

INDUSTRIAL PROPERTY (PROTECTION) ORDINANCE

CHAPTER 29

To amend and consolidate the laws relating to patents and to make provision relating to designs and models of manufacture, trade marks and manufacture and trade descriptions.

(1st January, 1900) *

Enacted by ORDINANCE XI of 1899, as amended by Ordinances: XVI of 1903, VII of 1907; Act II of 1928; Ordinances: III of 1934, XXXI of 1937, VIII of 1939, XL of 1940; Acts: XX of 1948, IX of 1952; Ordinances: XVI and XIX of 1960; Legal Notices: 2 of 1963, 46 of 1965; Acts: IV and XXXI of 1966, VI of 1967, VII of 1970, LVIII of 1974; Legal Notice 148 of 1975; Acts: XXII of 1976, XI of 1977, IX of 1982, XIII of 1983, XI of 1986; Legal Notices: 29 of 1986, 34 of 1988; Acts: VIII of 1990, XXIV of 1993 and XIX of 1997; and Legal Notices 108 of 1997 and 140 of 1998.

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Short title.

1. This Ordinance may be cited as the Industrial Property (Protection) Ordinance.

PART I PATENTS

Title I RIGHTS OF INVENTORS

Patent for new industrial invention or discovery.

2. (1) The author of a new industrial invention or discovery shall have the exclusive right of working the same for his own profit, during the time, within the limits and under the conditions prescribed in this Ordinance.

(2) This exclusive right constitutes a patent.

What constitutes a new invention or discovery.

3. (1) The following shall be deemed to be new inventions or discoveries:

(a) the invention of a new industrial process or result;

(b) the invention of new methods, or the new application of known methods, for obtaining an industrial result or process.

(2) Every modification of an invention or discovery, for which a patent is still in force, gives a claim to a further patent, without prejudice to the patent existing in respect of the original invention.

Inventions or discoveries which are not patentable.

4. The following are not patentable:

- (a) inventions or discoveries relating to trades which are contrary to law, morals, or public safety;
- (b) inventions or discoveries the subject whereof is not the production of corporeal substances;
- (c) inventions or discoveries which are purely theoretical;
- (d) schemes and combinations relating to credit or finance.

International arrangements with other countries for the mutual protection of inventions.
Amended by: VII.1907.1; XI.1977.2.

5. (1) Any person who has applied for the protection of an invention in any country with which Malta has made an arrangement for mutual protection of inventions, shall be entitled to a patent for his invention in Malta under this Ordinance, in priority to other applicants:

Provided that

- (a) the application for a patent in Malta is made within twelve months from the date of his application for protection in such country;
 - (b) nothing in this section contained shall entitle the patentee to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification.
- (2) The publication in Malta, during the period aforesaid, of any description of the invention, or the use of the invention in Malta during such period, shall not invalidate the patent which may be granted for the invention.
- (3) The application for the grant of a patent under this section must be made in the same manner as an ordinary application under this Ordinance:

Provided that an application under this section shall be accompanied by a complete specification.

Countries with which an arrangement has been made. Substituted by: XI.1977.2.

6. The Minister responsible for trade, with the concurrence of the Minister responsible for foreign affairs, may by order specify the countries with which any arrangement as is referred to in section 5 has been made.

Title II

FORMALITIES RELATING TO THE GRANT OF PATENTS

Application for patent to whom made. Amended by: IV.1966.2.

7. Any person desiring to obtain a patent shall present an application in writing at the office of the Comptroller of Industrial Property, designs and models of manufacture, trade marks, and manufacture and trade descriptions, who in this Ordinance shall be referred to as the Comptroller.

Contents of application.

8. Any such application shall be filed by the inventor or his special attorney, and must contain -

(a)

the name, surname, nationality, and place of residence of the applicant and of his attorney, if any;

(b)

a declaration to the effect that the person making the application or in whose name the application is made, or, in the case of a joint application, that one or more of the applicants is or are in possession of an invention or discovery, whereof he or they claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent.

Application by two persons or more.

9. Where the application for a patent is made by two or more persons jointly, a patent may be granted to them jointly.

Documents to be produced with application. Amended by: XX.1948.2; XXXI.1966.2; LVIII.1974.68 .

10. The said application shall be accompanied by

(a)

two copies of a specification, which may be either a provisional or a complete specification;

(b)

the fee payable under this Ordinance on the filing of an application for a patent;

(c)

the original title, or an office copy thereof, showing the grant of the foreign patent whenever the patent is claimed under section 5 ;

(d)

if there be an attorney, the power, in public or private form, provided that, in the latter case, the signature of the principal be attested by the diplomatic or consular representative of the Government of Malta in that country or by a person serving in a diplomatic, consular or other foreign service of any country which, by arrangement with the Government of Malta, has undertaken to represent that Government's interests in that country, or by a person authorised in that behalf by the President of Malta, or, in the absence of such persons, by the competent government or municipal officer of the district in which the principal resides;

(e)

a list of the papers and articles produced.

Provisional and complete specification.

11. (1) A provisional specification must describe the nature of the invention or discovery and its object, and be accompanied by drawings, if such drawings are necessary to explain it.

(2)

A complete specification must particularly describe and ascertain the nature of the invention or discovery and the manner in which the same is to be performed, and contain an indication of its object.

(3)

A specification, whether provisional or complete, must commence with an indication of the title of the invention or discovery claimed, and in the case of a complete specification, must end with a detailed statement of the nature of such invention or discovery.

Time for the production of the complete specification is not filed with the application.
Amended by: VII.1907.2.

12. (1) If a complete specification is not produced with the application for a patent, it may be produced within nine months from the date of the filing of the application, or within such extended time, not exceeding one month, as the Comptroller may, on application and on payment of the fee prescribed in Schedule A hereto, allow:

Provided that an application for an extension of time for producing a complete specification shall set out in detail the circumstances in which and the grounds on which such extension is required.

(2) In default of the production of a complete specification within the said time, the application for a patent shall be deemed to be abandoned.

Several patents or a single patent for different inventions cannot be demanded by the same application.

13. It shall in no case be lawful for any person to demand by one and the same application several patents, or a single patent for different inventions or discoveries.

Powers of Comptroller.

14. If the Comptroller is of opinion that the nature of the invention or discovery has not been fairly described, or that the application, specifications, or drawings has not or have not been prepared in the manner prescribed in the preceding sections, he may order the applicant, in writing, to amend the application, specifications, or drawings in the manner to be stated in the order, before he proceeds with the application.

Further powers of Comptroller.

15. If a complete specification has been filed after the production of a provisional specification, and the Comptroller is of opinion that the complete specification has not been prepared in the manner prescribed in the preceding sections or that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification, he may also order the applicant, in writing, to amend the complete specification in the manner to be stated in the order.

Filing of additional applications.

16. If, after an application for a patent has been filed but before such patent has been issued, another application or other applications is or are made, accompanied by a specification bearing the same title as the previous one or a title similar thereto, it shall be lawful for the Comptroller, if it appears to him that the invention described in such specification is comprised in the previous application, to refuse, in writing, to issue a patent to the second or subsequent applicant.

Appeal from order of Comptroller. Amended by: IV.1966.3; L.N. 148 of 1975; XI.1977.2.

17. (1) An appeal to the Court of Appeal may be entered by the applicant against any order of the Comptroller under the last three preceding sections.

(2) Such appeal shall be by application to be filed within two months from the receipt by the applicant of the order of the Comptroller.

Cap. 12.

(3) The Court of Appeal may, in regard to costs, make an order in accordance with the provisions of section 223 of the Code of Organization and Civil Procedure.

Preservation of copies of specifications. Amended by: IV.1966.4.

18. A copy of every specification shall be kept in the Comptroller's Office.

Acceptance of complete specification. Amended by: XIX. 1997.2.

19. (1) As soon as the complete specification is accepted, or, in case of appeal, as soon as it is declared by the court to be acceptable, the Comptroller shall advertise the acceptance by means of a notice in the Gazette or such other official publication as the Minister responsible for trade may by notice in the Gazette prescribe.

(2) The notice shall also contain an intimation that, on the expiration of two months, in default of lawful opposition, the patent referred to in the notice shall be granted.

Opposition to grant of patent.

20. During the time stated in the last preceding section, any person may give notice at the Office of the Comptroller, of opposition to the grant of the patent on any of the following grounds:

(a)

that the applicant obtained the invention or discovery from him or from a person of whom he is the legal representative; or

(b)

that a patent had previously been granted in Malta for the same invention or discovery;

but on no other ground.

How made.

21. Such opposition shall be made in writing, and a copy thereof shall be communicated to the applicant for the patent.

Comptroller shall decide whether there be grounds for the opposition.

22. On the expiration of the time stated in section 19, the Comptroller shall decide whether there be ground for the opposition, and shall communicate his decision to the parties concerned.

Appeal.

23. (1) The party against whom the decision is given, may enter an appeal therefrom in accordance with the provisions of subsections (1) and (2) of section 17 .

(2) The provisions of subsection (3) of that section shall also apply to such appeal.

Definitive approval of application. Amended by: L.N. 2 of 1963; XI.1977.2.

24. If there is no opposition, or if the opposition is finally rejected, the Comptroller shall definitively approve the application for the grant of a patent and shall make a report of his approval to the Minister responsible for trade, who, on receipt of such report, will grant the patent.

Time within which approval is to be given.

25. The approval referred to in the last preceding section shall be given as soon as may be, and not later than three months from the filing of the complete specification, except in the cases hereinafter mentioned, that is to say

(a)

if such approval is delayed by the proceedings referred to in section 17 or section 23 , it shall be given not later than three months from the decision;

(b)

if the person making the application dies before the expiration of the said three months, the approval shall be given not later than one year from the death of the applicant; and in such case, the patent shall be granted to the successors of the deceased according to law.

Publication of patent. Amended by: L.N. 2 of 1963; XI.1977.2.

26. A patent shall be issued under the signature of the Minister responsible for trade, and shall be published by means of a notice in the Government Gazette.

Date of patent. Amended by: XI.1977.2.

27. (1) Every patent shall be dated as of the date of the application for the grant of the same:

More than one application for the same invention.

Provided that where more than one application for a patent for the same invention shall have been made, the grant of a patent on a later application, even though already published, shall not prevent the granting of a patent on an earlier application.

(2) A patent granted under section 5 shall be dated as of the date of the application made in the country concerned.

Use of invention.

28. The applicant shall be entitled to make use of the invention and to publish it during the period between the approval of the application and the publication of the patent by notice in the Government Gazette.

Privileges and rights of applicant.

29. After the acceptance of a complete specification and until the publication of the notice referred to in the last preceding section, the applicant shall have the like privileges and rights as would have been competent to him if the notice had been published on the date of the acceptance of the complete specification.

Damages for infringement of patent.

30. The provisions, however, of the last two preceding sections shall not entitle the patentee to sue for damages for any infringement of the patent occurring before the date of the acceptance of his complete specification.

Duration of patent.

31. The term limited in every patent for the duration thereof shall be fourteen years from its date.

Extension of patent. Amended by: XL.1940.3(1); XX.1948.3; L.N. 2 of 1963; XI.1977.2.

32. (1) A patentee may apply to the Minister responsible for trade for an extension of his patent for a further term.

(2)

The application must be made in writing and must be filed at least six months before the time limited for the expiration of the patent. (3) The application shall be published by a notice in the Government Gazette.

(4)

Any person interested may enter an opposition to such application, provided such opposition is filed in writing, with the Comptroller of Industrial Property, within two months from the date of the notice.

(5)

The said application shall be accompanied by the fee payable under this Ordinance on the filing of an application for an extension of the patent for a further term.

What circumstances are to be considered in the grant of extension of term of patent.

33. In considering an application for an extension of the term of a patent, regard shall be had to the nature and merits of the invention in relation to the public, to the profits made by the patentee, and to all the circumstances of the case.

Opposition to application for extension. Amended by: L.N. 2 of 1963; L.N.148 of 1975; XI.1977.2.

34. In case of opposition to the application for extension, the Minister responsible for trade may direct that the question as to whether the patentee has been adequately remunerated for his invention by the use of the patent be referred by the applicant to the Court of Appeal by writ of summons, in which case the provisions of section 17 shall apply.

Term of extension. Amended by: L.N. 2 of 1963; L.N. 148 of 1975; XI. 1977.2.

35. If from the decision of the Court of Appeal it shall appear, or, in default of opposition it shall be proved to the satisfaction of the Minister responsible for trade, that the patentee has not been adequately remunerated for his invention by the use of the patent, an extension may be granted for a further term not exceeding seven, or, in exceptional cases, fourteen years.

Title III PATENTS OF ADDITION

Modifications of original invention.

36. (1) The author of a patented invention or discovery and any person claiming through or under him, may apply for a patent of addition in respect of every modification made by them in the original invention or discovery.

(2) Such patent of addition extends the effects of the original patent to the modifications which form its subject-matter for the whole term of the original patent.

Provisions applicable to applications for patents of addition.

37. (1) The provisions of sections 7 , 8 and 9 shall apply to an application for a patent of addition.

(2)

The provisions of section 10 shall also apply to any such application but the specification to be annexed thereto shall be a complete specification.

(3)

All other provisions relating to the grant of patents shall extend to such application in so far as they may apply thereto.

Title IV

ASSIGNMENT OF PATENTS

Registration of assignment of patents. Amended by: IV.1966.5.

38. (1) Every assignment of a patent shall be registered in the office of the Comptroller of Industrial Property, and shall be published in the Government Gazette.

(2) An assignment shall not take effect, with respect to third parties, except from the date of registration.

Requirements. Amended by: XX.1948.4; IX.1952.3; IV.1966.6.

39. (1) To effect such registration the person in whose favour the assignment has been made shall, together with the application, present or cause to be presented

(a) a certified copy of the act of assignment:

Provided that where the act of assignment is not drawn up in the Maltese or the English language, the Comptroller of Industrial Property may require the person in whose favour the assignment has been made to produce to the said Comptroller a duly certified translation into the Maltese or the English language of the act of assignment;

(b) if there be an attorney, the power of attorney in any of the forms as provided in paragraph (d) of section 10 .

(2)

The application shall be accompanied by the fee payable under this Ordinance for the registration of an assignment of a patent.

(3)

As soon as the registration is effected, the certified copy of the act of assignment and the certified translation thereof, if any, shall be returned to the applicant.

Publication of assignments. Amended by: IV.1966.7.

40. The publication of an assignment of a patent in the Government Gazette shall consist in the insertion therein of an abstract of the act of assignment, signed by the Comptroller of Industrial Property, containing

(a)

- the name, surname and place of residence of both the assignor and the assignee;
- (b) the rights so assigned;
- (c) the date and nature of the act by which the assignment was made, and, if made by a notarial deed, the name of the notary who received it.

Liability for payment of fees. Amended by: XX.1948.5.

41. If the rights arising from a patent are assigned wholly to a single person, such person shall become liable for the payment of the prescribed fees for the grant of patents; if the assignment is made to several persons collectively; they become liable for such payment jointly and severally; if the said rights are partially assigned to several persons or are partly alienated, the title of transfer cannot be registered unless the payment is made to the Comptroller of a sum equal to the remaining rates of fees for the grant of patents.

Effects of assignment.

42. (1) Any person in whose favour the assignment of a patent has been registered, is entitled to make use of any patent of addition which may be granted to the person making the assignment or to his heirs, or to the persons claiming through or under him.

(2) In like manner, the person making the transfer, his heirs, or persons claiming through or under him, are entitled to make use of any patent of addition which may be granted to the person in whose favour the assignment of a patent has been registered.

Title V

NULLITY AND ANNULMENT OF PATENTS

Proceedings under Title II do not guarantee validity of patent.

43. The investigations and proceedings referred to in Title II shall not be held in any way to guarantee the validity of a patent.

Grounds of nullity of patent.

44. A patent is null and void

- (a) if the invention or discovery is neither new nor industrial;
- (b)

if it concerns one of the inventions or discoveries which, according to section 4 , are not patentable;

(c)

if by the fraud of the person who obtained the patent, the title of the invention or discovery indicates other than its true object;

(d)

if the description annexed to the application for the patent is insufficient or conceals or omits any of the indications necessary for the working of the patented invention or discovery.

Grounds of nullity of patent of addition.

45. The following are also null:

(a)

any patent of addition, if the modification in respect of which such patent was applied for, is not connected with the original invention;

(b)

any extension applied for after the expiration of the term of the patent or after its absolute annulment has been pronounced.

Inventions which have received publicity.

46. No industrial invention or discovery shall be considered as new which, in Malta or abroad, and previously to the application for the patent, had received sufficient publicity to enable the same to be worked.

Provisions as to exhibitions Amended by: L.N. 2 of 1963; XI.1977.2.

47. An inventor or his legal representative shall not forfeit his right to obtain a patent by exhibiting the industrial invention or discovery at an exhibition declared by the Minister responsible for trade to be an industrial or international exhibition, or by publishing any description of the industrial invention or discovery, or by making use of it for the purpose of the exhibition and in the place where the exhibition is held, or by using or suffering other persons to use it elsewhere during the period of the holding of the exhibition, provided that both the following conditions are complied with namely:

(a)

the inventor, before exhibiting the invention or discovery, gives the Comptroller notice of his intention to apply for a patent; and

(b)

the application for a patent is made within six months from the date of the opening of the exhibition.

Forfeiture of patentee's rights.

48. (1) The holder of a patent shall forfeit his rights if he fails to pay the annual fee due in advance within three months from the date on which it becomes due.

(2) Such forfeiture shall be advertised by a notice in the Government Gazette.

Holder of patent may be compelled to assign his rights in certain cases. Amended by: VII.1907.3; L.N. 148 of 1975; XXIV.1995.362.

49. The holder of a patent may be compelled to assign his rights, or to grant to others the use of the patent, for a consideration to be determined by the Civil Court, First Hall, if the invention or discovery to which the patent refers shall not have been worked within three years subsequent to the grant, or if its working is suspended for three consecutive years.

Action for nullity or forfeiture, Amended by: L.N. 148 of 1975; XXIV.1995.362.

50. An action for a declaration of nullity or for the forfeiture of a patent shall be brought before the Civil Court, First Hall, by writ of summons.

may be brought by any person interested,

51. (1) Such action may be brought by any person interested therein.

by Comptroller.

(2) It may also be brought by the Comptroller.

Proceedings.

52. The writ of summons shall in all cases be served on the Comptroller who shall be entitled to be made a party to the action, if he makes an application to that effect.

Appointment of experts.

53. Where in any such action the court deems it necessary to call in the assistance of experts, such experts shall be appointed by the court.

Duties of registrar. Amended by: IV.1966.8.

54. (1) The registrar shall transmit to the Comptroller a copy of every judgment delivered in any such action, within two working days of its delivery.

(2) The Comptroller may, within two days of the receipt of such copy, enter an appeal from the judgment, even though he was not a party to the action before the first court.

Duties of Comptroller. Amended by: IV.1966.9.

55. The operative part of any judgment declaring the nullity or pronouncing the annulment of a patent, shall, by the Comptroller, be entered in a special register, and shall be published by means of a notice in the Government Gazette.

Where patent has been declared null on any of the grounds stated in paragraphs (c) and (d) of s.44.

56. Where a patent has been declared null on any of the grounds stated in paragraphs (c) and

(d) of section 44 , the Comptroller may, on the application of the true inventor, made in accordance with the provisions of this Ordinance, grant to him a patent bearing the same date as the date of the patent so annulled, but the new patent shall cease on the expiration of the term for which the first patent was granted.

Added by: III.1934.1.

Title VI RESTORATION OF PATENTS

Procedure for the restoration of patents which have become void, owing to failure of payment of prescribed fee. Added by: III.1934.2. Amended by: XX.1948.6.

57. (1) Where a patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller for an order for the restoration of the patent.

(2) Every such application shall be accompanied by

- (a) the fee due according to the Schedule annexed hereto restoration of a patent; on an application for the
- (b) a statement of the circumstances which have led to the omission of the payment of the prescribed fee;
- (c) one or more declarations verifying the statement contained in such application.

(3)

If it appears from such statement that the omission of the payment was unintentional and that no undue delay has occurred in the making of the application, the Comptroller shall accept the application and shall advertise the acceptance by means of a notice to be published, at least, three times in the Government Gazette and in another periodical newspaper.

(4)

The notice shall also contain an intimation that, on the expiration of two months, in default of lawful opposition, the patent referred to in the notice shall be restored.

Opposition to restoration. Added by: III.1934.2.

58. At any time within two months from the date of the publication of the first of such notices, any person may make to the Comptroller opposition to the restoration of the patent. Such opposition shall be accompanied by a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks.

Copy of opposition to be transmitted to application. Added by: III.1934.2.

59. A copy of the opposition and of the statement shall be transmitted by the Comptroller to the applicant.

Contestation of opposition. Added by: III. 1934.2.

60. (1) If the applicant is desirous of contesting the opposition, he shall, within fourteen days of the receipt of such copies, or such further time as the Comptroller may allow, file a counter-statement fully setting out the grounds on which he contests the opposition.

Comptroller to decide whether there be ground for opposition.

(2) On the expiration of the time mentioned in subsection (1) of this section, the Comptroller shall decide whether there be ground for the opposition and shall communicate his decision to the parties concerned.

Appeal. Added by: III.1934.2.

61. (1) From such decision the party against whom it is given, may enter an appeal in accordance with the provisions of subsections (1) and (2) of section 17 .

(2) The provisions of subsection (3) of the said section shall also apply to such appeal.

If no opposition is entered. Added by: III.1934.2. Amended by: L.N. 2 of 1963; XI.1977.2.

62. (1) If no opposition to the application is entered or if the opposition is definitely rejected, the Comptroller shall definitively approve the application for the restoration of the patent, and shall report his approval to the Minister responsible for trade, who, on the receipt of such report, will make an order for the restoration of the patent.

(2) The order for the restoration of the patent shall be issued under the signature of the Minister responsible for trade and shall be published by means of a notice in the Government Gazette.

(3) All unpaid annual fees must be paid before the order for restoration is made.

Provisions for the protection of third parties. Added by: III.1934.2.

63. In every order restoring a patent, provisions shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent has been announced as void by notice in the Government Gazette. Such provisions shall restrain the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage

(a)

in respect of any infringement of the patent which shall have taken place after the date on which the patent was announced, by notice in the Government Gazette, to be void and before the date of the order;

(b)

in respect of the use or employment at any time thereafter of any mechanism, machine, machinery, process or operation actually made or carried on within Malta, or of the use, purchase, or sale of any article manufactured or made in infringement of the patent after the date of the said announcement and before the date of the order; provided that such use, purchase, sale or employment is by the person or body corporate by or for whom such machine or machinery or article was bona fide manufactured or made, or such mechanism, machine, machinery, process or operation was bona fide made or carried on, his or their executors, administrators, successors or vendees or his or their assigns respectively;

(c)

in respect of the use, employment, or sale at any time thereafter by any person or body corporate entitled for the time being under the preceding paragraph to use or employ any machine or machinery, mechanism, process, or operation of any improved or additional machine, machinery, mechanism, process or operation or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the patent; provided that the use or employment of any such improved or additional machine, machinery, mechanism, process, or operation shall be limited to the buildings, works or premises existing at the time being or afterwards erected, of the person or body corporate by or for whom such machine, machinery, mechanism, process or operation was made or carried on within the meaning of the preceding paragraph, his or their executors, administrators, successors or assigns.

Compensation. Added by: III. 1934.2.

64. The order shall further provide that if any person within one year after the date thereof makes an application to the court for compensation in respect of money, time or labour expended by the applicant upon the subject-matter of the patent in the bona fide belief that such patent had become and continued to be void, it shall be lawful for the

court after hearing the parties concerned or their agents, to assess the amount of such compensation if in the opinion of the court the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid, and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

PART II DESIGNS AND MODELS OF MANUFACTURE

Author of new design or model of manufacture.

65. The author of a new design or model of manufacture shall be considered the proprietor thereof, unless he executed the work on behalf of another person for good consideration, in which case such person shall be considered the proprietor of the new design or model of manufacture.

Right to demand registration of design or model of manufacture.

66. The proprietor of a new design or model of manufacture may demand and obtain the registration of his design or model of manufacture to the extent and on the conditions hereunder stated.

Effect of registration. Copyright.

67. Such registration gives to the proprietor copyright in the design or model, that is, the exclusive right to reproduce the design or model and to apply such design or model to any of the articles or substances mentioned in the next following section.

Definition of design or model of manufacture.

68. In this Ordinance, design or model of manufacture means any design or model which, by whatever means or process, is applicable to any article of manufacture or to any other substance, natural or artificial, or partly natural and partly artificial, whether the design or model is applicable for the pattern, or for the shape or configuration, or for the ornament thereof.

Copyright on registration -duration -extension. Amended by: XXXI.1937.2; VI.1967.20 .

69. (1) When a design is registered, the registered proprietor of the design shall have copyright in the design during five years from the date of registration.

(2)

If before the expiration of the said five years or within such time (not exceeding three months) as the Comptroller may allow, application for the extension of the period of copyright is made to the Comptroller, the Comptroller shall, on payment of the prescribed

fee, extend the period of copyright for a second period of five years from the expiration of the original period of five years.

(3)

If before the expiration of such second period of five years or within such further time (not exceeding three months) as the Comptroller may allow, application for the extension of the period

of copyright is made to the Comptroller, the Comptroller may, on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years.

Cap. 196.

(4) The provisions of this section shall have effect subject to the provision of subsection (3) of section 3 of the Copyright Act.

Registration of design or model of manufacture obtained elsewhere. Amended by: VII.1907.4; XI.1977.2.

70. (1) Any person who has applied for protection for a design or model of manufacture in any country with which Malta has made an arrangement for mutual protection of designs or models of manufacture, shall be entitled to registration of his design or model under this Ordinance in priority to other applicants; and such registration shall have the same date as the date of the application made in the country concerned:

Provided that

(a)

such application is made within four months from the date of the application for protection in the country with which the arrangement is in force;

(b)

nothing in this section contained shall entitle the proprietor of the design or model of manufacture to recover damages for infringements happening prior to the date of the actual registration of his design or model in Malta.

(2)

The exhibition or use in Malta during the period aforesaid, of the design or model of manufacture, or the publication therein during such period of a description or representation of the design or model shall not invalidate the registration of such design or model of manufacture.

(3)

The application for the registration of a design or model of manufacture under this section, must be made in the same manner as an ordinary application under this Ordinance.

(4)

The provision of section 6 shall apply, mutatis mutandis, to any country with which an arrangement as is referred to in subsection (1) of this section has been made.

Application for registration.

71. An application for the registration of a new design or model of manufacture shall be made to the Comptroller. It shall be signed by the inventor or by his special attorney, and shall contain

(a)

the name, surname, place of birth and residence of the applicant or of his attorney, if any;

(b)

a description of the design or model, showing shortly, but with precision, its main characteristics;

(c)

an indication of the class of articles or substances to which the applicant intends to apply the new design or model.

To be accompanied by certain documents. Amended by: XX.1948.7.

72. Every application shall be accompanied by

(a) the drawings, besides the models which the applicant considers useful for the proper comprehension of his invention;

(b)

the fee due according to the Schedule annexed hereto on the registration of a new design or model;

(c)

if there be an attorney, the power of attorney in any of the forms as provided in paragraph (d) of section 10 ;

(d)

a list of the papers and documents produced.

Tracings and drawings to be furnished on application.

73. The applicant shall furnish to the Comptroller a number of tracings and drawings sufficient, in the opinion of the Comptroller, for enabling him to identify the new design.

Drawings to be in ink or water-colours.

74. (1) The drawings shall be traced by outlines in ink or water-colours, and according to a scale.

(2) The Comptroller may refuse any drawing produced by lithography or photography.

Registration of design or model. Substituted by: IV.1966.10.

75. If the application is allowed by the Comptroller, the new design or model of manufacture shall be registered in the Register of Designs and Models of Manufacture and such registration shall be advertised in the Government Gazette by means of a notice signed by the Comptroller.

Inspection of registered designs or models. Amended by: IV.1966.11.

76. During the existence of copyright in a design or model of manufacture, the design or model shall not be open to inspection except by the proprietor, or his lawful representative, or by a person authorised on good grounds by the Comptroller or by the court, and except in the presence of the Comptroller and on payment of the prescribed fee for inspection:

Provided that where registration of a design or model of manufacture is refused on the ground of identity with a design or model of manufacture already registered, the applicant for registration shall be entitled to inspect the design or model so registered.

Appeal in case of disallowance of application.

77. If the Comptroller does not allow the application, notice of the disallowance shall be given to the applicant who shall be entitled to enter an appeal from the decision of the Comptroller in terms of section 17 .

Articles to which design or model is to be applied shall be marked.

78. Before the delivery or sale of any article to which a registered design or model of manufacture is to be applied, the proprietor of the design or model shall cause such article to be marked with that design or model, or with words or figures denoting that the design or model is registered; and if he fails to do so, the copyright shall cease, unless he shows that he took all proper steps to ensure the marking of the article.

Designs registered before 9th November, 1937. Added by: XXXI.1937.3. Amended by: VIII.1939.3.

79. Nothing in this Part contained shall affect any rights subsisting in a design registered in Malta before the ninth day of November, one thousand nine hundred and thirty-seven.

PART III
TRADE MARKS

Essential particulars of trade mark. Amended by: IV.1966.12.

80. Marks intended to distinguish the produce of any industry or articles of trade are considered to be trade marks, provided they contain at least one of the following particulars:

- (a) a name of an individual or a firm name of a commercial partnership, printed, impressed, or woven in some particular and distinctive manner; or
- (b) a written signature or copy of a written signature of the individual applying for registration thereof as a trade mark;
- (c) a distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use; or
- (d) a word or words having no direct reference to the character or quality of the goods and not being according to the ordinary signification a surname or a geographical name.

Marks and words must be different from others already used by others.

81. (1) The marks and words referred to in the last preceding section must be different from those already legally used by other persons.

(2) There may be added, in a trade mark, to any one or more of the particulars stated in the last preceding section, any words or figures, or combination of words and figures.

Exclusive use of trade mark.

82. Any person may have the exclusive use of a trade mark provided he complies with the provisions of the following sections of this Part.

Application for registration of trade mark. Amended by: XX.1948.8; IV.1966.13.

83. Any person who is desirous of securing for himself the exclusive use of any trade mark, must present to the Comptroller an application in the form annexed hereto, and accompanied by

- (a) two representations of the trade mark;
- (b)

a declaration stating the kind of articles to which it is intended to affix the mark, and whether the mark is to be affixed to articles produced by the declarant, or to goods of his trade;

(c)

a description of the mark;

(d)

the fee prescribed in Schedule B annexed hereto, for registration of trade marks.

Representations of trade mark.

84. The representations of a trade mark shall be made on metallic plates, pieces of strong cardboard, or parchment or similar materials which, in the opinion of the Comptroller, are of a durable nature.

Progressive number on the representations.

85. (1) The Comptroller shall write on the representations of the trade mark a progressive number and the date on which they are deposited; such representations shall moreover be signed by the person depositing them and by the officer receiving them.

(2) If this be impracticable, the said indications shall be made on small pieces of cardboard to be attached to the representations.

Documents presented to be signed by Comptroller.

86. All such documents as are presented for the purpose of registering a trade mark, shall be signed by the Comptroller.

Advertisement of applications. Substituted by: XIX. 1997.3.

87. Every application for registration of a trade mark shall, as soon as may be, be advertised by the Comptroller in the Gazette or such other official publication as the Minister responsible for trade may by notice in the Gazette prescribe.

Opposition to application for registration. Amended by: IV.1966.14; L.N. 148 of 1975; XXIV.1995.362.

88. (1) Any person may, within two months from the publication of the advertisement referred to in the last preceding section, give notice, in duplicate, at the office of the Comptroller, of opposition to the application for registration. Such notice shall contain a statement of the grounds upon which he objects to the registration, and one copy of such notice shall be sent to the applicant with an intimation that he may send a counter-statement in duplicate of his grounds against the opposition.

(2)

If the applicant fails to send such counter-statement within two months from the receipt by him of the said copy of the notice and intimation, his application shall be considered as abandoned; but, if he sends such counter-statement, it shall be communicated to the person who gave notice of opposition.

(3)

The opposition shall be deemed to be withdrawn if, within two months from the receipt by him of such counter-statement, the opponent fails to bring an action, by writ of summons, before the Civil Court, First Hall, demanding that the registration be not granted, and fails to give, together with the writ of summons, sufficient security for the costs of the suit.

Non-completion within twelve months.

89. The application for the registration of a trade mark shall also be deemed to be abandoned, if, by reason of default on the part of the applicant, registration could not be completed within twelve months from the date of the application.

Definitive approval of application.

90. Upon completion of the formalities required by the foregoing provisions, if there has been no opposition in terms of section 88 or if the opposition has been finally rejected, the Comptroller shall definitively approve the application for the grant of a certificate of registration of the trade mark.

Connection of trade mark with goods.

91. (1) A trade mark must be registered for particular goods or classes of goods.

Registration of a series of marks.

(2)

When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of

(a)

the statement of the goods for which they are respectively used or proposed to be used;

or

(b)

statements of numbers; or

(c)

statements of price; or

(d)

statements of quality; or

(e) statements of names of places; seeks to register such trade marks, they may be registered as a series in one registration.

(3)

Each of the trade marks so registered shall, however, be deemed to be registered separately.

Trade mark may be registered in any colour.

92. A trade mark may be registered in any colour, and the proprietor shall be entitled to use it in the colour in which it was registered or in any other colour.

Power of Comptroller.

93. (1) The Comptroller may, on good grounds, refuse to register a trade mark.

(2) In any such case he must communicate his refusal in writing to the applicant who may avail himself of the remedy referred to in section 17 .

Procedure when the application is allowed.

94. If the application is allowed by the Comptroller, the trade mark shall be entered in the Register of Trade Marks as provided in Part V .

Right of proprietor to exclusive use of trade mark.

95. The registration of a person as proprietor of a trade mark shall entitle him to the exclusive use of the mark from the date of the application for registration; but he shall not be entitled to institute any proceedings to recover damages for any infringement of the trade mark occurring before the publication of the certificate of registration in the Government Gazette.

Registration does not guarantee validity of title to trade mark, etc.

96. Registration shall not operate so as to guarantee the reputation of a trade mark or the validity of the title to the trade mark or the excellence or origin of the goods or the existence of the other conditions required for the validity of the certificate of registration.

Right of ownership of marks registered abroad. Amended by: VII.1907.5.

97. The provisions contained in section 70 for the protection of designs or models of manufacture registered abroad shall apply to trade marks.

Rights of successor in business to retain use of trade mark.

98. Where a person claiming under the proprietor of a trade mark, or being his successor in business or trade, intends to retain the use of such mark, he must comply with the provisions contained in Title IV of Part I relating to the assignment of patents in so far as they may be applicable.

Assignment of registered trade mark must include right to trade in the goods.

99. The assignment of a registered trade mark shall not be valid unless such assignment includes also the right to trade in the goods or in the class of goods in respect of which the mark has been registered.

Assignment of marks registered as a series.

100. Notwithstanding the provisions of subsection (3) of section 91 , such marks as are registered as a series, as provided in that section, cannot be assigned separately, but shall be assignable only as a whole.

Forfeiture of right to make use of mark.

101. The proprietor of a registered trade mark shall forfeit his right to the exclusive use thereof, if at the expiration of fourteen years from the date of the registration of the mark, he fails to pay to the Comptroller, within one month, the fee prescribed in Schedule B, provided the Comptroller shall have sent to the proprietor of the mark two notices in writing requiring the payment of the said fee, with an intimation that, in default of payment, the trade mark will be removed from the register: one of such notices must be sent three months, and the other two months, before the expiration of the said term of fourteen years.

Re-registration of cancelled mark.

102. Where a trade mark has been removed from the register, the Comptroller may, on good grounds shown, restore such trade mark to the register on payment by the applicant of the prescribed additional fee.

Status of unrenewed trade mark.

103. Where a trade mark has been removed from the register for non-payment of the fee mentioned in section 101 , such trade mark shall, nevertheless, for the purpose of any application for registration, be deemed to be, during the five years next after the date of such removal, a trade mark which is still registered.

PART IV

INFRINGEMENT OF PATENTS, OF COPYRIGHT IN DESIGNS AND MODELS OF MANUFACTURE, AND OF TRADE MARKS,

AND ACTIONS RELATING THERETO

Title I CIVIL ACTIONS

Infringement of patent. Amended by: II.1928.2; L.N. 148 of 1975; XXII.1976.4.; XIII.1983.5; XXIV.1995.362.

104. Whoever in fraud and contravention of a patent, manufactures any goods, or uses any machine or other industrial means or contrivances, or sells, exposes for sale or has in his possession for sale, or imports into Malta infringing articles, shall be liable, at the suit of the holder of the patent, to be condemned by the Civil Court, First Hall, either to the payment of damages and interest, or to the payment of a fine of not less than ten, nor exceeding five hundred liri, or to the restitution of all the profit derived from the infringement of the patent.

Infringement of copyright in design or model of manufacture. Amended by: XI.1977.2; XIII.1983.5.

105. Whosoever shall, during the existence of copyright in a design or model of manufacture

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- (a) for the purposes of sale apply, without the written consent of the proprietor, the registered design or model of manufacture, or any fraudulent or obvious imitation thereof, to any class of articles or substances of those referred to in section 68;
 - (b) publish or expose for sale any article of manufacture or substances to which such design or model of manufacture or any fraudulent or obvious imitation thereof shall have been applied, knowing that the same has been so applied without the consent of the proprietor;

shall be liable, at the instance of the proprietor of the design or model, to be condemned, by the court referred to in the last preceding section, to pay to the proprietor of the design or model of manufacture, a fine not exceeding fifty liri, or to the payment of damages and interest.

Infringement of registered trade mark. Amended by: II.1928.2; L.N. 148 of 1975; XXIV.1995.362.

106. Whosoever shall commit any act in violation of the rights of any person in whose favour a trade mark has been registered, for which, under the provisions of Title II of this Part, he is liable to criminal proceedings, may, at the instance of the proprietor of the trade mark, be condemned by the Civil Court, First Hall, as provided in section 104 .

Delivery up of infringing articles, etc.

107. The court may, moreover, in each of the cases referred to in the last three preceding sections, on the application of the plaintiff, order that the machinery or other industrial means or contrivances used in contravention of the patent or in contravention of the rights of the proprietor of the design or model of manufacture, or of the trade mark, the infringing articles, and the apparatus destined for their production, be forfeited, wholly or partially, and delivered up to the holder of the patent, copyright or trade mark, without prejudice to the relief mentioned in those sections.

Where infringer acts without malice or fraud.

108. Where the holder of the articles mentioned in the last preceding section has acted without malice or fraud, he shall only be liable to the said forfeiture in favour of the party injured.

How civil action is instituted.

109. The civil action is brought by writ of summons.

Security.

110. If, for the purpose of securing the claim for the forfeiture referred to in section 107, application is made for the issue of a warrant of description or of a garnishee order, or of a warrant of seizure, or for the grant of a prohibitory injunction, the court may, before issuing the said warrant, order or injunction, require the applicant to give security.

Limitation of civil action.

111. Civil actions under this Ordinance 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 Ordinance.

Title II CRIMINAL ACTIONS

Offences.

112. (1) Whoever puts into circulation, or sells any article, falsely representing that it is a patented article, or that the design or model of manufacture, or the trade mark, applied to it, has been registered with reference thereto, shall, on conviction, be liable to a fine (ammenda).

(2) If any person puts into circulation or sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word “patent”, “patented”, “registered”, or any other word expressing or implying that a patent has been obtained for the article, or that the design or model of manufacture, or trade mark is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design, model or mark applied thereto is a registered design, model or mark.

Powers of magistrates.

113. Pending any proceedings, commenced by summons or by the arrest of the accused, 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 Executive 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 section, issue the said warrant.

Forfeiture of things seized. Amended by: VIII.1990.3.

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 Ordinance.

Procedure where owner is unknown.

116. (1) In the case referred to in section 114, the court shall order the issue of banns which shall be published twice, with an interval of at least eight days, in the Government 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 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 trade marks 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 Ordinance 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.

Imported goods. Amended by: XI.1977.2; IX.1982.2.

119. (1) The importation of goods which, if sold, would, under this Ordinance, be liable to forfeiture, and also of all goods manufactured out of Malta, bearing any Maltese name or trade mark or bearing any other name or trade mark, and not showing a definite indication of the country in which such goods were produced, is prohibited.

(2) The provisions of this section shall not be applicable to goods which are landed in Malta to be re-exported.

Forfeiture takes place ipso jure. Amended by: XVI.1960.3.

120. (1) Forfeiture shall take place ipso jure if within one month from the date of the publication of the notice hereunder mentioned, no claim for the goods is made by any person.

(2) Such notice, signed by the Comptroller of Customs, shall be published twice, with an interval of at least fifteen days, in the Government Gazette and in another periodical newspaper, and shall be posted up at the entrance of the Custom House and at the Exchange. It shall indicate the goods subject to forfeiture, and the cause of forfeiture, and shall state that, unless claimed by means of a judicial or other letter addressed to the Comptroller of Customs, within one month from the date of the notice, the goods shall be forfeited.

Application of Attorney General for order for forfeiture. Amended by: L.N. 46 of 1965; LVIII. 1974.68; L.N. 148 of 1975; XXIV.1995.362.

121. If the goods are claimed, the Attorney General shall, with all convenient dispatch, make an application to the Civil Court, First Hall, for an order for the forfeiture of the goods seized.

Powers of Comptroller of Customs and Attorney General. Amended by: XVI.1960.3;

L.N. 46 of 1965; LVIII. 1974.68.

122. The Comptroller of Customs, before refusing to deliver the goods referred to in section 119 , and before proceeding, after the publication of the said notice, to the forfeiture of such goods, and the Attorney General, before instituting the proceedings mentioned in the last preceding section, may require that the provisions of the regulations hereunder named be complied with by the parties concerned, and they shall moreover satisfy themselves, in accordance with those regulations, that such goods are goods the importation whereof is prohibited under this Ordinance.

Power of Minister responsible for trade to make regulations. Amended by: L.N. 2 of 1963; XI. 1977.2.

123. The Minister responsible for trade may make, vary or revoke regulations, either general or special, respecting —

- (a) the seizure and forfeiture of goods the importation of which is prohibited by section 119 ;
- (b) the conditions to be fulfilled before such seizure or forfeiture;
- (c) the information, notices, and security to be given, and the evidence requisite for the purposes of the last preceding section;
- (d) the reimbursement to the Government by the person giving the information on which the said goods were unjustly seized or forfeited, of all expenses and damages incurred in consequence of any such unjust seizure or forfeiture, and of any proceedings consequent on such seizure or forfeiture.

Implied warranty on sale of marked goods.

124. For the purposes of this Ordinance, on the sale of any goods to which a trade mark, or other mark, or trade description has been applied, the vendor shall be deemed to warrant that the trade mark, other mark, or description is genuine and not forged or

falsely applied, unless the contrary is proved by some writing signed by the vendor and delivered, at the time of the sale, to and accepted by the buyer.

Use of forged marks.

125. The provisions of this Title 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 Ordinance, 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 where the goods to which the genuine commercial designation thereof refers were produced, and such name is calculated to mislead as to the place or country where the goods were actually produced, and the goods are not produced in the place or country indicated in the mark of manufacture or description in use, the provisions of this section 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, with that name, 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.

Right to damages not affected.

126. The provisions of this Title shall apply without prejudice to the payment of damages to persons entitled thereto.

Privilege may not be claimed by witness.

127. No person shall be excused from making a complete statement of every fact within his knowledge, nor shall any witness be excused from giving testimony in any proceeding, on the ground that he might become liable to prosecution for any one of the offences mentioned in this Title; but any statement or testimony so made or given, shall not be admissible in evidence against such person in any prosecution for any such offence.

Master and servant.

128. No proceedings shall be instituted against any person in the service of another person residing in Malta, if, in good faith, he has acted in obedience to the instructions of his employer, and, on being questioned by the Police, gives full information as to his employer.

PART V

REGISTER OF PATENTS, DESIGNS AND MODELS OF MANUFACTURE AND TRADE MARKS

Registers to be kept at office of Comptroller of Industrial Property. Amended by:
IV.1966.15 .

129. There shall be kept at the office of the Comptroller of Industrial Property a register of industrial patents, a register of inventions of new designs and models of manufacture, and a register of trade marks.

Contents of registers. Amended by: L.N. 2 of 1963; XI.1977.2.

130. There shall be entered in the respective register the patents issued or the copyrights registered as well as all subsequent modifications, revocations, declarations of nullity, and forfeitures affecting such patents or copyrights, and all other matters the registration whereof is prescribed by the regulations made by the Minister responsible for trade.

Register of assignments. Amended by: IV. 1966.16.

131. There shall also be kept at the office of the Comptroller of Industrial Property a register of assignments of patents, copyrights in designs and models of manufacture and trade marks, and an annotation of any such assignment shall be made against the original entry of the patent or other right so assigned.

Applications to be entered in registers. Substituted by: IV.1966.17.

132. (1) There shall be entered in each of the registers mentioned in section 129 under a progressive number, all applications and documents filed therewith, the name, surname, country,

father's name and place of domicile of the applicant and his attorney, if any, the subject-matter of the application and the date of presentation.

(2)

To the said entries there shall be added

(a)

in the register of industrial patents, the title of the invention for which a patent is claimed;

(b)

in the register of inventions of new designs and models of manufacture, an indication of the design or model of manufacture for which copyright is claimed;

(c)

in the register of trade marks, an indication of the object for which the marks are intended.

Other entries in register of industrial patents. Substituted by: IV.1966.18.

133. In the register of industrial patents, a reference to the specifications which may have been filed shall also be entered.

Column for annotations.

134. In each of the registers referred to in the foregoing sections, a column shall be reserved for any annotations which it may become necessary to enter.

Alphabetical index. Amended by: IV.1966.19.

135. (1) To each of the said registers there shall be an alphabetical index of the surnames and names of the persons whose right or application has been registered.

(2) In the index of the register for assignments, reference shall be made to the progressive number of the general register.

Inspection of and extracts from registers. Amended by: XIX.1960.2; IV.1966.20.

136. Saving the provisions of section 76, the said registers shall be open to the inspection of any person at the office of the Comptroller, and copies of or extracts therefrom as well as copies of or extracts from the specifications kept at the office of the Comptroller, written or printed, signed by the Comptroller of Industrial Property, shall be given to any person requiring the same on payment of the fees prescribed in the annexed Schedules, to be made at the time of the request.

Registers and extracts to be evidence of their contents. Amended by: XIX.1960.3; IV.1966.21.

137. (1) The registers as well as the copies of or extracts from the registers or the specifications kept at the office of the Comptroller, and certificates signed by the Comptroller of Industrial Property, shall, until the contrary is proved, be evidence of their contents.

(2) No proof of their authenticity is required other than that which they bear on the face of them.

Rectification or cancellation of registration. Amended by: II.1928.2; IV.1966.23;

L.N. 148 of 1975: XXIV.1995.362.

138. (1) Any person may bring an action for the rectification or cancellation of any entry made in the register, or for the registration of any act which the Comptroller may have refused to enter.

Proceedings.

(2) Any such action shall be brought before the Civil Court, First Hall, by a writ of summons in which the Comptroller and a curator to be appointed by the court to represent any person who may have an interest in the matter, shall be named as defendants.

Notice in Government Gazette.

139. (1) Fifteen days at least before the trial of the action referred to in the last preceding section, a notice shall, by order of the court, be published in the Government Gazette, calling upon any interested party to declare, by a note, within fifteen days from the publication of the said notice, whether he intends to oppose the demand contained in the writ of summons.

(2) Notice of the day appointed for the trial of the action shall be given to any person who shall, within the said time, have filed any such note.

Applicability of ss.960–962 of Code of Organization and Civil Procedure. Cap. 12.

140. Nothing in the last two preceding sections contained shall be in derogation of the provisions contained in sections 960, 961 and 962 of the Code of Organization and Civil Procedure.

Time within which rectification, etc., is to be made. Amended by: IV.1966.23.

141. (1) Any rectification, cancellation, or registration ordered by the court shall be made by the Comptroller within the time of ten days from the day on which the judgment shall have become a res judicata.

(2) Reference to the judgment shall be made by a note in the margin of the respective register.

(3) A rectification, however, consisting in the correction of an error incurred in transcribing an act in the register may be made by the Comptroller on his own authority.

Procedure where cancellation is requested by proprietor. Added by: XI.1986.2.

141A. (1) Notwithstanding the provisions of section 138 of this Ordinance, the proprietor of a patent, or the proprietor of a design or model of manufacture or the proprietor of a trade mark, may make an application in writing to the Comptroller requesting the cancellation of the respective entry in the relative register, of the patent, design or model of manufacture or trade mark of which he is the proprietor.

(2)

Upon receipt of an application as is referred to in subsection (1) of this section the Comptroller shall publish in the Gazette a notice calling upon any interested party to make a declaration to be filed with the Comptroller within fifteen days from the publication of the said notice, wherein he states his opposition to the cancellation.

(3)

If on the lapse of the fifteen days referred to in subsection (2) of this section the Comptroller shall not have received a declaration objecting to the cancellation he shall make the cancellation in the appropriate register.

(4)

If a declaration as is referred to in subsection (2) of this section shall have been received by the Comptroller within the fifteen days referred to in the said subsection, the Comptroller shall refuse the application and the cancellation may only be made by an action brought against the Comptroller in accordance with sections 138 to 141 of this Ordinance. In any such action the person making the declaration shall also be a defendant.

Copies to be deposited in the Comptroller's office. Amended by: XXII.1976.4.

142. (1) A copy of the description and drawings produced in connection with an application for a patent, or of the designs or models produced in connection with an application for copyright in a new design or model of manufacture, shall be deposited in the Comptroller's office, but such copy shall not be open to inspection except three months after the grant of the patent or copyright, saving the provisions of section 76 .

(2) The models and another copy of the description of the drawings shall be kept in the National Library of Malta or in a place appointed for the purpose by the Government, wherein they shall be open to public inspection after the expiration of the said time.

Copy of marks to be sent to Chamber of Commerce.

143. (1) One of the two representations of the trade mark or other mark which are to be presented to the Comptroller under section 83 shall be kept by him and shall be open to public inspection and the other shall be sent by the Comptroller to the Chamber of Commerce.

(2) Such other representation shall be kept by the Chamber of Commerce and shall be available for public inspection.

Actions other than criminal actions to be tried by Civil Court, First Hall. Added by: II.1928.3. Amended by: L.N. 148 of 1975; XXIV.1995.362.

144. The Civil Court, First Hall, shall be the only competent court to deal with proceedings other than proceedings of a criminal character arising under this Ordinance.

PART VI SPECIAL AND TRANSITORY PROVISIONS

Power of Minister responsible for trade to make regulations. Amended by: L.N. 2 of 1963; XI. 1977.2.

145. The Minister responsible for trade may, from time to time, make regulations relating to such matters as may be necessary in order to carry out the provisions of this Ordinance. Such regulations shall be published by notice in the Government Gazette.

Fees. Amended by: XI. 1986.3.

146. (1) The fees payable to the Government under this Ordinance shall be taxed and levied in accordance with the Schedules annexed hereto.

(2) The Minister responsible for trade may by regulations amend, add to, revoke or substitute all or any of the Schedules annexed to this Ordinance.

Costs of proceedings.

Cap. 12.

147. In any proceedings under this Ordinance the costs shall be taxed and levied according to the tariffs in Schedule A annexed to the Code of Organization and Civil Procedure.

Provisions not applicable to patents granted before commencement of Ordinance.

148. The provisions of this Ordinance concerning the formalities relating to the grant of industrial patents shall not apply to patents (formerly called exclusive rights) granted before the commencement of this Ordinance.

Provisions applicable to former patents.

149. In all other matters (including the amount of fees payable and the time for payment), the provisions of this Ordinance shall apply to patents granted before the commencement of this Ordinance as if such provisions had been in force at the time of the grant.

FORM A

FORM OF PROVISIONAL SPECIFICATION

(a)

I, (b) , of , in the , do hereby declare the nature of my invention for “ ”, to be as follows:-

(c) (d)

Dated this day of 19

FORM B

FORM OF COMPLETE SPECIFICATION

(a)

I, (b) do hereby declare the nature of my invention for and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:- (c)

Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed, I declare that what I claim is (d)

- 1.
- 2.
3. etc.

(e)

Dated this day of 19

FORM C

FORM OF APPLICATION FOR REGISTRATION OF DESIGN

(a)

Here insert title as in declaration.

(b)

Here insert name, address, and calling of inventor, as in declaration.

(c)

Here insert short description of invention.

(d)

Signature of inventor.

(a)

Here insert title as in declaration.

(b)

Here insert name, address, and calling of inventor, as in declaration.

(c)

Here insert full description of invention.

(d)

Here state distinctly the features of novelty claimed.

(e)

Signature of inventor.

day of 19

You are hereby requested to register the accompanying Design, in Class in the name of (a) of who claims to be the proprietor thereof, and to return the same to

Statement of nature of Design

Registration Fees enclosed Lm c m

To the Comptroller of Industrial Property. (Signed)

FORM D

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK

(One representation to be fixed within this square, and two others on separate sheets of foolscap of same size).

(Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto).

You are hereby requested to register the accompanying trade mark, [], in the name of (a) , who claims to be the proprietor thereof.

Registration Fees enclosed Lm c m

To the Comptroller of Industrial Property.

(Signed)

FORM E

BY THE MINISTER RESPONSIBLE FOR TRADE

Amended by: XL.1940.3 (3): L.N. 2 of 1963.

WHEREAS has by his solemn declaration expressed to me that he is in possession of an invention for and that the same is not in use by any other person to the best of knowledge and belief:

WHEREAS the said inventor has applied to me for the grant to of a patent for the sole use and advantage of his said invention:

AND WHEREAS the said inventor has by and in his complete specification particularly described the nature of his invention:

I, NOW, by virtue of the power vested in me by the Industrial Property (Protection) Ordinance, and on the conditions therein set forth, do by these presents give and grant unto the said patentee the

(a)

Here insert legibly the name and address of the individual or firm.

(a)

Here insert legibly the name, address, and business of the individual or firm.

exclusive right to use the said invention and derive all profits therefrom, in Malta, up to and until the lapse of fourteen years from *

PROVIDED THAT this Warrant is held on the condition, that if, any time during the said term, it will be made to appear to me that this our grant is contrary to law, or if the said patent be annulled by a competent court, or if the patentee shall forfeit his right to his patent, this Warrant shall forthwith be determined and be void to all intents and purposes.

Given at the Ministry

this day of

in the Year of OUR

LORD One Thousand Nine Hundred

and

Minister responsible for trade.

Added by: III.1934.4. Amended by: XL. 1940.3(3); L.N. 2 of 1963.

FORM F

IN THE MATTER OF AN APPLICATION BY

FOR THE RESTORATION OF WARRANT NO.

WHEREAS a Warrant bearing date the day of, 19 and numbered was granted to (hereinafter referred to as “the patentee”) for an invention entitled

AND WHEREAS the said Warrant became void on the day of, 19, owing to the omission of the payment of the prescribed renewal fee in respect of the year:

AND WHEREAS the said on the day of, 19, made application for the restoration of the said Warrant:

AND WHEREAS it appears from the said application that the omission to pay the prescribed renewal fee was unintentional, and that no undue delay has occurred in making the said application:

AND WHEREAS the prescribed renewal fee in respect of the now been paid:

I hereby restore the said Warrant and order that it shall be considered, deemed and taken to be, and to have been as good, valid, and effectual to all intents and purposes as if no omission had been made in the payment of the said renewal fee in respect of the year:

PROVIDED THAT no action or other proceeding shall be commenced or prosecuted nor any damage recovered:

(i) in respect of any infringement of the said Warrant which shall have taken place after the

day of , 19 (being the day on which the Warrant was announced as void in the Government Gazette) and before the date of this Order;

* Here insert date of filing of application for grant of patent.

(ii) in respect of the use or employment at any time hereafter of any mechanism, machine, machinery, process, or operation actually made or carried on within Malta or of the use, purchase or sale of any article manufactured or made in infringement of the said Warrant after the said day of , 19 and before the date of this Order. Provided that such use, purchase, sale or employment is by the person or corporation by or for whom such machine or machinery or article was bona fide manufactured or made, or such mechanism, machine, machinery, process or operation was bona fide made or carried on, his or their executors, administrators, successors, or vendees, or his or their assigns respectively;

(iii) in respect of the use, employment or sale at any time hereafter by any person or corporation entitled for the time being under the preceding paragraph to use or employ any machine, machinery, mechanism, process or operation of any improved or additional machine, machinery, mechanism, process, or operation or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the said Warrant; provided that the use or employment of any such improved or additional machine, machinery, mechanism, process or operation shall be limited to the buildings, works or premises now existing or hereafter erected of the person or corporation by or for whom such machine, machinery, mechanism, process or operation was made or carried on within the meaning of the preceding paragraph, his or their executors, administrators, successors or assigns.

PROVIDED ALSO that if any person shall within one year after the date of this Order make an application to the court for compensation in respect of money, time or labour expended by the applicant upon the subject-matter of the said Warrant in the bona fide belief that such Warrant had become and continued to be void, it shall be lawful for the court after hearing the parties concerned or their agents to assess the amount of such compensation, if in the opinion of the court the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid, and if default shall be made in payment of the sum awarded then the Warrant shall become void, but the sum awarded shall not in such case be recoverable as a debt or damages.

Given at the Ministry

this day of

in the Year of OUR

LORD One Thousand Nine Hundred

and

Minister responsible for trade.

SCHEDULES OF FEES

[SECTIONS 12, 57, 72, 83, 101, 136, 146]

Amended by: III.1934.3. Substituted by: XX.1948.9; VII.1970.2. Amended by: XIII.1983.4. Substituted by: L.N. 29 of 1986; L.N. 34 of 1988. Amended by: L.N. 108 of 1997.

SCHEDULE A Fees on Instruments for Obtaining Patents and Renewals

Lm c m Lm c m

1. On application for provisional protection 25.00,0
2. On filing complete specification..... 25.00,0 or 50.00,0
3. On filing specification with first application 50.00,0
4. On notice of opposition to grant of patent - by opponent 10.00,0
5. On application to amend specification..... 10.00,0
6. On notice of opposition to amendment - by opponent..... 5.00,0
7. On application to amend specification during action or proceeding by patentee 10.00,0
8. On opposition to grant of compulsory licence - by patentee 6.00,0
9. On application by proprietor requesting the cancellation of the entry of registration of a patent of which he is the proprietor..... 6.00,0
10. For cancellation from register of a patent after request by its proprietor..... 26.00,0
11. For opposition to application by proprietor to cancel registration of a patent..... 26.00,0

Annual Fees

Lm c m

1. Before the expiration of the 4th year from the date of the patent and in respect of the 5th year..... 25.00,0
2. Before the expiration of the 5th year from the date of the patent and in respect of the 6th year..... 30.00,0
3. Before the expiration of the 6th year from the date of the patent and in respect of the 7th year..... 35.00,0
4. Before the expiration of the 7th year from the date of the patent and in respect of the 8th year.....

40.00,0

1. Before the expiration of the 8th year from the date of the patent and in respect of the 9th year..... 45.00,0

- 2. Before the expiration of the 9th year from the date of the patent and in respect of the 10th year..... 50.00,0
- 3. Before the expiration of the 10th year from the date of the patent and in respect of the 11th year..... 55.00,0
- 4. Before the expiration of the 11th year from the date of the patent and in respect of the 12th year..... 60.00,0
- 5. Before the expiration of the 12th year from the date of the patent and in respect of the 13th year..... 65.00,0
- 6. Before the expiration of the 13th year from the date of the patent and in respect of the 14th year..... 70.00,0

On Enlargement of Time for Payment of Annual Fees

Lm c m

- 1. Not exceeding one month 5.00,0
 - 2. Not exceeding two months..... 7.00,0
 - 3. Not exceeding three months..... 10.00,0
 - 4. For every assignment, agreement, licence or extension of patent 4.00,0
 - 5. For duplicate certificate of Warrant (each)..... 6.00,0
 - 6. On notice to Comptroller of intended exhibition of a patent under section 47 4.00,0
 - 7. Search or inspection fee (each) 4.00,0
 - 8. For any certificate issued by Comptroller..... 3.00,0
 - 9. For altering address in register..... 3.00,0
 - 10. For enlargement of time for filing complete specification, not exceeding one month 3.00,0
 - 11. On application for restoration of u patent 50.00,0
-
- 1. Change of name 3.00,0
 - 2. For copies of specifications including drawings - per page..... 0.30,0
 - 3. On request to Comptroller to correct clerical error on application (before registration) 3.00,0

Amended by: XXXI. 1937.4. Substituted by: XX.1948.9: VII. 1970.2. Amended by: XIII.1983.4. Substituted by: L.N. 29 of 1986: L.N. 34 of 1988. Amended by: L.N. 108 of 1997: L.N. 140 of 1998.

SCHEDULE B Fees on Instruments for the Registration of Trade Marks

Lm c m

1. On application to register a trade mark, for one or more articles included in one class, on account of which the registration of the mark is sought 50.00,0
2. Deleted by: L.N. 108 of 1997.
3. For registering a series of trade marks, for every additional representation after the first, in each class 7.00,0
4. On notice of opposition, for each application opposed, by opponent.... 15.00,0
5. On application to register a subsequent proprietor in cases of assignment of the first mark..... 25.00,0
6. For every additional mark assigned or transmitted at the same time..... 5.00,0
7. For continuance of right to exclusive use of mark at expiration of 14 years 40.00,0
8. Additional fee where fee is paid within three months after expiration of 14 years..... 15.00,0
9. Additional fee for restoration of trade mark where removed for nonpayment of fee..... 30.00,0
10. For altering address on the register for every mark 5.00,0

11. For every entry in the register of a rectification of a trade mark or an alteration therein, not otherwise charged 5.00,0
12. On application by proprietor requesting the cancellation of the entry of registration of a trade mark of which he is the proprietor 10.00,0

1. For cancellation from register of a trade mark after request by its proprietor..... 30.00,0
2. For opposition to application by proprietor to cancel registration of a trade mark 30.00,0
3. On request to Comptroller to correct a clerical error, or permit amendment of application..... 5.00,0
4. For any certificate by Comptroller..... 5.00,0

5. For copy of notification of registration..... 2.00,0

6. For search or for inspecting register by interested person, for every quarter of an hour..... 3.00,0

7. For extract from the register (including copy of label, if any) or for certificate of non-registration..... 5.00,0

Added by: VII.1970.2. Amended by: XIII.1983.4. Substituted by: L.N. 29 of 1986:

L.N. 34 of 1988. Amended by: L.N. 108 of 1997.

SCHEDULE C

Fees on Instruments for the Registration of Designs

Lm c m

1. On application to register designs or models of manufacture, for every drawing..... 20.00,0

2. Deleted by: L.N. 108 of 1997.

3. On application to register a subsequent proprietor 6.00,0

4. For continuance of the right to exclusive use of a design or model of manufacture after the expiration of the first five years..... 15.00,0

5. For continuance of the right to exclusive use of a design or model of manufacture after the expiration of the second five years 15.00,0

6. For altering address on the register for every design or model..... 3.00,0

7. On request to Comptroller to correct a clerical error, or permit amendment of application..... 2.00,0

8. For any certificate by Comptroller..... 2.00,0

9. For copy of notification of registration..... 2.00,0

1. On application by proprietor requesting the cancellation of the entry of registration of a design of which he is the proprietor 5.00,0

2. For cancellation from register of a design after request by its proprietor..... 15.00,0

3. For opposition to application by proprietor to cancel registration of a design 12.00,0