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L.N 343 of 2018

TRADEMARKS ACT
(CAP. 416)

Trademark Search and Opposition Rules, 2018

IN EXERCISE of the powers conferred by articles 8 and 65 of the Trademarks Act, the Minister for the Economy, Investment and Small Businesses has made the following rules:-

Citation.

1. The title of these rules is the Trademark Search and Opposition Rules, 2018.

Purpose.

2. These rules specify:

(a) the details of the procedure governing a relative search examination carried out by the Office.

(b) the details of the procedure for filing and examining an opposition to the registration of a trademark at the Office.

Interpretation.

3. In these rules -

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"the Act" means the Trademarks Act, and the words and expressions used shall have the same meaning as is given to them in the Act;

"the Office" means the national Maltese entity officially designated with the responsibility to register trademarks in Malta.

Relative search.

4. (1) Pursuant to article 35(1) of the Act, the Office shall carry out a search under the national trademark database for each application received in order to identify identical or similar registrations or applications.

(2) The results of the search shall be notified to the applicant.

(3) If the applicant wishes to withdraw the application, a request for withdrawal shall be submitted to the Office, together with the prescribed withdrawal fee within twenty (20) working days from receipt of the notification.

(4) If the applicant does not submit his request to withdraw the application within the specified time period, the office shall notify the earlier right holder of the results of the search and proceed with the

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publication of the application accordingly.

(5) An opposition to such an application may be submitted in terms of these rules.

Publication.

5. (1) If it appears to the Comptroller that the requirements for registration are met, the Comptroller shall publish the application on the official online Intellectual Property journal or any other official publication that the Comptroller shall prescribe.

(2) The publication shall be updated with new applications on a monthly basis.

(3) In accordance with article 37(4) of the Act, the Comptroller shall also publish the registration of a trademark on the official online Intellectual Property journal or any other official publication that the Comptroller shall prescribe.

Notice of opposition.

6. (1) A notice of opposition may be entered on the basis of one or more earlier marks or other rights within the meaning of article 6 of the Act, provided that the proprietors or authorised persons entering the notice are entitled to do so for all the earlier marks or rights referred to. Where an earlier mark has more than one proprietor or where an earlier right may be exercised by more than one person, an opposition may be filed by any or all of the proprietors or authorised persons.

(2) The notice of opposition shall contain:

(a) the file number of the application against which opposition is entered and the name of the applicant for the trademark;

(b) a clear identification of the earlier mark or right on which the opposition is based, namely:

(i) where the opposition is based on the grounds provided in article 6(1) and, or (2) and, or (3) of the Act, the file number or registration number of the earlier mark, an indication of whether the earlier mark is registered or an application for registration of that mark;

(ii) where the opposition is based on the grounds provided in article 6(4) of the Act, a representation of the mark;

(iii) where the opposition is based on an earlier designation of origin or geographical indication, an

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indication of its nature, a representation of the earlier designation of origin or geographical indication, and an indication of whether it is protected under Union legislation or the Laws of Malta;

(c) a statement outlining the grounds on which the opposition is based under article 6 of the Act in respect of each of the earlier marks or rights invoked by the opposing party;

(d) in the case of an earlier trademark application or registration, the filing date and, where available, the registration date and the priority date of the earlier mark;

(e) in the case of an earlier trademark application or registration, a representation of the earlier mark as registered or applied for; if the earlier mark is in colour, the representation shall be in colour;

(f) an indication of the goods or services on which each of the grounds of the opposition is based;

(g) as concerns the opposing party, the identification of the opposing party as follows:

(i) the name and address and the State in which the opposing party is domiciled or has a seat or an establishment. Names of natural persons shall be indicated by the person's family name(s) and given name(s). Names of legal entities, as well as bodies including institutions and authorities as governed by public law, shall be indicated by their official designation and include the legal form of the entity, which may be abbreviated in a customary manner. The company's national identification number may also be specified if available. The Office may require the opposing party to provide telephone numbers or other contact details for communication by electronic means;

(ii) where the opposing party has appointed a representative, the name and business address of the representative;

(iii) where the opposition is entered by a licensee or by a person who is entitled under the relevant Union legislation or national law to exercise an earlier right, a statement to that effect and indications concerning the authorisation or the entitlement to file the opposition;

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(iv) an indication of the goods or services against which the opposition is directed; in the absence of such an indication, the opposition shall be considered to be directed against all of the goods or services of the opposed trademark application.

(3) Where the opposition is based on more than one earlier mark or earlier right, sub-rule (2) shall apply for each of those marks, signs, designations of origin or geographical indications.

(4) The notice of opposition should also contain a reasoned statement on the grounds, the facts and arguments on which the opposition relies, and supporting evidence.

(5) The notice of opposition shall, unless otherwise demanded by the Office, be submitted in duplicate and shall be accompanied by the prescribed opposition fee.

(6) The notice of opposition and any document submitted by the opposing party, shall be sent by the Office to the applicant for purposes of informing of the introduction of an opposition.

Opposition period.

7. Within a period of sixty (60) working days following the publication of a trademark application, notice of opposition to registration of the trademark may be given on the grounds that it may not be registered under article 6 of the Act.

Admissibility of the opposition.

8. (1) Where the opposition fee has not been paid within the opposition period laid down in rule 7, the opposition shall be deemed not to have been entered. Where the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.

(2) Where the notice of opposition has been filed after the expiry of the opposition period, the Office shall reject the opposition.

(3) Where the notice of opposition does not comply with the provisions of rule 6(2)(d) to (g), the Office shall inform the opposing party accordingly and shall invite it to remedy the deficiencies noted within a period of ten (10) working days from the date of notification by the Office. If the deficiencies are not remedied before the time limit expires, the Office shall reject the opposition.

(4) The Office shall notify the opposing party of any finding pursuant to sub-rule (1) that the notice of opposition is deemed not to have been entered and of any decision to reject the opposition on the grounds of inadmissibility under sub-rule (2) or (3):

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Provided that the Office shall also inform the opposing party where following action taken pursuant to sub-rule (3), the opposition is deemed admissible.

Opposition proceedings.

9. (1) Where the opposition is found admissible pursuant to rule 8, the Office shall notify the applicant the applicant, that within a period of sixty (60) working days from the date of notification, the applicant may:

(i) withdraw the application; or

(ii) restrict the goods and services covered by the application; or

(iii) submit a counterstatement outlining grounds against the opposition.

(2) Where, within the period referred to in sub-rule (1), the application is withdrawn, the opposition proceedings shall be closed.

(3) Where, within the period referred to in sub-rule (1), the applicant restricts the application by deleting some of the goods or services against which the opposition is directed, the Office shall invite the opposing party to state, within ten (10) working days of the date from said invitation, whether it maintains the opposition, and if so, against which of the remaining goods or services the opposition is being maintained. Where the opposing party withdraws the opposition in light of the restriction, the opposition proceedings shall be closed.

(4) (i) Where a counterstatement is submitted, the Office shall notify the opposing party of the counterstatement and also send a copy of the counterstatement to the opposing party. Within twenty (20) working days of the date of notification of the counterstatement, the opposing party shall inform the Office in writing, whether it is withdrawing or maintaining the opposition.

(ii) In the case where the opposing party informs the Office that the opposition is being maintained, it shall, at the same time, submit the prescribed fee and any additional documentation outlining the grounds on which opposition is being maintained.

(iii) In the case where the opposing party does not inform the Office, within the period stipulated in sub-rule (4) above, whether it is withdrawing or maintaining the opposition, the Office shall consider the opposition as withdrawn and proceed with the registration of the trademark.

(5) The Office shall reject the application if, within the period

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referred to in sub-rule (1), the applicant does not:

(i) withdraw the application; or

(ii) restrict the goods and services covered by the application; or

(iii) submit a counterstatement outlining grounds against the opposition.

(6) The parties shall be granted, at their joint request, a period of up to ninety (90) working days from the date of the notification by the Office of the opposition to the applicant in order to allow for the possibility of a friendly settlement between the opposing party and the applicant:

Provided that such request shall not be made after the expiry of the period of the sixty (60) working days from the date of notification by the Office, of the opposition to the applicant as referred to in sub-rule (1).

(7) Where, within the period referred to in sub-rule (1), the Office is informed that the application is rejected in parallel proceedings, the opposition proceedings shall be closed.

Decision by the Office.

10. (1) Where the opposition is maintained, pursuant to rule 9(4)(ii), the Office, shall proceed to take a decision based on the information and evidence provided by the opposing party and the applicant.

(2) The decision shall be communicated to the applicant and to the opposing party.

(3) A notice of appeal to the decision of the Office can be filed according to the provisions of article 64 of the Act.

Schedule of Fees

Notice of opposition [rule 6(5)]	€50
Notice of maintaining opposition [rule 9(4)(ii)]	€150

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