



CHETCUTI CAUCHI
ADVOCATES

DESIGNS

MALTA INTELLECTUAL PROPERTY INFORMATION SHEETS



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DESIGNS REGISTRATION IN MALTA

BACKGROUND

The protection of intellectual property in Malta includes trademark, patent and designs protection. The protection of such and similar intangible assets is no means any recent phenomenon. Evidence of this can be traced back to 1899 with pieces of legislation such as the Industrial Property (Protection) Ordinance (1899) and the Commercial Code.

Until a few years ago, designs were protected through this Ordinance. It was only in June 2002 that detailed legislation was promulgated to provide us with a sound basis in the protection of designs and models of manufacture.¹ This legislation was upgraded to conform the IP protection standards imposed by the EU and the entire *acquis communautaire*.

DEFINITION

The Act defines “designs” as the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and, or materials of the product itself and, or its ornamentation.

REQUIREMENTS FOR PROTECTION

The Act provides that designs shall be protected by registration, by means of which exclusive rights shall be conferred upon their holders.

COMPLEX PRODUCT

A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter, and
- (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

NOVELTY & INDIVIDUALITY

Two of the *sine qua non* characteristics of design registration are novelty and individuality.



A design is considered to be new if no identical design has been made available to the public before the date of filing of the application for registration or, if priority is claimed, before the date of priority.

A design is considered to have individual character if the overall impression it has on the informed user differs from the overall impression produced by any other design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, before the priority date.

¹ Chapter 147, The Patents and Designs Act, as amended by Act IX of 2003.



DISCLOSURE

A design is considered as having been made available to the public if it has been published, exhibited, used in trade or otherwise disclosed, unless it can be shown that the design could have reasonably become known, before the filing date or where priority is claimed, before the priority date, in the normal course of business to the circles specialised in the sector concerned.



NON-REGISTRABLE DESIGNS

A design right cannot be obtained for:

- ▶ features of appearance of a product which are solely dictated by its technical function;
- ▶ features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to allow the product, in which the design is incorporated or to which the design is applied, to function;
- ▶ a design serving the purpose of allowing multiple assembly or connection of multiple interchangeable products within a modular system;
- ▶ a design which is contrary to public policy or accepted principles of morality;
- ▶ a design which consists of the national flag of Malta, or contains Presidential or Episcopal arms or principal armorial bearings or representation of flags.

SCOPE OF PROTECTION

The protection of a design right extends to any design which does not give a different overall impression on the informed user.

TERM OF PROTECTION

A design right is protected for a period of five years from the date of filing of the application and is renewable for one or more periods of five years each up to a total term of 25 years.

RENEWAL OF REGISTRATION

The registration of a design may be renewed at the request of the proprietor, accompanied by the prescribed fee. A late renewal can be effected up to six months after the date of expiry. If the registration is not renewed it shall be removed from the register.

EXCLUSIVE RIGHTS CONFERRED BY THE DESIGN RIGHT

The registration of a design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The rights of the proprietor have effect from the date of registration but no infringement proceedings may be initiated before the date on which the design is in fact registered.

EXHAUSTION OF RIGHTS

The proprietor of a registered design is not entitled to prohibit the use of a product in which the design is incorporated or to which the design is applied when the product has been put on the market by the proprietor or with his consent.

TRANSMISSION OF A REGISTERED DESIGN

A registered design is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property. A transmission may be partial and limited so that the use of the design applies in a particular manner or a particular locality. Such transmissions are to be recorded in Malta.



THE REGISTRATION PROCESS

Upon filing of the applicable application, the official date of filing would be the date of submission of the completed application form to the Office.

In order to claim priority of another application in a Convention Country, one is to file the Maltese application within 6 months from the date of first filing.

EXAMINATION OF APPLICATION

The Comptroller shall examine the application in order to ascertain that it complies with the requirements of the law. If any of these requirements are missing the Comptroller will inform the applicant and invite him to make the necessary amendments. If the necessary amendments are not made the Comptroller shall refuse the application.

WITHDRAWAL OR AMENDMENT OF APPLICATION

The applicant may withdraw his application at any time. An application may be amended only in so far as the amendment relates to corrections of the name and address of the applicant, errors of wording and obvious mistakes. Such a correction should not substantially affect the identity of the design.

REGISTRATION

On the registration of a design the registration certificate shall be issued and a notice shall be published in the Government Gazette stating that the design has been registered and that it is available to be viewed by the public at the Office.

GROUND FOR INVALIDITY OF REGISTRATION

The registration of a design may be declared invalid on the grounds that it is not novel, it does not have individual character or it has been disclosed or in any way made available to the public.

EFFECT OF ACQUIESCENCE

An action for invalidity may not be initiated when the person bringing action is aware of the use of the registered design in Malta and has acquiesced for a continuous period of five years to such use.

ACTION FOR INFRINGEMENT

Infringement proceedings shall be brought before the Civil Court, First Hall and shall not be instituted after five years from the date when the injured party has obtained knowledge of the infringement and of the identity of the alleged infringer.



CONVENTIONS AND TREATIES

Malta is a member of:

- the World Intellectual Property Organization;
- Paris Convention for the Protection of Industrial Property;
- the Berne Convention for the Protection of Literary and Artistic Works; and
- the World Trade Organisation Agreement.

Malta implemented the pertinent provisions of the WTO Trade-related Aspects of Intellectual Property Rights (TRIPS) in the year 2000.

The necessary action is also being taken to secure Malta's accession to the:

- Protocol to the Madrid Agreement on the International Registration of Marks;
- Hague Agreement on the International Registration of Designs.



CHETCUTI CAUCHI
ADVOCATES

OUR IP SERVICES



- General intellectual property consultancy;
- handling applications for trademarks, designs and patents registration and checking registrability of same;
- identical/similar searches;
- checking and forwarding the certificates of registration;
- assignments of trademarks, designs and patents;
- recordal of licensing of trademarks, designs and patents and licensing agreements;
- filing of application for renewal of trademarks, designs and patents;
- providing extracts from the official register;
- filing request for change of proprietor and change of address;
- out of office meetings and meetings with the Registrar in relation to the IP matter;
- filing of restoration of IP rights;
- handling of copyright infringement matters
- domain name registration and dispute resolution
- information technology consultancy and drafting of related agreements;
- franchise advice and agreements
- dispute resolution;
- other ancillary services in relation to IP rights in Malta.

OTHER SERVICES OFFERED BY OUR
FIRM

Commercial & Corporate

- General corporate advice
- Company search
- Company incorporation and registration
- Back Office Administration

Tax Consultancy Services

- Local & International tax compliance & consultancy
- Expatriate taxation services
- Property taxation
- Taxation of savings/offshore investment

Property Law and Consultancy Services

- Advice on purchasing renting/property in Malta
- Immigration services

Licensing

- E-Gaming Licenses
- Licenses associated with pharmaceutical products and market authorisation of same
- Insurance Licenses, including captive insurance

Shipping

- Registration of ships under the Maltese flag;
- Ship finance
- Any other ancillary services



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