I assent.

(L.S.) **GEORGE VELLA**
President

9th April, 2019

ACT No. XII of 2019

AN ACT to repeal and replace the Trademarks Act, Cap. 416.

BE IT ENACTED by the President, by and with the advice and consent of the House of Representatives, in this present Parliament assembled, and by the authority of the same, as follows:-

1. (1) The short title of this Act is the Trademarks Act, 2019. Short title and commencement.

(2) This Act shall come into force on such date as the Minister responsible for Intellectual Property may by notice in the Gazette

establish, and different dates may be so established for different purposes and for different provisions of this Act.

PART I – GENERAL PROVISIONS

Scope, purpose and data protection.

2. (1) This Act applies to every trademark in respect of goods or services which is the subject of registration or of an application for registration in Malta as an individual trademark, a certification mark or a collective mark or of an international registration having effect in Malta.

(2) This Act transposes the provisions of Directive (EU) 2015/ 2436 of 16 December 2015 to approximate the laws of the Member States relating to trademarks (Recast).

(3) The processing of any personal data carried out in Malta in the framework of this Act shall be subject to Regulation 2016/679 (EU) and the Data Protection Act.

Cap. 586.

Definitions.

3. (1) For the purpose of this Act, the following definitions apply:

"Comptroller" means the Comptroller of Industrial Property as established under article 3 of the Patents and Designs Act and includes any other person appointed to exercise all or any of the powers and perform all or any of the duties of the Comptroller;

Cap. 417.

"European Union" or "Union" means the European Union referred to in the Treaty;

"infringement proceedings" in relation to a registered trademark, includes proceedings under article 21;

"Member State" means a state which is a member of the European Union;

"the Minister" means the Minister responsible for the protection of Industrial Property;

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

"the Ordinance" shall mean the Industrial Property (Protection) Ordinance;

Cap. 29.

"Paris Convention" means the convention referred to in article 125;

"prescribed" means prescribed by this Act or by any regulations made thereunder;

"publish" means make available to the public, and references to publication in relation to registration, are to publication under article 56(4);

"register" means the register of trademarks kept by the Office;

"trade" includes any business or profession;

"the Treaty" has the same meaning assigned to it by article 2 of the European Union Act. Cap. 460.

(2) References in this Act to a trademark include, unless the context otherwise requires, reference to a certification mark or collective mark referred to respectively in article 61(a) and (b). References to trademark.

PART II - REGISTERED TRADEMARKS

4. (1) A registered trademark is a property right obtained by the registration of the trademark under this Act. The proprietor of a registered trademark has the rights and remedies provided by this Act. Property right.

(2) A trademark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of: Signs of which a trademark may consist.

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and

(b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

5. (1) The following shall not be registered as trademarks or, if registered, shall be liable to be declared invalid: Absolute grounds for refusal or invalidity.

(a) signs which cannot constitute a trademark;

(b) trademarks which are devoid of any distinctive character;

(c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin, the time of

production of goods or of rendering of the service, or other characteristics of the goods or services;

(d) trademarks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;

(e) signs which consist exclusively of -

(i) the shape, or another characteristic, which results from the nature of the goods themselves;

(ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;

(iii) the shape, or another characteristic, which gives substantial value to the goods;

(f) trademarks which are contrary to public policy or to accepted principles of morality;

(g) trademarks which are of such a nature as to deceive the public or likely to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or services;

(h) trademarks which have not been authorised by the competent authorities and are to be refused or invalidated pursuant to Article 6*ter* of the Paris Convention;

(i) trademarks which are excluded from registration pursuant to Union legislation or the laws of Malta, or to international agreements to which the Union or Malta is party, providing for protection of designations of origin and geographical indications;

(j) trademarks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine;

(k) trademarks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional specialities guaranteed;

(l) trademarks which consist of, or reproduce in their essential elements, an earlier plant variety denomination

registered in accordance with Union legislation or the laws of Malta, or international agreements to which the Union or Malta is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species.

(2) A trademark shall be liable to be declared invalid where the application for registration of the trademark was made in bad faith by the applicant.

(3) A trademark shall not be registered or, if registered, is liable to be declared invalid where and to the extent that:

(a) the use of that trademark may be prohibited pursuant to provisions of law other than trademark law of Malta or of the Union;

(b) the trademark includes a sign of high symbolic value, in particular a religious symbol;

(c) the trademark includes badges, emblems and escutcheons other than those covered by Article 6*ter* of the Paris Convention and which are of public interest, unless the consent of the competent authority to their registration has been given in conformity with the laws of Malta.

(4) A trademark which consists of or contains -

(a) the arms, or any of the principal armorial bearings of the arms appertaining to the President or the Roman Catholic Archbishop of Malta, or any insignia or device so nearly resembling such arms or any such armorial bearing as to be likely to be mistaken for them or it;

(b) a representation of the Presidential or Episcopal flags;

(c) a representation of the President or the Archbishop, or any colourable imitation thereof; or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Presidential or Episcopal patronage or authorization,

shall not be registered unless it appears to the Comptroller that consent has been given by or on behalf of the President or the Archbishop:

Provided that the Minister may by regulations extend the

applicability of the provisions of this sub-article to apply *mutatis mutandis* in respect of religions other than the Roman Catholic Apostolic Religion.

(5) A trademark which consists of a representation of the national flag of Malta shall not be registered.

(6) A trademark which contains a representation of the national flag of Malta shall not be registered if it appears to the Comptroller that the use of the trademark would be misleading or grossly offensive.

(7) A trademark shall not be registered in the cases specified in article 127 or article 128 except as provided in said articles.

(8) A trademark shall not be refused registration in accordance with sub-article (1)(b), (c) or (d) if, before the date of application for registration, it has acquired a distinctive character as a result of the use made of it in Malta. A trademark shall not be declared invalid for the same reasons if, before the date of action for a declaration of invalidity, following the use which has been made of it, it has acquired a distinctive character as a result of the use made of it in Malta.

Relative grounds for refusal or invalidity.

6. (1) A trademark shall not be registered or, if registered, shall be liable to be declared invalid where:

(a) it is identical with an earlier trademark, and the goods or services for which the trademark is applied for or is registered are identical with the goods or services for which the earlier trademark is protected;

(b) because of its identity with, or similarity to, an earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public, including the likelihood of association by the public with the earlier trademark.

(2) "Earlier trademarks" within the meaning of sub-article (1) means:

(a) trademarks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trademark, taking account, where appropriate, of the priorities claimed in respect of those trademarks:

(i) EU trademarks;

(ii) trademarks registered in Malta;

(iii) trademarks registered under international arrangements which have effect in Malta;

(b) EU trademarks which validly claim seniority, in accordance with Regulation (EU) 2017/1001, of a trademark referred to in sub-article (2)(a)(ii) and (iii), even when the latter trademark has been surrendered or allowed to lapse;

(c) applications for the trademarks referred to in sub-article (2)(a) and (b), subject to their registration;

(d) trademarks which, on the date of application for registration of the trademark or, where appropriate, of the priority claimed in respect of the application for registration of the trademark, are well known in Malta, in the sense in which the words "well-known" are used in Article 6*bis* of the Paris Convention.

(3) Furthermore, a trademark shall not be registered or, if registered, shall be liable to be declared invalid where:

(a) it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which the trademark is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is protected, where the earlier trademark has a reputation in Malta or, in the case of an EU trademark, has a reputation in the Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark;

(b) an agent or representative of the proprietor of the trademark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action;

(c) to the extent that, pursuant to Union legislation or the laws of Malta providing for protection of designations of origin and geographical indications:

(i) an application for a designation of origin or a geographical indication had already been submitted in accordance with Union legislation or the laws of Malta prior to the date of application for registration of the trademark or the date of the priority claimed for the application, subject to its subsequent registration;

(ii) that designation of origin or geographical indication confers on the person authorised under the relevant law to exercise the rights arising therefrom, the right to prohibit the use of a subsequent trademark.

(4) A trademark is not to be registered or, if registered, is liable to be declared invalid where, and to the extent that:

(a) rights to a non-registered trademark or to another sign used in the course of trade, were acquired prior to the date of application for registration of the subsequent trademark, or the date of the priority claimed for the application for registration of the subsequent trademark, and that non-registered trademark or other sign confers on its proprietor the right to prohibit the use of the subsequent trademark;

(b) the use of the trademark may be prohibited by virtue of an earlier right, other than the rights referred to in sub-articles (2) and (4)(a), and protected by means of:

(i) copyright;

(ii) registered designs;

(iii) other rights which the Minister may prescribe by regulation.

(5) A trademark shall not be refused registration or declared invalid where the proprietor of the earlier trademark or other earlier right consents to the registration of the later trademark.

Derogation in respect of trademarks regulated by the Ordinance.

7. The grounds for refusal of registration or invalidity in force in Malta prior to the date of the entry into force of the Trademarks Act, are to continue to apply in relation to trademarks for which an application was made prior to such entry into force and which remained regulated thereby.

Establishment *a posteriori* of invalidity or revocation of a trademark.

8. Where the seniority of a national trademark or of a trademark registered under international arrangements having effect in Malta, which has been surrendered or allowed to lapse, is claimed for an EU trademark, the invalidity or revocation of the trademark providing the basis for the seniority claim may be established *a posteriori*, provided that the invalidity or revocation could have been declared at the time the mark was surrendered or allowed to lapse. In such a case, the seniority shall cease to produce its effects.

9. Where grounds for refusal of registration or for invalidity of a trademark exist in respect of only some of the goods or services for which that trademark has been applied or registered, refusal of registration or invalidity shall cover those goods or services only.

Grounds for refusal or invalidity relating to only some of the goods or services.

10. An action for a declaration of invalidity on the basis of an earlier trademark shall not succeed at the date of the action for invalidation if it would not have been successful at the filing date or the priority date of the later trademark for any of the following reasons:

Lack of distinctive character or of reputation of an earlier trademark precluding a declaration of invalidity of a registered trademark.

(a) the earlier trademark liable to be declared invalid pursuant to article 5(1)(b), (c) or (d) had not yet acquired a distinctive character as referred to in article 5(8);

(b) the application for a declaration of invalidity is based on article 6(1)(b) and the earlier trademark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of article 6(1)(b);

(c) the application for a declaration of invalidity is based on article 6(3)(a) and the earlier trademark had not yet acquired a reputation within the meaning of article 6(3)(a).

11. (1) Where, in Malta, the proprietor of an earlier trademark, as referred to in article 6(2) or article 6(3)(a) has acquiesced for a period of five successive years, in the use of a later trademark registered in Malta, he shall no longer be entitled on the basis of the earlier trademark to apply for a declaration that the later trademark is invalid in respect of the goods or services for which the later trademark has been used, unless registration of the later trademark was applied for in bad faith.

Preclusion of a declaration of invalidity due to acquiescence.

(2) Sub-article (1) is to apply to the proprietor of any other earlier right referred to in article 6(4)(a) or (b).

(3) In the cases referred to in sub-articles (1) and (2), the proprietor of the later registered trademark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later trademark.

Rights conferred and limitations

12. (1) The registration of a trademark shall confer on the proprietor exclusive rights therein.

Rights conferred by a trademark.

(2) Any reference in this Act to the infringement of a registered trademark shall be deemed to be a reference to any such infringement

of the rights of the proprietor.

(3) The rights of the proprietor have effect from the date of registration reckoned in accordance with article 56(3):

Provided that -

(a) no infringement proceedings may be begun before the date on which the trademark is in fact registered; and

(b) no offence under article 109 shall be committed by anything done before the date of publication of the registration.

(4) Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trademark, the proprietor of that registered trademark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the trademark and is used in relation to goods or services which are identical with those for which it is registered;

(b) the sign is identical with, or similar to, the trademark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trademark is registered:

Provided that there exists a likelihood of confusion on the part of the public:

Provided further that the likelihood of confusion includes the likelihood of association between the sign and the trademark;

(c) the sign is identical with, or similar to, the trademark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trademark is registered, where the latter has a reputation in Malta and where use of that sign, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.

(5) The following, in particular, may be prohibited under sub-article (4):

(a) affixing the sign to the goods or the packaging thereof;

(b) offering the goods or putting them on the market, or stocking them for those purposes, under the sign, or offering or supplying services thereunder;

(c) importing or exporting the goods under the sign;

(d) using the sign as a trade or company name or part of a trade or company name;

(e) using the sign on business papers or in advertising;

(f) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC.

(6) A person who applies a registered trademark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trademark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(7) Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trademark, the proprietor of that registered trademark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into Malta, without being released for free circulation there, where such goods, including the packaging thereof, come from third countries and bear without authorisation a trademark which is identical with the trademark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trademark.

The entitlement of the trademark proprietor pursuant to the first sub-paragraph shall lapse if, during the proceedings to determine whether the registered trademark has been infringed, initiated in accordance with Regulation (EU) No. 608/2013, evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trademark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

(8) Where the use of a sign under the conditions referred to in paragraphs (b) and (c) of sub-article (4) could not be prohibited before the coming into force of the Trademarks Act, the rights conferred by the trademark cannot be relied on to prevent the continued use of the sign if such use had started prior to the said Act coming into force.

Cap. 416.
Cap. 29.

(9) Sub-articles (1), (4), (5) and (8) shall not affect provisions applicable under any law relating to the protection against the use of a

sign other than use for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of or is detrimental to, the distinctive character or the repute of the trademark.

The right to prohibit preparatory acts in relation to the use of packaging or other means.

13. Where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trademark is affixed, could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of a trademark under article 12(4) and (5), the proprietor of that trademark shall have the right to prohibit the following acts if carried out in the course of trade:

(a) affixing a sign identical with, or similar to, the trademark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed;

(b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.

Reproduction of trademarks in dictionaries.

14. If the reproduction of a trademark in a dictionary, encyclopaedia or similar reference work, in print or electronic form, gives the impression that it constitutes the generic name of the goods or services for which the trademark is registered, the publisher of the work shall, at the request of the proprietor of the trademark, ensure that the reproduction of the trademark is, without delay, and in the case of the work in printed form at the latest in the next edition of the publication, accompanied by an indication that it is a registered trademark.

Prohibition of the use of a trademark registered in the name of an agent or representative.

15. (1) Where a trademark is registered in the name of the agent or representative of a person who is the proprietor of that trademark, without the proprietor's consent, the latter shall be entitled to do either or both of the following:

(a) oppose the use of the trademark by his agent or representative;

(b) demand the assignment of the trademark in his favour.

(2) Sub-article (1) shall not apply where the agent or representative justifies his action.

Limits on effects of a registered trademark.

16. (1) A trademark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

(a) the name or address of the third party, where that third party is a natural person;

(b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the services, or other characteristics of goods or services;

(c) the trademark for the purpose of identifying or referring to goods or services as those of the proprietor of that trademark in particular where the use of the trademark is necessary to indicate the intended purpose of a product or service in particular as accessories or spare parts.

(2) Sub-article (1) shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

(3) (a) A trademark shall not entitle the proprietor to prohibit a third party from using, in the course of trade in Malta, an earlier right, if the right is recognised by law and if, or to the extent that, its use is protected by virtue of any rule of law.

(b) For the purposes of this sub-article an "earlier right" means an unregistered trademark or other sign continuously used in relation to goods or services by a person or his predecessor in title from a date prior to whichever is the earlier of -

(i) the use of the first-mentioned trademark in relation to those goods or services by the proprietor or his predecessor in title; or

(ii) the registration of the first-mentioned trademark in respect of those goods or services in the name of the proprietor or his predecessor in title.

Exhaustion of the rights conferred by a trademark.

17. (1) A trademark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Union under that trademark by the proprietor or with the proprietor's consent.

(2) Sub-article (1) shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, particularly where the condition of the goods is changed or

impaired after they have been put on the market.

Registration subject to disclaimer or limitation.

18. (1) An applicant for registration of a trademark, or the proprietor of a registered trademark, may -

(a) disclaim any right to the exclusive use of any specified element of the trademark; or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

(2) The Comptroller may disclaim any right to the exclusive use of any specified element of the trademark.

(3) The Minister may make rules providing for the publication and entry in the register of a disclaimer or limitation.

(4) Where the registration of a trademark is subject to a disclaimer or limitation, the rights conferred by article 12 shall be restricted accordingly.

Action for infringement.

19. (1) Subject to the provisions of articles 41 and 42, an infringement of a registered trademark is actionable by the proprietor of the trademark by sworn application to be filed in the First Hall of the Civil Court.

(2) In an action for infringement all such relief as is available in respect of the infringement of any other property right shall be available to the plaintiff.

Order for erasure, etc., of offending sign.

20. (1) Where a person is found to have infringed a registered trademark, the Court may make an order requiring him –

(a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or

(b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

(2) If an order under sub-article (1) is not complied with, or it appears likely to the Court that such an order would not be complied with, the Court may order that the infringing goods, material or articles be delivered to such person as the Court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

Order for delivery up of infringing goods, material or articles.

21. (1) The proprietor of a registered trademark may, by application, ask the First Hall of Civil Court for an order for the delivery up to him, or such other person as the Court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a business.

(2) An application shall not be made after the end of the period specified in article 23; and no order shall be made unless the Court also makes, or it appears to the Court that there are grounds for making, an order under article 24.

(3) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this article shall retain them pending the decision of the Court under article 24.

(4) Nothing in this article affects any other power of the Court.

Meaning of "infringing goods, material or articles".

22. (1) In this Act the expressions "infringing goods", "infringing material" and "infringing articles" shall be construed in accordance with the following sub-articles of this article.

(2) Goods are "infringing goods", in relation to a registered trademark, if they or their packaging bear a sign identical or similar to that mark and -

(a) the application of the sign to the goods or their packaging is an infringement of the registered trademark; or

(b) the goods are proposed to be imported into Malta and the application in Malta, of the sign, to them or their packaging would be an infringement of the registered trademark; or

(c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trademark.

(3) Material is "infringing material", in relation to a registered trademark, if it bears a sign identical or similar to that mark and -

(a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trademark; or

(b) it is intended to be so used and such use would infringe the registered trademark.

(4) "Infringing articles", in relation to a registered trademark, means articles -

(a) which are specifically designed or adapted for making copies of a sign identical or similar to that trademark; and

(b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been used or are to be used to produce infringing goods or material.

Period after which remedy of delivery up not available.

23. (1) An application for an order under article 24 may not be made after the end of the period of six years from -

(a) in the case of infringing goods, the date on which the trademark was applied to the goods or their packaging;

(b) in the case of infringing material, the date on which the trademark was applied to the material; or

(c) in the case of infringing articles, the date on which they were made,

except as provided in the following sub-article.

(2) If during the whole or part of that period the proprietor of the registered trademark is prevented by fraud or concealment from discovering the facts entitling him to apply for an order, an application may be made at any time before the end of the period of six years from the date on which he could with reasonable diligence have discovered those facts.

Order as to disposal of infringing goods, material or articles.

24. (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under article 21, an action by sworn application may be brought before the Court by any party interested -

(a) for an order that they be destroyed or forfeited in favour of such person as the Court may think fit; or

(b) for a decision that no such order should be made.

(2) In considering its decision, the Court shall consider whether other remedies available in an action for infringement of the registered trademark would be adequate to compensate the proprietor and any licensee to protect their interests.

(3) The Court shall order the service of the sworn application on persons having an interest in the goods, material or articles, and any person having an interest shall be entitled -

(a) to appear in proceedings for an order under this article, whether or not he was served with a notice; and

(b) to appeal against any order made, whether or not he appeared at first instance, and any such order shall not take effect until the end of the period within which an appeal may be filed or, if before the end of that period an appeal is so filed, until the final determination or abandonment of the proceedings on the appeal.

(4) Where there is more than one person interested in the goods, material or articles, the Court shall make such order as it thinks fit.

(5) If the Court decides that no order should have been made under article 21, the person in whose possession, custody or control the goods, material or articles were before being delivered up, is obliged towards their return.

Remedy for groundless threats of infringement proceedings.

25. (1) Where a person threatens another with proceedings for infringement of a registered trademark other than-

(a) use of the mark on goods or their packaging;

(b) the importation of goods to which, or to the packaging of which, the mark has been applied; or

(c) the supply of services under the mark,

any person aggrieved may bring proceedings for relief under this article by sworn application before the Civil Court, First Hall.

(2) The relief which may be applied for is any of the following -

(a) a declaration that the threats are unjustified;

(b) an injunction against the continuance of the threats;

(c) damages in respect of any loss he may have sustained by the threats, and the plaintiff is entitled to such relief unless the defendant shows that the acts in respect of which proceedings were threatened constitute, or if done would constitute, an infringement of the registered trademark concerned.

(3) Where the defendant shows that the acts in respect of which proceedings were threatened constitute or would constitute an infringement of the registered trademark, the plaintiff shall nevertheless be entitled to relief if he shows that the registration of the trademark is invalid or liable to be revoked.

(4) The mere notification that a trademark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this article.

Use of trademarks.

26. (1) If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trademark to genuine use in Malta in connection with the goods or services in respect of which it is registered, or if such use has been suspended during a continuous five-year period, the trademark shall be subject to the limits and sanctions provided for in article 27, article 29(1), article 51(1) and (2), and article 53(3) and (4), unless there are proper reasons for non-use.

(2) Subject to Malta becoming member to the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on 27 June, 1989, the five-year period referred to in sub-article (1), for a trademark registered under international arrangements and having effect in Malta, shall be calculated from the date when the trademark can no longer be rejected or opposed. Where an opposition has been lodged the period shall be calculated from the date when a decision terminating the opposition proceedings became final or the opposition was withdrawn.

(3) The date of commencement of the five-year period, as referred to in sub-article (1) shall be entered in the register.

(4) The following shall also constitute use within the meaning of sub-article (1):

(a) use of the trademark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trademark in the form as used is also registered in the name of the proprietor;

(b) affixing of the trademark to goods or to the packaging thereof in Malta solely for export purposes.

(5) Use of the trademark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

Non-use as defence in infringement proceedings.

27. The proprietor of a trademark shall be entitled to prohibit the use of a sign only to the extent that the proprietor's rights are not liable to be revoked pursuant to article 29 at the time the infringement action is brought. If the defendant so requests, the proprietor of the trademark shall furnish proof that, during the five-year period preceding the date of bringing the action, the trademark has been put to genuine use as provided in article 26 in connection with the goods or services in

respect of which it is registered and which are cited as justification for the action, or that there are proper reasons for non-use, provided that the registration procedure of the trademark has at the date of bringing the action been completed for not less than five years.

Intervening right as defence in infringement proceedings.

28. (1) In infringement proceedings, the proprietor of a trademark shall not be entitled to prohibit the use of a later registered mark where that later trademark would not be declared invalid pursuant to article 10, article 11(1) or (2) or article 53(3).

(2) In infringement proceedings, the proprietor of a trademark shall not be entitled to prohibit the use of a later registered EU trademark where that later trademark would not be declared invalid pursuant to Article 60(1), (3) or (4), 61(1) or (2) or 64(2) of Regulation (EU) No. 2017/1001.

(3) Where the proprietor of a trademark is not entitled to prohibit the use of a later registered trademark pursuant to sub-article (1) or (2), the proprietor of that later registered trademark shall not be entitled to prohibit the use of the earlier trademark in infringement proceedings, even though that earlier right may no longer be invoked against the later trademark.

Revocation of registered trademark rights

Absence of genuine use as grounds for revocation.

29. (1) A trademark shall be liable to revocation if, within a continuous five-year period, it has not been put to genuine use in Malta, in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.

(2) The registration of a trademark shall not be revoked on the grounds mentioned in sub-article (1) if such use as is referred to in that sub-article is commenced or resumed after the expiry of the five-year period and before the action for revocation is made:

Provided that, the commencement or resumption of use within the three-month period preceding the filing of the action shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the action may be filed.

Trademark having become generic or is a misleading indication as grounds for revocation.

30. A trademark shall be liable to revocation if, after the date on which it was registered:

(a) as a result of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered;

(b) as a result of the use made of it by the proprietor of the trademark or with the proprietor's consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

Revocation relating to only some of the goods or services.

31. Where grounds for revocation of a trademark exist in respect of only some of the goods or services for which that trademark has been registered, revocation shall cover those goods or services only.

Registered Trademarks as objects of property

Nature of a registered trademark.

32. A registered trademark is the personal property of its owner.

Co-ownership of a registered trademark.

33. (1) Where a registered trademark is granted to two or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trademark.

(2) The following provisions apply where two or more persons are co-proprietors of a registered trademark, by virtue of sub-article (1) or otherwise.

(3) Subject to any agreement to the contrary, each co-proprietor is entitled, personally or through his agents, to do for his own benefit and without the consent of or the need to account to any other co-proprietor, any act which would otherwise amount to an infringement of the registered trademark.

(4) Notwithstanding the provisions of sub-article (3) a co-proprietor may not without the consent of the other or others -

(a) grant a licence to use the registered trademark; or

(b) assign or cede control of his share in the registered trademark.

(5) Infringement proceedings may be brought by any co-proprietor, but a co-proprietor may not, without the leave of the Court, proceed with the action unless the other, or each of the other co-proprietors, is joined in the suit.

A co-proprietor who is thus joined in the suit shall not be liable for any costs in the action.

Nothing in this sub-article affects the making of any precautionary warrant on the application of a single co-proprietor.

(6) Nothing in this article affects the rights and obligations of trustees or personal representatives, or their rights and obligations as such.

Transmission of a registered trademark.

34. (1) A registered trademark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.

Transfer of a registered trademark.

(2) A registered trademark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered.

(3) A transfer of the whole of the undertaking shall include the transfer of the trademark except where there is agreement to the contrary or circumstances clearly dictate otherwise. This provision shall apply to the contractual obligation to transfer the undertaking.

(4) An assignment of a registered trademark is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, by a personal representative.

(5) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trademark as part of the goodwill of a business.

(6) The Minister may make regulations for the recordal of transfers in the register.

Registration of transactions affecting a registered trademark.

35. (1) On application being made to the Comptroller by –

(a) a person claiming to be entitled to an interest in or under a registered trademark by virtue of a registrable transaction; or

(b) any other person claiming to be affected by such a transaction,

the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions -

(a) an assignment of a registered trademark or any right in it;

(b) the grant of a licence under a registered trademark;

(c) the transfer of a registered trademark by testamentary disposition;

(d) an order of a Court or other competent authority transferring a registered trademark or any right in or under it.

(3) Until an application has been made for registration of the prescribed particulars of a registrable transaction -

(a) the transaction is ineffective as against a person acquiring in good faith a conflicting interest in the registered trademark, and

(b) a person claiming to be a licensee by virtue of the transaction shall not have the protection of article 41 or 42.

(4) Where a person becomes the proprietor or a licensee of a registered trademark by virtue of a registrable transaction, he shall not be entitled to damages or an account of profits in respect of any infringement of the registered trademark occurring after the date of the registrable transaction and before the prescribed particulars of the transaction are registered, unless:

(a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with the date of the transaction; or

(b) the Court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter.

(5) The Minister may make regulations prescribing rules as to -

(a) amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence; and

(b) the removal of such particulars from the register -

(i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired;

(ii) where no such period is indicated and, after such period as may be prescribed, and after the Comptroller has notified the parties of his intention to remove the particulars from the register and the parties have not indicated their agreement that such particulars should not be removed for such period as the parties shall have agreed and indicated to the Comptroller;

(c) the amendment or removal from the register of particulars relating to a security interest on the application of, or with the consent of, the person entitled to the benefit of that interest.

Application for registration of a trademark as an object of property.

36. The provisions of article 32 to 35 apply *mutatis mutandis* in relation to an application for the registration of a trademark in the same manner in relation to a registered trademark.

Rights *in rem*.

37. (1) A trademark may, independently of the undertaking, be given as security or be the subject of rights *in rem*.

(2) The Minister may make regulations for the recordal of a security or of rights *in rem* in the register.

Levy of execution.

38. (1) A trademark may be levied in execution.

(2) The Minister may make regulations for the recordal of levy of execution in the register.

Licensing.

39. (1) A trademark may be licensed for some or all of the goods or services for which it is registered, and for the whole or part of Malta. A licence may be exclusive or non-exclusive.

(2) Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest, and references in this Act to doing anything with, or without, the consent of the proprietor of a registered trademark shall be construed accordingly.

(3) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include a sub-licence or sub-licensee.

(4) The proprietor of a trademark may invoke the rights conferred by that trademark against a licensee who contravenes any provision in his licensing contract with regard to:

(a) its duration;

(b) the form covered by the registration in which the trademark may be used;

(c) the scope of the goods or services for which the licence is granted;

(d) the territory in which the trademark may be affixed; or

(e) the quality of the goods manufactured or of the

services provided by the licensee.

(5) Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a trademark only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trademark, after formal notice, does not himself bring infringement proceedings within an appropriate period.

(6) A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor of the trademark.

(7) The Minister may make regulations for the recordal of licences in the register.

Exclusive licences.

40. (1) In this Act an "exclusive licence" means a licence (whether general or limited) authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trademark in the manner authorised by the licence.

(2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

General provisions as to the rights of licensees in case of infringement.

41. (1) The provisions of this article shall apply with respect to the rights of a licensee in relation to infringement of a registered trademark:

Provided that they shall not apply where or to the extent that, in accordance with article 42(1) an exclusive licensee has a right to bring proceedings in his own name.

(2) A licensee is entitled, unless his licence provides otherwise, to call on the proprietor of the registered trademark to take infringement proceedings in respect of any matter which affects his interests.

(3) If the proprietor -

(a) refuses to do so; or

(b) fails to do so within two months after being called upon,

the licensee may bring the proceedings in his own name as if he were the proprietor.

(4) Where infringement proceedings are brought by a licensee by

virtue of this article, the proprietor shall be joined in the suit.

(5) In infringement proceedings brought by the proprietor of a registered trademark any loss suffered or likely to be suffered by licensees shall be taken into account by the Court which shall give such directions as it thinks fit with regard to the disposal and distribution of any sum awarded as a remedy for the infringement.

Exclusive licensee having right and remedies of assignee.

42. (1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

Where or to the extent that such provision is made, the licensee shall be entitled, subject to the provisions of the licence and to the following provisions of this article, to bring infringement proceedings in his own name against any person other than the proprietor.

(2) The rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered trademark; and references in this Act to the proprietor of a registered trademark relating to infringement shall be construed accordingly.

(3) In an action brought by an exclusive licensee under this article a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trademark.

(4) Where proceedings for infringement of a registered trademark are brought by the proprietor or by the exclusive licensee relating to an infringement in respect of which they have concurrent right of action, the proprietor or, as the case may be, the exclusive licensee who is not the plaintiff shall be joined in the suit.

(5) (a) Where an action for infringement of a registered trademark relating to an infringement in respect of which the proprietor and an exclusive licensee have concurrent right of action is brought -

(i) the Court shall in assessing damages take into account -

(1) the terms of the licence; and

(2) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(ii) no account of profits shall be ordered to be made if an award of damages has been made, or an account of profits has been ordered, in favour of either of them in respect of the infringement; and

(iii) the Court shall, if an account of profits has been ordered, apportion subject to any agreement between them, the profits between them as the Court considers just.

(b) The provisions of this sub-article apply whether action is brought by the proprietor alone, or it is brought by the proprietor and the exclusive licensee; and if they are not both parties the Court may give such directions as it deems fit with regard to the disposal and distribution of any sum awarded as remedy for the infringement.

(6) The proprietor of a registered trademark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under article 21; and the Court may on the application of the licensee make such order under that article as it thinks fit having regard to the terms of the licensee.

(7) The provisions of sub-articles (4) to (6) shall be without prejudice to any agreement to the contrary between the exclusive licensee and the proprietor.

Applications for the registration of a trademark

Application requirements.

43. (1) An application for registration of a trademark shall contain at least all of the following:

(a) a request for registration;

(b) information identifying the applicant;

(c) a list of the goods or services in respect of which the registration is requested;

(d) a representation of the trademark, which satisfies the requirements set out in sub-article (2)(b) of article 4.

(2) The application for a trademark shall be subject to the payment of the prescribed fee.

Date of filing.

44. (1) The date of filing of a trademark application shall be the date on which the documents containing the information specified in article 43(1) are filed with the Office by the applicant.

(2) The accordance of the date of filing is to be subject to the

payment of a fee as referred to in article 43(2):

Provided that where the elements are furnished on different days, the date of filing shall be the date on which the last element is so furnished.

(3) References in this Act to the date of application for registration shall be construed as a reference to the date of filing of the application.

Designation and classification of goods and services.

45. (1) The goods and services in respect of which trademark registration is applied for shall be classified in conformity with the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 ("the Nice Classification").

(2) The goods and services for which protection is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought.

(3) For the purposes of sub-article (2), the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision set out in this article.

(4) The Office shall reject an application in respect of indications or terms which are unclear or imprecise, where the applicant does not suggest an acceptable wording within a period set by the Office to that effect.

(5) The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood.

(6) Where the applicant requests registration for more than one class, the applicant shall group the goods and services according to the classes of the Nice Classification, each group being preceded by the number of the class to which that group of goods or services belongs, and shall present them in the order of the classes.

(7) Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification. Goods and services shall not be regarded as being

dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(8) Any question arising as to the class within which any goods or services fall shall be determined by the Comptroller, whose decision shall be final.

Claim to priority of Convention application.

46. (1) A person who has duly filed an application for protection of a trademark in a country which is a member of the World Trade Organisation or a party to the Paris Convention, hereinafter in this Act referred to as a "Convention application", or his successor in title, has a right to priority, for the purposes of registering the same trademark under this Act for any or all of the same goods or services for which such an application has been filed, for a period of six months from the date of filing of the first such application.

(2) If the application for registration under this Act is made within such six-month period -

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application; and

(b) the registrability of the trademark shall not be affected by any use of the mark in Malta in the period between that date and the date of the application under this Act.

(3) (a) Any filing which in a country which is a member of the World Trade Organisation or is a party to the Paris Convention is made under its legislation or any international agreement to which such country is a party, treated as if it were a regular national filing, shall be treated as giving rise to the right of priority.

(b) For the purposes of this sub-article "regular national filing" means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent application.

(4) A subsequent application concerning the same goods or services as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (the filing date of which is the starting date of the period of priority), if at the time of the subsequent application -

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and

(b) it has not yet served as a basis for claiming a right of priority, and the previous application may not thereafter serve as a basis for claiming a right of priority.

(5) Provision may be made by rules as to the manner of claiming a right to priority on the basis of a Convention application.

(6) A right to priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently.

Claim to priority from other relevant overseas application.

47. (1) The Minister may make regulations conferring on a person who has duly filed an application for protection of a trademark in a country or territory in relation to which the Maltese Government is a party to a treaty, convention, arrangement or engagement for the reciprocal protection of trademarks, a right to priority, for the purpose of registering the same trademark under this Act for any or all of the same goods or services, for such a period as may be specified in the application from the date of filing of that application.

(2) Such regulations may make provisions similar to those contained in article 46 in relation to Convention applications or such other provision as appears to the Minister to be appropriate.

Examination of application.

48. (1) The Comptroller shall examine whether an application for registration of a trademark satisfies the requirements of this Act:

Provided that the Minister may prescribe regulations as to whether such examination shall include *ex officio* relative grounds examination.

(2) If it appears to the Comptroller that the requirements for registration are not met, he shall inform the applicant and give him an opportunity to make representations or to amend the application within such period as the Comptroller may specify.

(3) If the applicant fails to satisfy the Comptroller that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the Comptroller shall refuse the application.

(4) If it appears to the Comptroller that the requirements for registration are met, he shall accept the application as eligible for registration.

Withdrawal, restriction or amendment of application.

49. (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

(2) Save as provided in sub-article (1), an application may be amended, at the request of the applicant, only by correcting -

(a) the name or address of the applicant;

(b) errors of wording or of copying; or

(c) obvious mistakes, and then only where the correction does not substantially affect the identity of the trademark or extend the goods or services covered by the application.

Opposition procedure.

50. (1) The proprietor of an earlier trademark as referred to in article 6(2) and article 6(3)(a), and the person authorised under the relevant law to exercise the rights arising from a protected designation of origin or geographical indication as referred to in article 6(3)(c) shall be entitled to file a notice of opposition to the registration of a trademark before the Comptroller. A notice of opposition may be filed on the basis of one or more earlier rights, provided that they all belong to the same proprietor, and on the basis of part or the totality of the goods or services in respect of which the earlier right is protected or applied for, and may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.

(2) The parties shall be granted, at their joint request, a period of up to 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.

(3) The Minister may make regulations in respect of all aspects relevant to the opposition procedure.

Non-use as defence in opposition proceedings.

51. (1) In opposition proceedings pursuant to article 50, where at the filing date or date of priority of the later trademark, the five-year period within which the earlier trademark must have been put to genuine use as provided for in article 26 had expired, at the request of the applicant, the proprietor of the earlier trademark who has given notice of opposition shall furnish proof that the earlier trademark has been put to genuine use as provided for in article 26 during the five-year period preceding the filing date or date of priority of the later trademark, or that proper reasons for non-use existed. In the absence of proof to this effect, the opposition shall be rejected.

(2) If the earlier trademark has been used in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the opposition as provided for in sub-article (1), be deemed to be registered in respect of that part of the goods or services only.

(3) Sub-articles (1) and (2) shall also apply where the earlier trademark is an EU trademark. In such a case, the genuine use of the EU trademark shall be determined in accordance with Article 18 of Regulation (EU) No. 2017/1001.

Procedure for revocation or declaration of invalidity.

52. (1) Without prejudice to the right of the parties to seek recourse to the courts, the revocation or declaration of invalidity of a registered trademark may be brought before the Comptroller as provided for under this Act or by sworn application to be filed in the First Hall of the Civil Court:

Provided that invalidity and revocation proceedings may only be initiated before the Comptroller as from 14th January 2023 or any date before as may be prescribed by the Minister.

(2) An action for revocation of a registered trademark shall be brought on any one or more of the grounds provided for in articles 29 and 30.

(3) An action for declaration of invalidity of a registered trademark shall be brought on:

(a) any one or more of the grounds provided for in article 5; and, or

(b) any one or more of the grounds provided for in article 6:

Provided that it shall only be possible to bring an action for declaration of invalidity of a registered trademark before the Comptroller on any one or more of the grounds of article 5 and article 6(1) to (3).

(4) An action for revocation or for a declaration of invalidity of a registered trademark before the Comptroller may only be filed:

(a) in the case of sub-articles (2) and (3)(a), by any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, and which, under the terms of the law governing it, has the capacity to sue in its own name and to be sued;

(b) in the case of sub-article (3)(b), by the proprietor of an earlier trademark as referred to in article 6(2) and article 6(3)(a), and the person authorised under the relevant law to exercise the rights arising from a protected designation of origin or geographical indication as referred to in article 6(3)(c).

(5) An action for revocation or for a declaration of invalidity may be directed against a part or the totality of the goods or services in respect of which the contested mark is registered.

(6) An action for a declaration of invalidity may be filed on the basis of one or more earlier rights, provided they all belong to the same proprietor.

(7) If an action for invalidity or revocation has been brought before the Comptroller, it shall not be possible to file for an action on the same grounds before the First Hall of the Civil Court after the proceedings before the Comptroller have been concluded:

Provided that, when a person brings an action for invalidity or revocation before the Comptroller, at any stage before the proceedings are concluded, that person may bring an action for invalidity or revocation on the same grounds before the First Hall of the Civil Court as a result of which the proceedings before the Comptroller will discontinue:

Provided further that if an action for invalidity or revocation has been brought before the First Hall of the Civil Court, it shall not be possible to file for an action on the same grounds before the Comptroller.

Non-use as a defence in proceedings seeking a declaration of invalidity.

53. (1) In proceedings for a declaration of invalidity based on a registered trademark with an earlier filing date or priority date, if the proprietor of the later trademark so requests, the proprietor of the earlier trademark shall furnish proof that, during the five-year period preceding the date of the action for a declaration of invalidity, the earlier trademark has been put to genuine use, as provided for in article 26, in connection with the goods or services in respect of which it is registered and which are cited as justification for the action, or that there are proper reasons for non-use, provided that the registration process of the earlier trademark has at the date of the action for a declaration of invalidity been completed for not less than five years.

(2) Where, at the filing date or date of priority of the later trademark, the five-year period within which the earlier trademark was to have been put to genuine use, as provided for in article 26, had expired, the proprietor of the earlier trademark shall, in addition to the proof required under sub-article (1), furnish proof that the trademark was put to genuine use during the five-year period preceding the filing date or date of priority, or that proper reasons for non-use existed.

(3) In the absence of the proof referred to in sub-articles (1) and (2), an action for a declaration of invalidity on the basis of an earlier

trademark shall be rejected.

(4) If the earlier trademark has been used in accordance with article 26 in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the action for a declaration of invalidity, be deemed to be registered in respect of that part of the goods or services only.

(5) Sub-articles (1) to (4) shall also apply where the earlier trademark is an EU trademark. In such a case, genuine use of the EU trademark shall be determined in accordance with Article 18 of Regulation (EU) No. 2017/1001.

Consequences of revocation and invalidity.

54. (1) A registered trademark shall be deemed not to have had, as from the date of the action for revocation, the effects specified in this Act, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision on the action for revocation, at the request of one of the parties.

(2) A registered trademark shall be deemed not to have had, as from the outset, the effects specified in this Act, to the extent that the trademark has been declared invalid.

Communications with the Comptroller.

55. Parties to the proceedings or, where appointed, their representatives, shall designate an official address for all official communications with the Comptroller and shall have an official address to be situated in the European Economic Area.

Registration.

56. (1) Where an application has been accepted as eligible for registration, the Comptroller shall register the trademark, unless it appears to him, having regard to matters coming to his notice after he accepted the application, that it was accepted in error.

(2) A trademark shall not be registered and the application shall be deemed to be withdrawn unless any fee prescribed in respect of any action taken before the registration is paid within the prescribed period.

(3) A trademark when registered shall be registered as of the date of filing of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

(4) On the registration of a trademark the Comptroller shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration:

Provided that when an opposition has been received within

the prescribed time the Comptroller shall only publish such registration in the event the said opposition has been rejected:

Provided further that if more than one opposition has been received and one or more oppositions have been accepted, such publication shall not take place.

(5) Notwithstanding sub-article (4) above the Comptroller shall publish the registration of a trademark where an agreement has been reached following an opposition that there shall be an amendment to the goods or services in respect of which the trademark applied for is to be registered:

Provided that such registration shall take place only when such amendment has been effected by the applicant.

Duration of registration.

57. (1) A trademark shall be registered for a period of 10 years from the date of filing of the application.

(2) Registration may be renewed in accordance with article 58 for further 10-year periods.

Renewal.

58. (1) Registration of a trademark shall be renewed at the request of the proprietor of the trademark or of any person authorised to do so by law or by contract, provided that the renewal fees have been paid not earlier than six months before the date of expiry.

(2) The Comptroller shall inform the proprietor of the trademark of the expiry of the registration at least six months before the said expiry. The Comptroller shall not be held liable for failure to give such information.

(3) The request for renewal shall be submitted and the renewal fees shall be paid within a period of not more than six months immediately preceding the expiry of the registration or of the subsequent renewal thereof. Failing that, the request may be submitted within a further period of six months immediately following the expiry of the registration or of the subsequent renewal thereof. The renewal fees and an additional fee shall be paid within that further period.

(4) Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be recorded in the register.

(5) If the registration is not renewed in accordance with the above provisions, the Comptroller shall remove the trademark from the register.

(6) Provision may be made by rules for the restoration of the registration of a trademark which has been removed from the register, subject to such conditions (if any) as may be prescribed.

(7) The renewal or restoration of the registration of a trademark shall be published in the prescribed manner.

Alteration of a registered trademark.

59. (1) A registered trademark shall not be altered in the register, during the period of registration or on renewal.

(2) Nevertheless, the Comptroller may, at the request of the proprietor, allow the alteration of a registered trademark where the mark includes the proprietor's name or address and the alteration is limited to the alteration of that name or address and does not substantially affect the identity of the mark.

(3) Provision shall be made by rules for the publication of any such alteration and the making of objections by any person claiming to be affected by it.

Surrender of a registered trademark.

60. (1) A registered trademark may be surrendered by the proprietor in respect of any or all of the goods or services for which it is registered.

(2) Provision may be made by rules -

(a) as to the manner and effect of a surrender; and

(b) for protecting the interests of other persons having a right in the registered trademark.

Definitions of certification marks and collective marks.

61. For the purposes of this Act, the following definitions apply:

(a) "certification mark" means a trademark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, from goods and services which are not so certified;

(b) "collective mark" means a trademark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of members of an association which is the proprietor of the mark from the goods or services of other undertakings.

General disposition.

62. The provisions of this Act apply to certification marks subject to the following provisions which may, by regulations, be amended by

the Minister.

Signs of which a certification mark may consist.

63. In relation to a certification mark the reference in the definition of "trademark" in article 4 (2)(a) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Certification marks.

64. (1) Any natural or legal person, including institutions, authorities and bodies governed by public law, may apply for certification marks provided that such person does not carry on a business involving the supply of goods or services of the kind certified.

Indication of geographical origin.

(2) Signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute certification marks. Such a certification mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided that third party uses them in accordance with honest practices in industrial or commercial matters. In particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.

(3) The requirements laid down in article 26 shall be satisfied where genuine use of a certification mark in accordance with article 26 is made by any person who has the authority to use it.

Nature of proprietor's business.

65. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance.

66. (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

(2) The Comptroller may accordingly require that a mark in respect of which application is made for registration includes some indication that it is a certification mark, and notwithstanding the provisions of article 49(2), an application may be amended so as to comply with any such requirement.

Regulations governing use of certification mark.

67. An applicant for registration of a certification mark must file with the Comptroller regulations governing the use of the mark specifying the person authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the

procedures for resolving disputes and any further requirements with which the regulations have to comply as may be established by any rule made by the Minister.

Approval of regulations, etc.

68. (1) A certification mark shall not be registered unless -

(a) the regulations governing the use of the mark -

(i) comply with article 67 and any further requirements imposed by rules; and

(ii) are not contrary to public policy or to accepted principles of morality; and

(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) The application shall be deemed to be withdrawn if before the end of any period as may be prescribed after the date of the application for registration of a certification mark, the applicant fails to file the regulations with the Comptroller and pay the prescribed fee.

Requirements.

69. (1) The Comptroller shall consider whether the requirements mentioned in article 68(1) are met.

(2) If it appears to the Comptroller that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the Comptroller may specify, to make representations or to file amended regulations.

(3) If the applicant fails to satisfy the Comptroller that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the Comptroller shall refuse the application.

(4) If it appears to the Comptroller that those requirements, and the requirements for registration are met, he shall accept the application and shall proceed in accordance with article 56.

Regulations to be open to inspection.

70. The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

Amendment of regulations.

71. An amendment of the regulations governing the use of a registered collective mark is not effective unless and until the amended regulations are filed with the Comptroller and accepted by him.

Consent to assignment of registered certification mark.

72. The assignment or other transmission of a registered certification mark is not effective without the consent of the Comptroller.

Infringement: right of authorised users

73. The provisions of sub-article (7) of article 12 and of sub-article (2) of article 24 apply in relation to an authorized user of a registered certificate mark as in relation to a licensee of a trademark.

Infringement proceedings.

74. In infringement proceedings brought by the proprietor of a registered certification mark, any loss suffered or likely to be suffered by authorised users shall be taken into account by the Court which shall give such directions as it thinks fit with regard to the disposal and distribution of any sum awarded as a remedy for infringement.

Grounds for revocation of registration – certification mark.

75. Apart from the grounds of revocation provided for in article 29, the registration of a certification mark may be revoked on any of the following grounds:

(a) that the proprietor has begun to carry out such a business in contravention of article 65;

(b) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in article 66(1);

(c) that the proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark;

(d) that an amendment of the regulations has been made so that the regulations -

(i) no longer comply with article 67; or

(ii) are contrary to public policy or to accepted principles of morality;

(e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

Grounds for invalidity of registration - certification marks.

76. Apart from the grounds of invalidity provided for in articles 5 and 6, the registration of a certification mark may be declared invalid on the grounds that the mark was registered in breach of the provisions of articles 65, 66(1) or 68(1).

General dispositions– collective marks.

77. The provisions of this Act apply to collective marks subject to the following provisions, which may, by regulations, be amended by the Minister.

Signs of which a collective mark may consist.

78. In relation to a collective mark the reference in the definition of "trademark" in article 4(2)(a) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

Capacity of Associations to accomplish legal acts – Collective Marks.

79. (1) Associations of manufacturers, producers, suppliers of services or traders, which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations, to make contracts or accomplish other legal acts, and to sue and be sued, as well as legal persons governed by public law, may apply for collective marks.

(2) Signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective marks. Such a collective mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, such signs or indications, provided that third party uses them in accordance with honest practices in industrial or commercial matters. In particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.

Collective mark not to be misleading as to character or significance.

80. (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be construed as something other than a collective mark.

(2) The Comptroller may accordingly require that a mark in respect of which application is made for registration includes some indication that it is a collective mark; and notwithstanding the provisions of article 49(2), an application may be amended so as to comply with any such requirement.

Regulations governing use of a collective mark.

81. (1) An applicant for a collective mark shall submit the regulations governing its use to the Comptroller.

(2) The regulations governing use shall specify at least the persons authorised to use the mark, the conditions of membership of the association and the conditions of use of the mark, including sanctions. The regulations governing use of a mark referred to in article 79(1) shall authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.

Approval of regulations by Comptroller.

82. (1) A collective mark shall not be registered unless the regulations governing the use of the mark -

(a) comply with article 81(2) and any further requirements imposed by rules; and

(b) are not contrary to public policy or to accepted principles of morality.

(2) The application shall be deemed to be withdrawn if before the end of any period as may be prescribed after the date of the application for registration of a collective mark, the applicant fails to file the regulations with the Comptroller and pay the prescribed fee.

Comptroller to consider requirements.

83. (1) The Comptroller shall consider whether the requirements mentioned in article 82(1) are met.

(2) If it appears to the Comptroller that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the Comptroller may specify, to make representations or to file amended regulations.

(3) If the applicant fails to satisfy the Comptroller that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the Comptroller shall refuse the application.

(4) If it appears to the Comptroller that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with article 56.

Regulations to be open to inspection.

84. The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

Refusal of an application for a collective mark.

85. (1) In addition to the grounds for refusal of a trademark application provided for in article 5, where appropriate with the exception of article 5(1)(c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, and article 6, and without prejudice to the right of the Office not to undertake examination *ex officio* of relative grounds, an application for a collective mark shall be refused where the provisions of article 61(b), article 79 or article 81 are not satisfied, or where the regulations governing use of that collective mark are contrary to public policy or to accepted principles of morality.

(2) An application for a collective mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

(3) An application shall not be refused if the applicant, as a result

of amendment of the regulations governing use of the collective mark, meets the requirements referred to in sub-articles (1) and (2).

Use of collective marks.

86. The requirements of article 26 shall be satisfied where genuine use of a collective mark in accordance with that article is made by any person who has authority to use it.

Amendments to the regulations governing use of a collective mark.

87. (1) The proprietor of a collective mark shall submit to the Comptroller any amended regulations governing use.

(2) Amendments to the regulations governing use shall be mentioned in the register unless the amended regulations do not satisfy the requirements of article 81 or involve one of the grounds for refusal referred to in article 85.

(3) For the purposes of this Act, amendments to the regulations governing use shall take effect only from the date of entry of the mention of those amendments in the register.

Persons entitled to bring an action for infringement.

88. (1) Article 39(5) and (6) shall apply to every person who has the authority to use a collective mark.

(2) The proprietor of a collective mark shall be entitled to claim compensation on behalf of persons who have authority to use the collective mark where those persons have sustained damage as a result of unauthorised use of the collective mark.

Additional grounds for revocation – collective marks.

89. In addition to the grounds for the revocation provided for in articles 29 and 30, the rights of the proprietor of a collective mark shall be revoked on any of the following grounds:

(a) the proprietor does not take reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use laid down in the regulations governing use, including any amendments thereto mentioned in the register;

(b) the manner in which the mark has been used by authorised persons has caused it to become liable to mislead the public in the manner referred to in article 85(2);

(c) an amendment to the regulations governing use of the mark has been mentioned in the register in breach of article 87(2), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of that article.

Additional grounds for invalidity.

90. In addition to the grounds for invalidity provided for in article 5, where appropriate with the exception of article 5(1)(c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, and article 6, a collective mark which is registered in breach of article 85 shall be declared invalid unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of article 85.

PART III - ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS

Maintenance and content of register.

91. (1) (a) The Comptroller shall maintain a register of trademarks.

(b) References in this Act to "the register" are to that register; and references to registration, in particular, in the expression "registered trademark", are, unless the context otherwise requires, to registration in that register.

(2) There shall be entered in the register in accordance with this Act -

(a) registered trademarks;

(b) such particulars as may be prescribed of registrable transactions affecting a registered trademark; and

(c) such other matters relating to registered trademarks as may be prescribed.

(3) The register shall be kept in such manner as may be prescribed, and provision shall in particular be made for -

(a) public inspection of the register; and

(b) the supply of certified or uncertified copies, or extracts, of entries in the register.

Rectification or correction of the register.

92. (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trademark.

(2) An application for rectification may be made either to the Comptroller or to the Court:

Provided that if proceedings concerning the trademarks in question are pending before the Court -

(a) the application must be made to the Court; and

(b) if the application is made to the Comptroller, he may at any stage of the proceedings refer the application to the Court.

(3) Except where the Comptroller or the Court directs otherwise the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) The Comptroller may, on request made in the prescribed manner by the proprietor of a registered trademark, or a licensee, enter any change in his name or address as recorded in the register.

(5) The Comptroller may remove from the register any matter appearing to him to have ceased to have effect.

(6) The applicant or proprietor may divide a national trademark application or registration into two or more separate applications or registrations by sending a declaration to the Office and indicating for each divisional application or registration the goods or services covered by the original application or registration which are to be covered by the divisional applications or registrations.

Adaptation of entries to new classification.

93. (1) The Minister may by regulations make rules empowering the Comptroller to do such things as may be necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trademarks, and without prejudice to the generality of the aforesaid provision may in particular be made for the amendment of existing entries on the register so as to accord with the new classification.

(2) Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the Comptroller that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the right of any person.

(3) The rules may moreover empower the Comptroller -

(a) to require the proprietor of a registered trademark, within such time as may be prescribed, to file a proposal for amendment of the register; and

(b) to cancel or refuse to renew the registration of the trademark in the event of his failing to do so.

(4) Any such proposal shall be advertised, and may be opposed, in such manner as may be prescribed.

Power to require use forms.

94. The Comptroller may require the use of such forms as he may direct for any purpose relating to the registration of a trademark or any other proceeding before him under this Act.

Information about applications and registered trademarks.

95. (1) Subject to such restrictions as the Minister may by regulations impose after publication of the registration of a trademark, the Comptroller shall on request provide a person with such information and permit him to inspect such documents relating to the registered trademark, as may be specified in the request.

Any such request must be made in such manner and be accompanied by such fee as may be prescribed.

(2) Before publication of registration of a trademark, documents or information constituting or relating to the application shall not be published by the Comptroller or communicated by him to any person except -

(a) in such cases and to such extent as may be prescribed; or

(b) with the consent of the applicant.

Exclusion of liability in respect of official acts.

96. (1) The Comptroller shall not be taken to warrant the validity of the registration of a trademark under this Act or under any treaty, convention, arrangement or engagement to which Malta is a party.

(2) The Comptroller is not subject to any liability by reason of, or in connection with, any examination required or authorised by this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.

(3) No action shall lie against an Officer of the Comptroller in respect of any matter for which, by virtue of this article, the Comptroller is not liable.

Registration to be *prima facie* evidence of validity.

97. In all legal proceedings relating to a registered trademark (including proceedings for rectification of the register) the registration of a person as proprietor of a trademark shall be *prima facie* evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.

Certification of validity of contested registration.

98. (1) If in proceedings before the Court the validity of the registration of a trademark is contested and it is found by the Court that the trademark is validly registered, the Court shall give judgement

accordingly.

(2) Where the Court has given such a judgement and in subsequent proceedings –

(a) the validity of the registration is again questioned; and

(b) the proprietor obtains a final order or judgement in his favour,

the proprietor shall be entitled to his costs unless the Court directs otherwise.

Comptroller's appearance in proceedings involving the register.

99. (1) In proceedings before the Court involving a demand for-

(a) the revocation of the registration of a trademark;

(b) a declaration of the invalidity of the registration of a trademark; or

(c) the rectification of the register,

the Comptroller shall be notified with the proceedings and shall be entitled to appear and to be heard if so directed by the Court.

(2) Unless otherwise directed by the Court, the Comptroller may, instead of appearing, file in the record of the case a statement in writing signed by him, giving particulars of -

(a) any proceedings before him in relation to the matter in issue;

(b) the grounds of any decision given by him affecting it;

(c) the practice of the Office in like cases; or

(d) such matters relevant to the issues and within his knowledge as Comptroller as he thinks fit,

and the statement shall be deemed to form part of the evidence in the proceedings.

Appeals from the Comptroller's decision. Cap. 12.

100. (1) Any decision of the Comptroller under this Act, may be appealed from, before the Court of Appeal composed in the manner provided in sub-article (9) of article 41 of the Code of Organization and Civil Procedure by application within fifteen days of service of the Comptroller's decision.

(2) For the purposes of sub-article (1) "decision" means any act, other than such acts as may by regulations be prescribed, done by the Comptroller in exercise of a discretion vested in him by or under this Act.

(3) The Minister may make rules governing appeals to the Court of Appeal under this Act, and presenting a scale of costs and fees in relation to such appeals.

Power of Minister to make rules.

101. (1) The Minister responsible for the protection of industrial property may make regulations for the better administration of this Act, making such rules as are required by any provisions of this Act, prescribing anything authorised or required by any provision of this Act to be prescribed, and generally for regulating practice and procedure under this Act, and in particular provision may be made -

(a) with regard to the manner of filing of applications and other documents;

(b) for the submission of documents and the filing and authentication of any translation;

(c) with regard to the service of documents;

(d) authorising the rectification of irregularities of procedure;

(e) prescribing time limits for anything required to be done in connection with any proceeding under this Act;

(f) for the extension of any time limit so prescribed, or specified by the Comptroller whether or not such time limit has already expired;

(g) for the division of a national trademark application or registration by the applicant or proprietor, into two or more separate applications or registrations;

(h) providing for the possibility of multi-class applications and registrations;

(i) in the case of multi class registration, for the possibility of a renewal of registration in respect of only those goods and services for which a submission of a request for renewal has been received and for which a payment of fees has been effected;

(j) to align legislation following amendment to the

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks.

Fees.

102. (1) There shall be paid in respect of applications and other matters under this Act such fees as may be prescribed.

(2) Provision may be made by rules as to -

(a) the payment of a single fee in respect of two or more matters;

(b) the circumstances, if any, in which a fee may be repaid or remitted;

(c) prescribing an additional fee for each class of goods and services beyond the first class, for the application and renewal of a trademark;

(d) circumstances where different fees may be charged or may not be charged at all.

Hours of business and business days.

103. (1) The Comptroller may give directions specifying the hours of business of the Industrial Property Office for the purpose of the transaction by the public of business under this Act, and the days which are business days for that purpose.

(2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.

(3) Directions under this article may make different provisions for different classes of business and shall be published in the prescribed manner.

Recognition of trademark agents.

104. Except as may otherwise be prescribed, any act required or authorised by this Act to be done by or in respect of a person in connection with the registration of a trademark, or any procedure relating to a registered trademark, may be done by or in respect of an agent authorised by that person in writing.

The register of trademark agents/ attorneys.

105. (1) The Minister may make rules requiring the keeping of a register of persons who act as agent for the purpose of applying for or obtaining the registration of trademarks; and in this Act a "registered trademark agent" means a person whose name is entered in the register kept under this article.

(2) The Minister may make rules regulating the registration of persons as registered trademark agents, and may in particular -

(a) require the payment of such fees in connection with such registration as may be prescribed; and

(b) authorise in such cases as shall be specified the erasure from the register of the name of any person registered as a registered trademark agent or the suspension of such a registration.

(3) Only registered persons may -

(a) carry on a business under any name or other description which contains the words "registered trademark agent"; or

(b) in the course of a business otherwise describe or hold himself out, or permit themselves to be described or held out, as registered trademark agents.

Privilege for communication with registered trademark agents. Cap. 12.

106. The provisions of article 588 of the Code of Organization and Civil Procedure shall apply with regard to registered trademark agents as they apply with respect to advocates and legal procurators.

Power to Comptroller to refuse to deal with certain agents.

107. The Comptroller may, in accordance with such rules as may be prescribed, refuse to recognize as agent in respect of any business under this Act -

(a) a person who not being a registered trademark agent shall have falsely posed as such;

(b) a person whose name has been erased from and not restored to, or who is suspended from, the register of trademark agents on the grounds of misconduct;

(c) a partnership or body corporate of which one of the partners or directors is a person whom the Comptroller could refuse to recognize under paragraph (a) or (b) above.

PART IV - CRIMINAL OFFENCES

Unauthorised use of trademark, etc., in relation to goods.

108. (1) Any person who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor -

(a) applies to goods or their packaging a sign identical to, or likely to be mistaken for, a registered trademark; or

(b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign; or

(c) has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b); or

(d) applies a sign identical to, or likely to be mistaken for, a registered trademark to material intended to be used -

(i) for labelling or packaging goods;

(ii) as a business paper in relation to goods; or

(iii) for advertising goods; or

(e) uses, in the course of a business material bearing such a sign for labelling or packaging goods, or as a business paper in relation to goods, or for advertising goods; or

(f) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (e); or

(g) (i) makes an article specifically designed or adapted for making copies of a sign of or to make a sign likely to be mistaken for, a registered trademark; or

(ii) has such an article in his possession, custody or control in the course of a business,

knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods,

shall be guilty of an offence against this article.

(2) A person does not commit an offence against this article

unless -

(a) the goods to which the offence refers are goods in respect of which the trademark is registered; or

(b) the trademark has a reputation in Malta and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trademark.

(3) It is a defence for a person charged with an offence against this article to show that he believed on reasonable grounds that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the registered trademark.

(4) A person guilty of an offence under this article shall be liable on conviction to imprisonment for a term not exceeding three years or to a fine (*multa*) of not more than twenty-three thousand and two hundred and ninety-five euro (€23,295) or to both such fine and imprisonment.

Falsification of register, etc.

109. (1) Any person who knowing or having reason to believe that it is false:-

(a) makes, or causes to be made, a false entry in the register of trademarks; or

(b) makes, or causes to be made, anything falsely purporting to be a copy of an entry in the register; or

(c) produces or tenders or causes to be produced or tendered in evidence any such thing,

shall be guilty of an offence against this article.

(2) A person guilty of an offence against this article shall be liable on conviction to imprisonment for a term not exceeding two years or a fine (*multa*) of not more than eleven thousand and six hundred and fifty euro (€11,650) or to both such fine and imprisonment.

Falsely representing trademark as registered.

110. (1) It shall be an offence against this article for a person -

(a) to falsely represent a trademark as a registered trademark; or

(b) to make a false representation as to the goods or services for which a trademark is registered, knowing or having

reason to believe that the representation is false.

(2) For the purposes of this article, the use in Malta in relation to a trademark -

(a) of the word "registered"; or

(b) of any other word or symbol importing a reference, express or implied, to registration, shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in Malta and that the trademark is in fact so registered for the goods or services in question.

(3) A person guilty of an offence against this article shall be liable on conviction to a fine (*multa*) of not more than eleven thousand and six hundred and fifty euro (€11,650).

Unauthorised use of certain devices, emblems, etc.

111. (1) A person shall not without the authority of the President use in connection with any business any device, emblem or title in such a manner as to be calculated to lead to the belief that he is employed by, or supplies goods or services to, the President.

(2) Any person who contravenes the provisions of sub-article (1) shall be guilty of an offence against this article and shall on conviction be liable to a fine (*multa*) of not more than six thousand and nine hundred and ninety euro (€6,990).

Delivery up of infringing articles, etc.

112. The Court may, moreover, in the cases referred to in article 109, on the demand of the prosecution, order that the machinery or other industrial means or contrivances used in contravention of the rights of the proprietors of the trademarks, the infringing articles, and the apparatus destined for their production, be forfeited, wholly or in part, and delivered to the holder of the trademark, without prejudice to any other right to relief under this Act.

Powers of Magistrates.

113. Pending any proceedings for any one of the offences referred to in this Part, any Magistrate, if he is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of, or in relation to which the offence has been committed, are in any house or premises of the accused, or are in his possession or under his control in any other place, may, by a warrant under his hand, direct any Officer of the Police to be named in the warrant, to enter any house, premises or place, also to be named therein, and there to search for, seize, and remove such goods or things.

Where owner of goods is unknown.

114. If the owner of any goods or things, which, if he were convicted of any of the offences referred to in this Part, would be liable

to forfeiture, is unknown or cannot be found, any Magistrate may in the like manner and in the circumstances required in the last preceding article, issue the said warrant.

Forfeiture of things seized.

115. The goods and things so seized shall be produced before the Court of Magistrates sitting as a court of criminal judicature, and such Court shall determine whether they are liable to forfeiture under this Act.

Procedure where owner is unknown.

116. (1) In the case referred to in article 114, the Court shall order the issue of banns which shall be published twice, with an interval of at least eight days, in the Gazette, and posted up at the entrance of the building wherein the Court sits, and in any other place which the court may deem fit, stating that the goods or things seized shall be forfeited, unless at the time and place named in the banns the owner of such goods or things or other person interested in such goods or things attends before the Court at the time and place indicated in the banns and shows cause to the contrary.

(2) If the owner or any person on his behalf, or other person interested in the said goods or things, fails to attend at the time and place named in the banns to show cause to the contrary, it shall be lawful for the Court to direct that such goods or things or any of them be forfeited.

Award of compensation to parties in good faith.

117. The Court may direct that the goods or things so forfeited be destroyed or disposed of, after the trademarks or other trade descriptions have been obliterated from them, and may also direct that, out of the net proceeds which may be realized by the disposal of such goods or things and up to the amount thereof, any persons who, being in good faith, were injured by the forfeiture, be awarded compensation for any loss caused to them.

Limitation of criminal actions.

118. Criminal actions under this Act shall be barred by the lapse of three years from the day on which the act constituting the offence was committed, if the person to whose prejudice the act was committed, had no previous knowledge thereof; in all other cases the period of limitation shall be one year from the day on which such person became aware of that act.

Use of forged marks.

119. The provisions relating to the use of forged marks shall not apply to the use of any mark of manufacture or description used in trade to indicate goods of a particular class, or the manufacture thereof by any particular method, where, at the time of the promulgation of this Act, such mark of manufacture or description was lawfully and generally applied for the above-mentioned purpose:

Provided that where such mark of manufacture or description

includes the name of a place or country and the goods are not produced in the place or country indicated in the mark of manufacture or description so used, the provisions of this article shall not apply, unless there is added to the mark of manufacture or description, immediately before or after the name of the said place or country, in an equally conspicuous manner, the name of the place or country in which the goods were actually made or produced, and unless there is also stated that the goods were made or produced in that place or country.

Person falsely representing himself as a registered trademark agent.

120. Any person who falsely claims to be a registered trademark agent when he is not so registered in accordance with article 105, shall be guilty of an offence against this article and shall on conviction be liable to a fine (*multa*) of not more than one thousand and one hundred and sixty-five euro (€1,165).

Right to damages not affected.

121. The provisions of this Part shall apply without prejudice to the right of any person to claim damages in consequence of any Act constituting an offence.

Employer and employee.

122. No proceedings shall be instituted against any person in the service of another person, if, he shows that in good faith, he acted in obedience to the instructions of his employer, and, on being questioned by the Police, gives full information relating to his employer and of the facts of the case as known to him.

PART V - MISCELLANEOUS ON CIVIL PROCEEDINGS AND ACTIONS

Burden of proving use of trademark.

123. In any civil proceedings under this Act if a question arises as to the use to which a registered trademark has been put, the burden of proof that a particular use has been made shall lie on the proprietor.

Limitations of civil actions.

124. Civil actions under this Act shall be barred by the lapse of five years in all cases in which no other period within which such actions may be brought is fixed in this Act.

PART VI - INTERNATIONAL MATTERS

SECTION 1

The Paris Convention

The Paris Convention.

125. (1) In this Part –

(a) "Convention country" means a country, other than Malta, which is a party to that Convention; and

(b) "the Paris Convention" means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as

revised or amended from time to time.

(2) The Minister may make regulations to make provision, as appear to him appropriate in consequence of any revision or amendment of the Paris Convention after the passing of this Act to enable Malta to comply with any provisions of such amendment, and such regulations may in particular provide that any of the provisions of Part II of this Act shall no longer apply or shall apply with such amendments as may be required.

Protection of well-known trademarks: Article 6*bis*.

126. (1) References in this Act to a trademark which is entitled to protection under the Paris Convention as a well-known trademark are to a mark which is well-known in Malta as being the mark of a person who is a national of a Convention country, or is domiciled in, or has a real and effective industrial or commercial establishment in a Convention country, whether or not that person carries on business, or has any goodwill, in Malta, and reference to the proprietor of such a mark shall be construed accordingly.

(2) Subject to the provisions of article 11, the proprietor of a trademark which is entitled to protection under the Paris Convention as a well-known trademark is entitled to restrain by injunction the use in Malta of a trademark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

Cap. 416.

(3) Nothing in sub-article (2) shall affect the continuation of any *bona fide* use of a trademark begun before the coming into force of the Trademarks Act.

National emblems, etc., of Convention countries: Article 6*ter*.

127. (1) A trademark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Comptroller that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trademark which consists of or contains the armorial bearing or any other State emblem of a Convention country which is protected under the Paris Convention shall not be registered without the authorisation of the competent authorities of that country.

(3) A trademark which consists of or contains an official sign or hallmark indicating control and warranty adopted by a Convention country shall not, where the sign or hall mark is protected under the Paris Convention, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned.

(4) The provisions of this article relative to national flags and other State emblems, and official signs or hallmarks apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this article prevents the registration of a trademark on the application of a national of a country who is authorised to make use of a State emblem or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this article the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trademark, those authorities are entitled to restrain any use of the mark in Malta without their authorisation.

Emblems, etc., of certain international organisations: Article 6*ter*.

128. (1) This article applies to the armorial bearing, flags or other emblems, and the names and their abbreviations, of international intergovernmental organisations of which one or more Convention countries are members.

(2) A trademark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention shall not be registered without the authorisation of the international organisation concerned, unless it appears to the Comptroller that the use of the emblem, abbreviation or name in the manner proposed -

(a) is not such as suggests to the public that a connection exists between the organisation and the trademark; or

(b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this article relative to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this article the authorisation of an international organisation is or would be required for the registration of a trademark, that organisation is entitled to restrain any use of the mark in Malta without its authorisation.

(5) Nothing in this article affects the right of a person whose *bona fide* use of the trademark in question began before 1st January 2000.

Notification under Article 6*ter* of the Convention.

129. (1) For the purposes of article 127 State emblems of a Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that –

(a) the country in question has notified Malta in accordance with Article 6*ter* (3) of the Convention that it desires to protect that emblem, sign or hallmark;

(b) the notification remains in force; and

(c) Malta has not objected to it in accordance with Article 6*ter* (4) or any such objection has been withdrawn.

(2) For the purposes of article 128 the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that -

(a) the organisation in question has notified Malta in accordance with Article 6*ter* (3) of the Convention that it desires to protect that emblem, abbreviation or name;

(b) the notification remains in force; and

(c) Malta has not objected to it in accordance with Article 6*ter* (4) or any such objection has been withdrawn.

(3) Notification under Article 6*ter* (3) of the Paris Convention shall have effect only in relation to applications for registration made more than two months after the receipt of the notification.

(4) The Comptroller shall keep and make available for public inspection by any person, as prescribed in the regulations, a list of the state emblems and official signs or hallmarks, and the emblems, abbreviations and names of international organisations, which are for the time being protected under the Paris Convention by virtue of notification under Article 6*ter* (3).

Acts of agent or representative: Article 6*septies*.

130. (1) The following provisions apply where an application for registration of a trademark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2) The proprietor may by sworn application before the First Hall of the Civil Court -

(i) demand a declaration of invalidity of the registration; or

(ii) demand the rectification of the register so as to substitute his name as the proprietor of the registered trademark.

(3) The proprietor may restrain any use of the trademark in Malta which is not authorised by him.

(4) Sub-articles (2) and (3) shall not apply if, or to the extent that, the agent or representative shows that his actions were authorised by the proprietor.

(5) An application under sub-article (2) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under sub-article (3) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

SECTION 2

The Madrid System for the International Registration of Trademarks

The Madrid Protocol.

131. In this Part –

"basic application" means an application for registration of a mark, filed with the Comptroller under this Act, and which is used as a basis for the filing of an international application under the Madrid Protocol;

"basic registration" means a mark registered by the Comptroller under this Act, and which is used as the basis for the filing of an international application under the Madrid Protocol;

"Common Regulations" means the Common Regulations under the Madrid Agreement and Madrid Protocol;

"international application" means an application to obtain registration of a mark under the Madrid Protocol;

"the International Bureau" means the International Bureau of the World Intellectual Property Organisation;

"international trademark (Malta)" means a trademark which is entitled to protection in Malta under that Protocol;

"International Register" means the official collection of data concerning international registrations of marks maintained by the International Bureau;

"Madrid agreement" means the Madrid Agreement concerning the international Registration of Marks of April 14, 1891;

"the Madrid Protocol" means the Protocol relating to the Madrid

Agreement concerning the International Registration of Marks adopted at Madrid on 27 June, 1989.

Power to make provision giving effect to Madrid Protocol.

132. (1) The Minister may by Order make such provisions as may be necessary for giving effect in Malta to the provisions of the Madrid Protocol or any other regional or international registration systems concerning trademarks and without prejudice to the generality of the foregoing.

(2) The Order may, in particular, be made with respect to -

(a) the making of applications for international registrations by way of the Industrial Property Office as the Office of origin;

(b) the procedures to be followed where the basic Malta application or registration fails or ceases to be in force;

(c) the procedures to be followed where the Industrial Property Office receives from the International Bureau a request for extension of protection to Malta;

(d) the effects of a successful request for extension of protection to Malta;

(e) the transformation of an application for an international registration or an international registration into a national application for registration;

(f) the communication of information to the International Bureau;

(g) the payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals.

Infringements; criminal provisions

(3) Without prejudice to the generality of sub-article (1), provision may be made by regulations under this article applying in relation to "an international trademark (Malta)" the provisions of article 25 and of articles 108 to 122.

PART VIII - TRANSITORY PROVISIONS

Interpretation.

133. (1) In this Part -

"existing registered mark" means a trademark, registered under the Ordinance and under the Trademarks Act immediately before the commencement of this Act; Cap. 416.

"former register" means the register kept under the Trademarks Act; Cap. 416.

"new register" means the register kept under this Act.

(2) For the purposes of this Part -

(a) an application shall be treated as pending on the commencement of this Act if it was made but not finally determined before commencement; and

(b) the date on which it was made shall be taken to be the date of filing under the Trademarks Act. Cap. 416.

134. (1) Existing registered marks shall, on the commencement of this Act, be transferred to the new register and subject to the provisions of this Part, shall have effect as if they were registered under this Act. Existing registered marks.

(2) Existing registered marks registered as a series under article 91(2) and (3) of the Ordinance and which are still valid before the coming into force of this Act, shall be similarly registered in the new register.

135. (1) Proceedings which are pending on the commencement of this Act shall be dealt with under the legislation under which they were instituted and any necessary alteration pursuant to such proceedings shall be made to the new register. Proceedings under the old law.

(2) A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall be transferred to the new register and have effect as if entered on the register in pursuance of article 18.

136. (1) Upon the coming into force of this Act, articles 12 to 17 shall apply in relation to an existing registered mark and subject to sub-article (2) hereof, article 19 shall apply in relation to any infringement of an existing registered mark committed after the commencement of this Act. Effects of registration infringement.

(2) After the coming into force of this Act, it shall not be an infringement of an existing registered mark to continue with any use which did not amount to infringement of the existing registered trademark under the Ordinance and under the Trademarks Act. Cap. 416.

Infringing goods, material or articles.

137. Article 21 shall apply to infringing goods, material or articles whether made before or after the commencement of this Act.

Rights and remedies of licensee or authorised user.

138. Article 41 shall also apply to licences granted and to infringements committed before the commencement of this Act.

Applicability of article 34 regarding assignment. Cap. 416.

139. The obligations under article 34 shall apply to transactions and events occurring after the commencement of the Trademarks Act in relation to an existing registered trademark and the Ordinance shall continue to apply in relation to transactions and events which occurred before the commencement of said Act.

Applicability of articles 39 and 40 (2) regarding licensing. Cap. 416

140. Articles 39 and 40(2) shall apply only in relation to licences granted after the commencement of the Trademarks Act.

Pending applications for registration. Cap. 416

141. (1) An application for registration of a mark under the Trademarks Act which is pending on the commencement of this Act shall be dealt with under the Trademarks Act subject to the other provisions of this article, and, when registered, the mark shall be treated for the purposes of this Part as an existing registered mark.

(2) The power of the Minister under article 101 to make rules regulating practice and procedure, and in relation to the matters mentioned in sub-article (2) of that article, is exercisable in relation to such an application; and different provision may be made for such applications from that made for other applications.

Conversion of pending application.

142. (1) In the case of a pending application for registration for which the applicant or his representative has not received any communication from the Office relating to the registrability of the application before the commencement of this Act, the applicant may give notice to the Comptroller claiming to have the registrability of the mark determined in accordance with the provisions of this Act.

(2) The notice must be in the prescribed form, be accompanied by the appropriate fee and be given no later than six months after the commencement of this Act.

(3) Notice duly given shall be irrevocable and shall have the effect that the application shall be treated as if made immediately after the commencement of this Act.

Repeal and Savings. Cap. 416.

143. (1) The Trademarks Act, hereinafter referred to as "the repealed Act", is hereby repealed, and any references in any law to the repealed Act shall be construed as references to this Act.

(2) Notwithstanding the provisions of sub-article (1):

(a) the repealed Act shall remain in force for the purpose of any act, decision, action or proceedings taken in respect of any breach of the repealed Act that occurred or were instituted prior to the coming into force of this Act; and

(b) any subsidiary legislation made under the provisions of the repealed Act shall, until other provision is made under or by virtue of this Act, continue in force and have effect as if it was made under this Act.

Passed by the House of Representatives at Sitting No. 215 of the 3rd April, 2019.

ANĠLU FARRUGIA
Speaker

RAYMOND SCICLUNA
Clerk of the House of Representatives

VERŻJONI ELETTRONIKA

Ippubblikat mid-Dipartiment tal-Informazzjoni (doi.gov.mt) — Valletta — ***Published by the Department of Information (doi.gov.mt) — Valletta***
Mitbugħ fl-Istamperija tal-Gvern fuq karta FSC® — ***Printed at the Government Printing Press on FSC® certified paper***

Prezz/*Price*
€5.76