showing his disagreement with the Comptroller's decision, the disclaimer or limitation shall be taken as accepted and shall be entered into the register against the mark to which the disclaimer or limitation refers.

(6) If within 20 working days from the date of the communication of the Comptroller's decision, the applicant or his attorney submits in writing his disagreement with the disclaimer or limitation, the Comptroller may refuse the application. The Comptroller's decision shall be final and may only be appealed as provided in article 64 of the Act.

Application to register transaction. Art. 24 (2).

6. (1) An application to register particulars of a transaction to which article 24 of the Act applies shall be made –

(a) relating to an assignment or a transfer by testamentary disposition, on the prescribed form;

(b) relating to a grant of a licence, on the prescribed form;

(c) relating to an amendment to, or termination of a licence, on the prescribed form.

(2) An application under subrule (1) above shall –

(a) where the transaction is an assignment, be signed by or on behalf of the parties to the assignment;

(b) where the transaction falls within sub-paragraphs (b) or (c) of subrule (1) above, be signed by or on behalf of the grantor of the licence,

or be accompanied by such documentary evidence as suffices to establish the transaction.

Application for registration. Art. 30.

7. An application for the registration of a trademark shall be filed in the Maltese or English language on the prescribed form and shall contain the following:

(a) a request for registration of a trademark;

(b) the name and address of the applicant;

(c) a statement of the goods or services in relation to which it is sought to register the trademark;

(d) a representation of the mark;

(e) the name and address of the representative or attorney, in cases where one has been appointed;

(f) a declaration claiming priority in cases where the applicant wishes to take advantage of an earlier application;

(g) an indication that the trademark is being used by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be used;

(h) a statement containing the name or names of the colour or colours being claimed in cases where the applicant wishes to claim colour as a distinctive feature of the mark; and

(i) the prescribed fee.

Date of filing. Art. 31.

8. (1) The date of filing of the application for the registration of a trademark shall be the date when all of the following elements are submitted:

(a) a request for registration of a trademark;

(b) the name and address of the applicant;

(c) a statement of the goods or services in relation to which it is sought to register the trademark;

(d) a clear representation of the mark; and

(e) the name and address of the representative or attorney, in cases where one has been appointed.

(2) If any of the above elements are omitted the application will not be accepted by the Comptroller and shall be returned to the applicant or his attorney.

(3) The other elements necessary for application included in rule 7 must be submitted within 90 working days from the date of filing. If any of these elements are not submitted within the stipulated time, the application shall be considered as withdrawn by the applicant or his attorney.

Classification of goods and services. Art. 32.

9. The classification of goods and services is according to the International Classification of Goods and Services for the purpose of the registration of marks under the Nice Agreement administered by the World Intellectual Property Organization (WIPO).

Claim to priority. Art. 33 (5).

10. Where a right to priority is claimed by reason of an application for the protection of a trademark duly filed in a World Trade Organization (WTO) or Convention country, other than Malta, under article 33 of the Act, particulars should include the country and the date of filing of the first application made in the WTO or Convention country.

Representations and amendments to the application specified by the Comptroller. Art. 35 (2).

11. The representations or the amendments to the application as requested by the Comptroller are to be submitted to the Office of the Comptroller within 90 working days from the Comptroller's request. If the representations or the amendments are not received by the Comptroller's Office within the specified time, the application would be refused.

Withdrawal and amendment of application. Art. 36.

12. A request for a withdrawal or an amendment of an application as specified in subarticles (1) and (2) of article 36 of the Act shall be made on the prescribed form.

Publication of registration. Art. 37 (4).

13. Once the application has been accepted for registration, the certificate of registration shall be issued and such registration shall be published in the Gazette or any other official publication that the Comptroller shall prescribe.

Renewal of registration. Art. 39 (1).

14. Renewal of registration shall be effected by filing a request for renewal on the prescribed form at any time within the period of six months ending on the date of the expiration of the registration.

Reminder of renewal of registration. Art. 39(2).

15. At any time not earlier than six months nor later than one month before the expiration of the last registration of a trademark, the Comptroller shall, except where renewal has already been effected under rule 14 above, send to the registered proprietor notice of the approaching expiration and inform him at the same time that the registration may be renewed in the manner prescribed in rule 14 above.

16. (1) If on the expiration of the last registration of a trademark, the renewal fee has not been paid and the request for renewal has not been made, the proprietor may renew the mark within six months from the date of expiration of the last registration provided that the request for renewal is filed on the prescribed form and is accompanied by the renewal fee and the additional renewal fee.

Delayed renewal and removal of registration. Art. 39(3).

(2) If on the expiration of the last registration of a trademark, the renewal fee has not been paid and the request for renewal has not been made and no action, as prescribed in subrule (1) above, has been taken by the proprietor, the Comptroller shall record the trademark as removed from the register.

17. Where the Comptroller has removed the mark from the register for failure to renew its registration in accordance with rule 16 above, he may, upon a request filed on the prescribed form within six months of the date of the removal of the mark and accompanied by the appropriate renewal fee and appropriate restoration fee, restore the mark to the register and renew its registration if, having regard to the circumstances of the failure to renew, he is satisfied that it is just to restore such mark.

Restoration of registration. Art. 39 (6).

18. The renewal and restoration of the registration shall be published in the Gazette or in any official publication the Comptroller may prescribe. The publication shall show the date of renewal or restoration.

Publication of renewal and restoration. Art. 39 (7).

19. The proprietor of a mark may submit a request for the alteration of his registered trademark on the prescribed form where the mark includes the proprietor's name and address. If the request is accepted by the Comptroller, the mark shall be altered accordingly and such alteration shall be published in the Gazette in any other official publication as prescribed by the Comptroller.

Alteration of a registered trademark. Art. 40 (2) and (3).

20. (1) An objection to the alteration may be entered at the Office of the Comptroller on the prescribed form, within 90 days from the date of publication of the alteration. The form shall be accompanied by a statement containing the grounds for objection. The Comptroller shall send a copy of the notice and the statement to the applicant

Objection to the alteration of a registered trademark. Art. 40 (3).

(2) Within 90 days from the date on which a copy of the statement is sent by the Comptroller to the trademark owner, the owner may file, in conjunction with notice of the same on the prescribed form, a counter-statement. If no counter-statement is filed within the stipulated time period, the objection to the alteration of the mark shall be considered as valid and the alteration shall not be allowed.

(3) If a counter-statement is filed in accordance with subrule (2) above, the Comptroller shall decide whether there are grounds for objection or otherwise. The Comptroller shall communicate his decision to the parties concerned and the party against whom the decision is taken may enter an appeal to the Court of Appeal in accordance with article 64 of the Act within 90 days from the receipt of the Comptroller's decision.

Surrender of a registered trademark. Art. 41 (2)

21. (1) The proprietor may surrender a registered trademark, by sending notice to the Comptroller on the prescribed form:

(a) in respect of all the goods or services for which it is registered; or

(b) in respect only of those goods or services specified by him in the notice.

(2) A notice under subrule (1) above shall be of no effect unless the proprietor in that notice:

(a) gives the name and address of any person having a contractual interest in the mark, or any other interest under the Act; and

(b) certifies that any such person –

(i) has been sent not less than 90 days' notice of the proprietor's intention to surrender the mark, or

(ii) is not affected, or if affected consents thereto.

(3) The Comptroller shall, upon the surrender taking effect, make the appropriate entry in the register and publish the same.

(4) Any person having a right in the registered mark, may appeal from the decision of the Comptroller's acceptance of the surrender before the Court of Appeal, composed in the manner provided in 4 (6) of the Code of Organization and Civil Procedure, within three years from the publication of the surrender.

Public inspection of state emblems, official signs or hallmarks. Art. 53 (4).

22. The register containing a list of the state emblems and official signs or hallmarks, and the emblems, abbreviations and names of international organisations, protected under article 6*ter* of the Paris Convention shall be available for public inspection at the prescribed fee. Copies of any part or parts of the register may be ordered, at an additional prescribed fee.

23. The register required to be maintained by the Comptroller under article 55 (a) of the Act may be kept in any form, including any digitized format, as deemed fit by the Comptroller.

Form of register. Art. 55 (a).

24. There shall be entered into the register in respect of each trademark registered therein the following particulars -

Entry into the register of particulars of registered trademarks. Art. 55(2).

(a) the date of registration as determined in accordance with articles 31(1) and 37(3), (that is to say, the date when all prescribed elements, necessary to obtain a filing date, are furnished to the Comptroller);

(b) the priority date (if any) to be accorded pursuant to a claim to a right to priority made under article 33 or 34;

(c) the name and address of the proprietor;

(d) any disclaimer or limitation of rights under article 13(1)(a) or (b) and 13(2) of the Act;

(e) the goods or services in respect of which the mark is registered;

(f) where the mark is a collective or certification mark, that fact; and

(g) where the mark is registered pursuant to article 6(5) of the Act with the consent of the proprietor of an earlier trademark or other earlier right, that fact.

25. Upon application made to the Comptroller by the persons specified in article 24 (1) of the Act, there shall be entered in the register the following particulars of registrable transactions, that is to say:

Entry in register of particulars of registrable transactions. Art. 55 (2)(a).

(a) in the case of an assignment of a registered trademark or any right in it –

(i) the name and address of the assignee,

(ii) the date of the assignment, and

(iii) where the assignment is in respect of any right in the mark, a description of the right assigned;

(b) in the case of the grant of a licence under a registered trademark –

(i) the name and address of the licensee,

(ii) where the licence is an exclusive licence, that fact,

(iii) where the licence is limited, a description of the limitation, and

(iv) the duration of the licence if the same is or is ascertainable as a definite period;

(c) in the case of a court or other competent authority transferring a registered trademark or any right in or under it ó

(i) the name and address of the transferee,

(ii) the date of the order, and

(iii) where the transfer is in respect of a right in the mark, a description of the right transferred;

and, in each case, there shall be entered the date on which the entry is made;

(d) in the case of a transfer of a registered trademark by testamentary disposition -

(i) the name and address of the person or persons in whose favour the testamentary disposition in made;

(ii) the date of the testamentary disposition; and

(e) in the case of a merger, the requirements specified for the registration of an assignment shall also apply.

Public inspection of register. Art. 55 (3)(a).

26. (1) The register shall be open for public inspection at the Office during the hours as may be determined by the Office.

(2) A search in the register may be conducted in respect of a mark or marks, in one of the following manners:

(i) an interested person may call at the Office and conduct a search for a mark or marks at the prescribed fee. If the person or persons conducting the search request copies of any related record, extracts from the register or copies of the representation of the mark, whether certified or uncertified, these shall be provided at the prescribed fee;

(ii) an interested person may submit a request in writing to the Office for a search to be conducted in respect of a mark or marks in one or more classes of goods and services, at the prescribed fee. If the person or persons requesting the search require copies of any related record, extracts from the register or copies of the representation of the mark, whether certified or uncertified, these shall be provided at the prescribed fee.

Rectification or correction of the register. Art. 56(1).

27. The Comptroller shall, on a request made on the prescribed form by the proprietor of a registered trademark or a licensee or any other interested person having an interest in a registered trademark, enter a rectification of the registered mark, provided that this does not affect the validity of the registration of the trademark.

Request for change of name and address. Art. 56(4).

28. When the proprietor of a registered trademark or a licensee wishes to enter a change in his respective name or address as recorded in the register, he shall do so by submitting a request to the Comptroller on the prescribed form.

Removal of matter from register. Art. 56 (5).

29. (1) Where it appears to the Comptroller that any matter in the register has ceased to have effect, before removing it from the register :

(a) he may, where he considers it appropriate, publish his intention to remove that matter, and

(b) where any person appears to him to be affected by the removal, he shall send notice of his intention to that person.

(2) Within 90 days from the date on which his intention to remove the matter is published, or notice of his intention is sent, as the case may be -

(a) any person may file notice of opposition to the removal on the prescribed form; and

(b) the person to whom a notice is sent under paragraph (l)(b) above may file in writing his objections, if any, to the removal.

(3) If the Comptroller is satisfied after considering any objections or opposition to the removal that the matter has not ceased to have effect, he shall not remove it.

(4) Where there has been no response to the Comptroller's notice he may remove the matter.

(5) Where representations objecting to the removal of the entry have been made the Comptroller may, if he is of the view after considering the objections that the entry or any part thereof has ceased to have effect, remove it or, as appropriate, the part thereof.

Change of classification. Art. 57 (1) and (3).

30. (1) Subject to article 32(1) of the Act, the Comptroller may consequent upon an amendment of the International Classification of Goods and Services referred to in rule 9 above, make such amendments to entries on the register as he considers necessary for the purposes of reclassifying the specification of the registered trademark.

(2) Before making any amendment to the register under paragraph (1) above the Comptroller shall require the proprietor of the mark to submit his proposals for amendment of the register.

(3) The proprietor shall submit such proposals in writing within 90 working days from the date of the requirement issued by the Comptroller.

(4) If no proposals are received within the prescribed period specified, the Comptroller shall decide whether to cancel or refuse to renew the registration of the trademark as specified in article 57(3)(b) of the Act.

Opposition to proposals. Art. 57 (4).

31. (1) The Comptroller shall, as soon as practicable, publish the proposals in the Gazette or in any other official publication.

(2) Notice of any opposition shall be filed on the prescribed form within 90 days from the date of publication of the proposals under paragraph (1) above and there shall be stated in the notice the grounds of opposition and, in particular, how the proposed amendments would be contrary to article 57(2) of the Act.

(3) If a notice of opposition under paragraph (2) above is filed within the prescribed period and the Comptroller accepts the opposition, the proposed amendments shall not be entered into the register.

(4) If no notice of opposition under paragraph (2) above is filed within the prescribed period, or where any opposition has been rejected, the Comptroller shall make the amendments as proposed and shall enter in the register the date when they were made.

(5) The Comptroller's decision shall be final and is not subject to appeal before the Court of Appeal.

32. (1) The Comptroller may require particular forms to be used for the purpose of registration of a trademark or any other proceedings before him under the Act pursuant to article 58 and he may specify any directions with respect to their use.

Forms and directions of the Comptroller. Art. 58.

(2) A requirement under this rule to use a form is satisfied by the use either of a replica of that form or of a form which is acceptable to the Comptroller and contains the information required by the form and complies with any directions as to the use of such a form.

(3) The Comptroller may, at his discretion, permit as an alternative to the sending by post or delivery of the application, notice or other document in legible form the filing of the application, notice or other document by electronic means subject to such terms or conditions as he may specify whether generally by published notice or in any particular case by written notice to the person being requested to file any such documents by such means.

33. A request for information relating to a registered trademark or an application for a trademark shall be made on the prescribed form and is subject or rule 34 below.

Request for information before and after publication. Art. 59.

34. (1) Subject to paragraphs (2) and (3) below, the Comptroller shall permit all documents filed or kept at the Office in relation to a registered mark to be inspected.

Inspection of documents. Art. 59 and 64.

(2) The Comptroller shall not be obliged to permit the inspection of any such document as is mentioned in paragraph (1) above until he has completed any procedure, or the stage in the procedure which is relevant to the document in question, which he is required or permitted to carry out under the Act or these rules.

(3) The right of inspection under paragraph (1) above does not apply to –

(a) any document until fourteen days after it has been filed at the Office;

(b) any document prepared in the Office solely for use therein;

(c) any document sent to the Office, whether at its request or otherwise, for inspection and subsequent return to the sender;

(d) any request for information under rule 33 above;

(e) any document issued or received by the Office which the Comptroller considers should be treated as confidential;

(f) any document in respect of which the Comptroller issues directions under rule 35 below that it be treated as confidential.

(4) Nothing in paragraph (1) shall be construed as imposing on the Comptroller any duty of making available for public inspection –

(a) any document or part of a document which in his opinion disparages any person in a way likely to damage him; or

(b) any document filed with or sent to the Office before the enactment of the Act.

(5) No appeal shall lie from a decision of the Comptroller under paragraph (4) above not to make any document or part of a document available for public inspection.

Confidential documents.

35. (1) Where a document other than a form required by the Comptroller in accordance with rule 33 above is filed at the Office and the person filing it requests, at the time of filing or within fourteen days of the filing, that it or a specified part of it be treated as confidential, giving his reasons, the Comptroller may direct that it or part of it, as the case may be, be treated as confidential, and the document shall not be open to public inspection while the matter is being determined by the Comptroller.

(2) Where such direction has been given and not withdrawn, nothing in this rule shall be taken to authorise or require any person to be allowed to inspect the document or part of it to which the direction relates except by leave of the Comptroller.

(3) The Comptroller shall not withdraw any direction given under this rule without prior consultation with the person at whose request the direction was given, unless the Comptroller is satisfied that such prior consultation is not reasonably practical.

(4) The Comptroller may, where he considers that any document issued by the Office should be treated as confidential, so direct, and upon such direction that document shall not be open to public inspection except by leave of the Comptroller.

(5) Where a direction is given under this rule for a document to be treated as confidential, a record of the fact shall be filed with the document.

36. The fees to be paid in respect of any application, registration or any other matter under the Act and these rules shall be those (if any) prescribed in the Schedule of Fees. The Comptroller shall decide the circumstances in which a fee may be repaid or remitted on a case by case basis.

Requirement as to fees. Art. 66.

37. The hours and days of business shall be those as determined by the Office.

Hours of business and business days. Art. 67.

38. (1) Where an agent has been authorised under article 68, the Comptroller may in any particular case require the personal signature or presence of the agent or the person authorising him to act as agent.

Proof of authorisation of agent may be required. Art. 68.

(2) The Comptroller may by notice in writing sent to an agent require him to produce evidence of his authority.

39. A claim to have the registrability of a mark applied for under the Industrial Property (Protection) Ordinance determined under the Act must be made on the prescribed form. The new filing date of the converted application will be the commencement date of the new Act.

Conversion of pending applications. Art. 99. Cap. 29.

Collective and Certification marks

40. All the above rules shall apply to collective and certification marks in so far as these are applicable.

General.

41. Where the collective or certification mark is used to indicate a geographical origin there must be submitted before the Comptroller evidence that this mark is in fact being used to identify the good or goods as originating in the territory or in a region or locality in that territory and that a given quality, reputation or other characteristic of the good or goods is essentially attributable to its geographical origin.

Indication of geographical origin. Schedule 1 and Schedule 2 pararaph 3.

42. Within nine months of the date of the application for the registration of a collective or certification mark, the applicant shall file the prescribed form accompanied by a copy of the regulations governing the use of the mark and the prescribed fee where applicable.

Filing of regulations for collective and certification marks. Schedule 1 paragraph 6 (2) and Schedule 2 paragraph 7 (2).

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SCHEDULE OF FEES
(On Instruments for the Registration of Trademarks)

Rule 3.

	Lm
1. On application to register a trademark, for one or more articles/ services included in one class of goods or services, on account of which the registration of the mark is sought	50.00
2. On application to register an assignment of a registered trademark or any right in it, or to register a merger, for the first mark	25.00
3. For every additional mark or right thereof being assigned or merged at the same time	5.00
4. On application for continuance of right to the exclusive use of a mark at expiration of 10 years	40.00
5. Additional fee where fee is paid within six months after expiration of 10 years	15.00
6. Additional fee for restoration of trademark where removed for non-payment of fee	30.00
7. Request for withdrawal of application	5.00
8. Request for amendment of application so as to correct:	
(a) the name and address of the applicant	5.00
(b) errors of wording or copying	5.00
(c) obvious mistakes	5.00
9. Request for alteration of the proprietor's name and address where this forms part of the registered mark	5.00
10. Objection to the alteration of a registered trademark where the alteration consists of the proprietors name and address when this forms part of the registered trademark	30.00
11. Request for the recordal of surrender of a registered trademark	40.00
12. On application to register the grant of an exclusive or a limited licence under a registered trademark	25.00

	Lm
13. On application to register the transfer of a registered trademark or any right in it, as ordered by a court or other competent authority; or by testamentary disposition	25.00
14. Request in writing:	
(a) for a search of a mark for each class of goods or services	5.00
(b) for the same mark to be searched in other classes of goods or services (per class)	5.00
(c) for a copy of a related record, extract from the register or representation of the mark, when these are requested as part of the request for a search in writing	
i. uncertified	0.50 (each)
ii. certified	1.00 (each)
15. For search or for inspecting register by interested person, for every quarter of an hour	5.00
– for copy of a related record, extract from the register or representation of the mark, when these are requested as part of the request for a search in writing	
i. uncertified	0.50 (each)
ii. certified	1.00 (each)
16. Request for information and inspection of documents	5.00
17. On a request to rectify or correct the register, including a change of name or address of the proprietor or a licensee	5.00
18. Opposition to the removal by the Comptroller of any matter in the register	15.00
19. Opposition to proposals for amendment to entries on the register for the reclassifying of the specification of goods or services	15.00
20. Application to convert pending application to be determined under the new Act	15.00