



CHETCUTI CAUCHI
ADVOCATES

TRADEMARK REGISTRATION

MALTA
INTELLECTUAL PROPERTY
INFORMATION SHEETS



The Cross of Malta – The Trademark of the Maltese Islands



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BACKGROUND

TRADEMARK LAW IN MALTA

The protection of trademarks in Malta is by no means any recent phenomenon. The Maltese legislator has felt the need to extend some form of specific protection over trademarks since 1899. For over a century, practitioners and businesses have relied on two specific pieces of legislation: the Industrial Property (Protection) Ordinance (1899) and the Commercial Code.

These two pieces of legislation covered both registered and non-registered marks in the sense that the IPPO protected marks which are officially registered and the Commercial Code provided protection to non-registered marks, under the title "Limits of Competition".

These laws were amended several times over the decades but nonetheless, recently it was felt that the varying needs and requirements of the business community necessitated a total re-haul of the relevant legislation. The Trademarks Act (Act XVI of 2000) was the result of this need. This new Act came into force on 1 January 2001.

MALTA AND INTERNATIONAL TM PROTECTION

It is to be noted that due to Malta's imminent accession to the EU accession, the new legislation is compliant not only to the TRIPS Agreement but is also in line with the *Acquis Communautaire*. In fact, the new Trademarks Act embraces the framework provisions of Council Directive 89/104 and also provides for the issue of regulations for the extension of the Community Trademark regime to Malta.

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 Caravaggio' by Mattia Preti – St John's Cathedral, Malta

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.

TRADEMARK PROTECTION

The Trademark Act provides for the registration of service marks, name marks and shape marks. It also provides for trademark licensing, the protection of well-known marks, collective¹ and certification marks.²

¹ A mark distinguishing the goods or services of members of an association from those of other undertakings.

² A mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.



DEFINITION



The Trademarks Act defines a trademark as any sign capable of being represented graphically which distinguishes goods and services of one undertaking from those of another. Such trademark may be comprised of words (including personal names), figurative elements, letters, numerals or the shape of goods or their packaging (get up).

When a trademark is registered, the proprietor acquires exclusive property rights on the trademark.

TERM OF REGISTRATION

A trademark is registered for a ten-year period, which period is thereafter renewable for further ten-year terms.

CLASSIFICATION

In Malta, multiclass applications are not admitted and applications for the registration of a trademark in respect of different goods and services must be made in a different application for each category.

Goods and services are classified by the office according to the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement.

PRIORITY CLAIMS

Under the new Trademarks Act, a person who has filed an application for protection of a trademark in a country, which is a member of the World Trade Organisation or a member of the Paris Convention

for the Protection of Industrial Property, or his successor in title, has the right to claim priority in registering the same trademark for any or all of the same goods or services for which the application has been filed. Such claim to priority is applicable for a period of **six months from the date of filing of the first application.**

THE APPLICATION

The appropriate form for an application for the registration of a trademark must be filed at the Industrial Property Office. The form should contain, *inter alia*, the following:

- the name and address of the applicant;
- a statement of the goods or services in relation to which it is sought to register the trademark;
- a representation of the mark;
- the name and address of the representative or attorney;
- a declaration claiming priority in cases where the applicant wishes to take advantage of an earlier application;
- an indication that the trademark is being used by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be used;
- a statement containing the name or names of the colour or colours being claimed in cases where the applicant wishes to claim colour as a distinctive feature of the mark; and
- the prescribed fee.

THE APPLICATION PROCESS

After the filing of the application, the Comptroller examines whether the application for registration of a trademark satisfies the requirements of the Trademarks ACT XVI of 2000. This entails an exhaustive search of earlier trademarks. The process usually takes around six months.

USE

The new Trademarks Act has amended the application form for the registration of trademarks



and/or service marks. A section has been introduced which stipulates that the trademark or service mark applied for is being used by the applicant or with his/her consent, in relation to the goods or services stated in the respective application, or that there is a bona fide intention that the mark will be used.

One of the grounds for which revocation of the TM may take place is non-use of the TM within the period of five years following the date of completion of the registration procedure or suspension of such use for an uninterrupted period of five years, and there are no proper reasons for such non-use.

AMENDMENT/ ALTERATION OF AN APPLICATION

Once an application is accepted, such application may be amended at a fee at the request of the applicant. The following corrections may be carried out:

- the name or address of applicant
- errors of wording or of copying, or
- obvious mistakes.

Corrections may only be carried out if they do not substantially affect the identity of the trademark or extend the goods or services covered by the application.

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

Nevertheless, the Comptroller may, at the request of the proprietor, allow 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.

APPEAL

A decision of the Comptroller may be appealed from, before the Court of Appeal. "Decision" means

any act done by the Comptroller in exercise of a discretion vested in him, excluding those acts that may be prescribed by the regulations.



If a person is found to have infringed a registered trademark, the proprietor of the registered trademark may file a writ of summons in the First Hall of the Civil Court. If subsequently, it is found that such person has infringed a registered trademark, the court may make an order requiring him:

- to cause the offending sign to be erased, or removed from any infringing goods, material or articles in his possession, custody or control; or
- to secure destruction of the infringing goods, material or articles in question.

The Court may also order that such goods, material or articles be delivered to such person for erasure, or removal or for destruction as the case may be, if it appears to the court that such an order would not be complied with.

TRANSMISSION OF A TRADE MARK TO THIRD PARTIES

A registered trademark may be transmitted to third parties by:

- Assignment
- Testamentary disposition
- By operation of the law, in the same way as other personal or movable property

This transmission can be effected together with the transfer of the goodwill of the business or independently.

An assignment or transmission of a registered trademark may be partial or limited. This means that it can be applicable to:

- some but not all of the goods or services for which the trademark is registered;



- the use of the trademark in a particular manner or a particular locality.

An assignment of a registered trademark is not effective unless it is in writing signed by the assignor or on behalf of the assignor by a personal representative.

LICENSING OF A TRADEMARK

If a Trademark is registered in Malta, in the case of a subsequent grant of a licence to use such registered trademark, recordal at the Maltese Industrial Property Office has to be duly carried out.

Under Maltese law, such licensing may be general or limited, and it may be exclusive or non-exclusive.

A limited licence may in particular, apply in relation to some but not all the goods or services for which the trademark is registered, or in relation to use of the trademark in a particular manner or a particular locality. On the other hand, a general licence excludes any of these subject-matter or location limitations. The licence is binding on a successor in title to the grantor's interest, unless the licence provides otherwise. Where the licence so provides, the licensee may grant a sub-licence.

An exclusive licence refers to 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. Again, 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.

TRADEMARK CO-OWNERSHIP

Two or more persons can jointly own a registered trademark. If this is the case, then each of them would be entitled to an equal undivided share in the registered trademark, as the case may be.

However, in the case of co-ownership, a co-proprietor has limited rights over the trademark. He may not:

- grant a license to use the registered trademark;
- assign or give up control of his share in the registered trademark;

without the consent of the other co-proprietor/s.



Grandmasters' Palace in Valletta



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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