

SUBSIDIARY LEGISLATION 597.04**TRADEMARK RULES, 2021**

12th February 2021

*LEGAL NOTICE 50 of 2021.***PART I****General Provisions**

- 1.** (1) The title of these rules is the Trademark Rules. Citation and applicability.
- (2) These rules shall be without prejudice to the validity or effectiveness of anything done in terms of the provisions of the Trademarks (Provisions and Fees) Rules, Community Trademark Rules, and Trademark Search and Opposition Rules, prior to their incorporation and replacement by these rules and, to the extent necessary, the provisions of the above mentioned Rules shall continue to apply until these rules shall come into force. S.L. 597. 01.
S.L. 597. 02.
S.L. 597. 03.
- (3) These rules shall apply to all applications filed on or after the date of coming into force of these rules and to pending applications for registration for which the applicant or his representative has not received any communication from the Office relating to the registrability of the application.
- 2.** In these rules, unless the context otherwise requires: Interpretation.
- "Act" means the Trademarks Act, and the words and expressions used shall have the same meaning as is assigned to them in the Act; Cap. 597.
- "days" shall mean calendar days. If the last day of any of the time limits provided in these rules is a national holiday, a public holiday or a day when the Office is not open to the public, the period shall be extended until the first following working day.
- 3.** The purpose of these rules is to enable the implementation of the provisions of the Act. Scope and purpose.
- 4.** An application for the registration of a trademark shall be filed in the Maltese or English language and shall contain the following: Content of the application.
- (a) a request for registration of a trademark;
- (b) the name and address of the applicant;
- (c) a list of the goods or services, in accordance with article 45 of the Act, for which the trademark is to be registered;

(d) a representation of the mark in accordance with rule 6;

(e) the name and address of the representative or attorney, in cases where one has been appointed:

Provided that the applicant may, if he so wishes:

(i) indicate a postal and electronic address for the service of correspondence and communications sent from the Office; and

(ii) indicate that in the case of renewals, the representative or attorney appointed as in paragraph (e) is also to be notified of the approaching expiration of the trademark and must for this purpose provide an electronic address where such notifications may be sent. This electronic address could be the same as the electronic address indicated in sub-paragraph (i):

Provided further that an address for service to which notification of the approaching expiration of the trademark as well as an address for service to which communications issued by this office is to be sent, can be submitted at a later date by the proprietor or his attorney or representative and is subject to the prescribed fee.

(f) if applicable, a declaration claiming priority stating the date on which and the country in or for which the previous application was filed; and

(g) the prescribed fee.

Date of filing.

5. (1) The date of filing of the application for the registration of a trademark shall be the date when all of the following elements are submitted:

(a) a request for registration of a trademark;

(b) the name and address of the applicant;

(c) a statement of the goods or services in relation to which it is sought to register the trademark;

(d) a representation of the mark in accordance with rule 6.

(2) If any of the above elements is omitted, the application will not be accepted by the Comptroller and shall be returned to the applicant or his attorney.

(3) The other elements necessary for application included in

rule 4 must be submitted within thirty (30) days from the date of filing. If any of these elements is not submitted within the stipulated time, the application shall be considered as withdrawn by the applicant or his attorney.

6. (1) The trademark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor.

Representation of
the trademark.

(2) The representation of the trademark shall define the subject matter of the registration. Where the representation is accompanied by a description pursuant to paragraphs (d), (e), (f)(ii), (h) of sub-rule (3) or sub-rule (4), such description shall accord with the representation and shall not extend its scope.

(3) Where the application concerns any of the trademark types listed in paragraphs (a) to (j), it shall contain an indication to that effect. Without prejudice to sub-rules (1) or (2), the type of the trademark and its representation shall accord with each other as follows:

(a) in the case of a trademark consisting exclusively of words or letters, numerals, other standard typographic characters or a combination thereof (word mark), the mark shall be represented by submitting a reproduction of the sign in standard script and layout, without any graphic feature or colour;

(b) in the case of a trademark where non-standard characters, stylisation or layout, or a graphic feature or a colour are used (figurative mark), including marks that consist exclusively of figurative elements or of a combination of verbal and figurative elements, the mark shall be represented by submitting a reproduction of the sign showing all its elements and, where applicable, its colours;

(c) in the case of a trademark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance (shape mark), the mark shall be represented by submitting either a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction. The graphic or photographic reproduction may contain different views. Where the representation is not provided electronically, it may contain up to six different views;

(d) in the case of a trademark consisting of the

specific way in which the mark is placed or affixed on the goods (position mark), the mark shall be represented by submitting a reproduction which appropriately identifies the position of the mark and its size or proportion with respect to the relevant goods. The elements which do not form part of the subject matter of the registration shall be visually disclaimed preferably by broken or dotted lines. The representation may be accompanied by a description detailing how the sign is affixed on the goods;

(e) in the case of a trademark consisting exclusively of a set of elements which are repeated regularly (pattern mark), the mark shall be represented by submitting a reproduction showing the pattern of repetition. The representation may be accompanied by a description detailing how its elements are repeated regularly;

(f) in the case of a colour mark:

(i) where the trademark consists exclusively of a single colour without contours, the mark shall be represented by submitting a reproduction of the colour and an indication of that colour by reference to a generally recognised colour code;

(ii) where the trademark consists exclusively of a combination of colours without contours, the mark shall be represented by submitting a reproduction that shows the systematic arrangement of the colour combination in a uniform and predetermined manner and an indication of those colours by reference to a generally recognised colour code. A description detailing the systematic arrangement of the colours may also be added;

(g) in the case of a trademark consisting exclusively of a sound or combination of sounds (sound mark), the mark shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation;

(h) in the case of a trademark consisting of, or extending to, a movement or a change in the position of the elements of the mark (motion mark), the mark shall be represented by submitting a video file or by a series of sequential still images showing the movement or change of position. Where still images are used, they may be numbered or accompanied by a description explaining the sequence;

(i) in the case of a trademark consisting of, or extending to, the combination of image and sound (multimedia

mark), the mark shall be represented by submitting an audiovisual file containing the combination of the image and the sound;

(j) in the case of a trademark consisting of elements with holographic characteristics (hologram mark), the mark shall be represented by submitting a video file or a graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety.

(4) Where the trademark is not covered by any of the types listed in sub-rule (3), its representation shall comply with the standards set out in sub-rule (1) and may be accompanied by a description.

(5) Where the representation is provided electronically, the Comptroller shall determine the formats and size of the electronic file as well as any other relevant technical specifications.

(6) Where the representation is not provided electronically, the trademark shall be reproduced on the relevant official form, or on a single sheet of paper separate from the sheet on which the text of the application appears. The single sheet on which the mark is reproduced shall contain all the relevant views or images and shall not exceed DIN A4 size (29.7 cm high, 21 cm wide). A margin of at least 2.5 cm shall be left all around.

(7) Where the correct orientation of the mark is not obvious, it shall be indicated by adding the word "top" to each reproduction.

(8) The reproduction of the mark shall:

(a) be of a maximum of 300 dots per inch (DPI);

(b) use the RGB colour system, when the mark contains colour;

(c) be of such quality as to enable it to be:

(i) reduced to a size of not less than 5cm x 5cm (600 x 600 pixels); or

(ii) enlarged to a size of not more than 8.5cm x 8.5cm (1000 x 1000 pixels):

Provided that these requirements shall not apply to:

(a) multimedia marks;

(b) sound marks when the mark is represented by submitting an audio file reproducing the sound;

(c) movement marks when the mark is represented by submitting a video file; and

(d) hologram marks when the mark is represented by submitting a video file.

Claiming priority.

7. (1) Where the priority of one or more previous applications is claimed together with the application pursuant to article 46 of the Act, the applicant shall indicate the file number, the country and the date of filing of the previous application and file a copy of it within thirty (30) days of the filing date.

(2) Where the language of the previous application for which priority is claimed is not one of the languages of the Office, the applicant shall provide the Office with a translation of the previous application into Maltese or English within thirty (30) days of the filing date.

(3) Sub-rules (1) and (2) shall apply *mutatis mutandis* where the priority claim relates to one or more previous registrations.

Representations and amendments to the application specified by the Comptroller.

8. The amendments to the application as requested by the Comptroller or any representations made by the applicant in terms of article 48(2) of the Act are to be submitted to the Office of the Comptroller within ninety (90) days from the Comptroller's request. If the representations or the amendments are not received by the Comptroller's Office within the specified time, the application would be refused:

Provided that once the representations or amendments have been submitted, the Comptroller shall decide whether to accept or refuse the application or to seek further clarification from the applicant or his representatives or from other sources as may be necessary. Any decision taken by the Comptroller is final.

Withdrawal, restriction or amendment of application.

9. (1) A request for a withdrawal, restriction or an amendment of an application as specified in article 49 of the Act shall be made on the relevant official form at the prescribed fee.

(2) A request to restrict the goods or services covered by the application should contain:

- (a) the trademark number;
- (b) the goods or services to be removed;
- (c) the remaining list of goods or services.

(3) A request for the correction of errors of wording or copying or obvious mistakes should contain:

- (a) the trademark number;

(b) the text or wording containing the error or mistake;

(c) the corrected version of the text or wording.

10. (1) The applicant or his attorney shall be informed of any disclaimer or limitation by the Comptroller.

Registration
subject to
disclaimer or
limitation.

(2) If the applicant or his attorney is not in agreement with the disclaimer or limitation, or part of the disclaimer or limitation, he shall inform the Comptroller accordingly and state his reasons for his disagreement. If the applicant or his attorney does not submit grounds for disagreement within sixty (60) days from the date of the notification of the disclaimer or limitation, the disclaimer or limitation will be considered as accepted by the applicant, and the Comptroller shall proceed with publication of the trademark application in accordance with article 36 of the Act, with the disclaimer or limitation.

(3) In the case of disagreement by the applicants or his attorney, the Comptroller shall reconsider the limitation or disclaimer on the basis of said disagreement and in this regard he may:

(a) waive the limitation or disclaimer; or

(b) alter the disclaimer or limitation as he sees fit; or

(c) insist on the disclaimer or limitation.

(4) The Comptroller shall communicate his decision in writing to the applicant or his attorney.

(5) If within sixty (60) days from the date of the communication of the Comptroller's decision, the Comptroller does not receive an indication in writing from the applicant or his attorney showing his disagreement with the Comptroller's decision, the disclaimer or limitation shall be taken as accepted and the Comptroller shall proceed with publication of the trademark application in accordance with article 36 of the Act, with the disclaimer or limitation.

(6) If within sixty (60) days from the date of the communication of the Comptroller's decision, the applicant or his attorney submits in writing his disagreement with the disclaimer or limitation, the Comptroller may refuse the application. The Comptroller's decision shall be final and may only be appealed as provided in article 100 of the Act.

11. The publication of the application shall contain:

(a) the applicant's name and address;

(b) the representation of the trademark, together with the elements and descriptions referred to in rule 6. Where the representation has been provided in the form of an electronic

Content of the
publication of an
application.

file, it shall be made accessible by means of a link to that file;

(c) the list of goods or services, according to the classes of the Nice Classification indicated in the application as accepted by the Office in terms of article 45 of the Act;

(d) the date of filing and the file number;

(e) where applicable, particulars of the claim of priority filed by the applicant pursuant to article 46 of the Act, and

(f) any disclaimer or limitation.

Content of the
publication of the
registration.

12. (1) The Comptroller shall, as soon as practicable, publish the registration on the official online journal or any other official publication as may be decided by the Comptroller.

(2) The publication of the registration shall contain:

(a) the proprietor's name and address;

(b) the representation of the mark, together with the elements and descriptions referred to in rule 6. Where the representation has been provided in the form of an electronic file, it shall be made accessible by means of a link to that file;

(c) the list of goods or services, according to the classes of the Nice Classification;

(d) the date of filing and the file number;

(e) where applicable, particulars of the claim of priority filed by the applicant pursuant to article 46 of the Act, and

(f) any disclaimer or limitation:

Provided that the date of such publication shall for the purposes of article 26 of the Act be taken as the date of completion of the registration procedure.

Request for
alteration of a
registration.

13. (1) The proprietor of a mark may submit a request for the alteration of his registered trademark, if the mark includes the proprietor's name and address.

(2) A request for alteration of a registration pursuant to sub-rule (1) shall contain:

(a) the registration number of the trademark;

(b) the name and address of the proprietor of the trademark;

(c) a representation of the trademark as altered, in accordance with rule 6.

(3) If the request is accepted by the Comptroller, the mark shall be altered accordingly and such alteration shall be published on the official online journal or any other official publication that the Comptroller shall prescribe.

14. (1) An objection to the alteration may be entered at the Office of the Comptroller within thirty (30) days from the date of publication of the alteration. Such request shall be accompanied by a statement containing the grounds for objection. The Comptroller shall send a copy of the notice and the statement to the applicant.

Objection to the alteration of a registered trademark.

(2) Within thirty (30) days from the date on which a copy of the statement is sent by the Comptroller to the trademark owner, the owner may file a counter-statement. If no counter-statement is filed within the stipulated time-period, the objection to the alteration of the mark shall be considered as valid and the alteration shall not be allowed.

(3) If a counter-statement is filed in accordance with sub-rule (2), the Comptroller shall decide whether there are grounds for objection or otherwise. The Comptroller shall communicate his decision to the parties concerned and the party against whom the decision is taken may enter an appeal to the Court of Appeal in accordance with article 100 of the Act.

15. (1) A request for the change of the name or address of the proprietor of a registered trademark or a licensee shall be made on the relevant official form and shall contain:

Request for restriction or amendment of a registration.

(a) the trademark number;

(b) the name and the address of the proprietor or the licensee of the trademark as recorded in the Register;

(c) the new name or address of the proprietor or the licensee of the trademark.

(2) A request to restrict the goods or services covered by the registration should contain:

(a) the trademark number;

(b) the goods or services to be removed;

(c) the remaining list of goods or services.

(3) A request for the rectification of an error or omission in the register should contain:

(a) the trademark number

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- (b) the text or wording containing the error or omission
- (c) the corrected version of the text
- Application for registration of a transfer. **16.** (1) An application for a registration of a transfer shall contain:
- (a) the trademark number;
- (b) the name and address of the new proprietor;
- (c) where not all the registered goods or services are included in the transfer, particulars of the registered goods or services to which the transfer relates;
- (d) evidence duly establishing the transfer in accordance with sub-articles (3) and (4) of article 34 of the Act;
- (e) where applicable, the name and business address of the representative of the new proprietor.
- (2) Sub-rule (1) shall apply *mutatis mutandis* for the purposes of an application for the recording of a transfer of a trademark application.
- (3) For the purposes of paragraph (d) of sub-rule (1), any one of the following shall constitute sufficient evidence of transfer:
- (a) the signing of the application for registration of the transfer by the registered proprietor or a representative of that proprietor, and by the successor in title or a representative of that successor;
- (b) where the application is submitted by the registered proprietor or a representative of that proprietor, a declaration signed by the successor in title or a representative of that successor agreeing to the registration of the transfer;
- (c) where the application for registration is submitted by the successor in title, a declaration, signed by the registered proprietor or a representative of that proprietor, that the registered proprietor agrees to the registration of the successor in title.
- Rights *in rem*. **17.** (1) A request for the registration of a right *in rem* may be submitted by:
- (a) the proprietor of the trademark jointly with pledgee; or
- (b) the proprietor of the trademark; or

- (c) the pledgee:

Provided that if the said right *in rem* is recognised in Malta.

(2) The request for the registration of a right *in rem* shall include:

- (a) the trademark number;
- (b) the name and address of the proprietor;
- (c) the name and address of the pledgee; and
- (d) evidence duly establishing the right *in rem*.

(3) For the purposes of paragraph (d) of sub-rule (2), any of the following shall constitute as sufficient evidence:

- (a) a declaration, signed by the trademark proprietor, that he agrees to the registration of the right *in rem*;
- (b) the right *in rem* contract, or an extract therefrom, indicating the trademark at issue and the parties, and bearing their signatures;
- (c) a statement of a right *in rem*, signed by both the proprietor and the pledgee; or
- (d) a *res judicata* judgement issued by a recognised judicial institution establishing the right *in rem*.

(4) The procedure for the registration of a transfer for a right *in rem* follows the same rules as the registration of a right *in rem* set out in sub-rules (1), (2) and (3).

(5) The registration of a right *in rem* may be cancelled or modified.

(6) A request for the cancellation or modification for the registration of a right *in rem* may be submitted by:

- (a) the proprietor of the trademark jointly with pledgee; or
- (b) the proprietor of the trademark; or
- (c) the registered pledgee.

(7) The request for the cancellation or modification for the registration of a right *in rem* shall include:

- (a) the trademark number;

- (b) the name and address of the proprietor; and
- (c) the name and address of the pledgee.

(8) When the request for cancellation is submitted by the proprietor, the request must be accompanied by evidence establishing that the registered right *in rem* no longer exists or by a declaration by the pledgee that he consents to the cancellation.

(9) (a) Where the request for modification is submitted by the proprietor, proof of the modification of the registration of the right *in rem* is required only where the modification is of such a nature that it would diminish the rights of the registered pledgee under the right *in rem*.

(b) Where the request for modification is submitted by the registered pledgee, proof of the modification of the registration of the right *in rem* is required only where the modification is of such a nature that it would extend the rights of the registered pledgee under the right *in rem*.

(10) The registration of rights *in rem*, of the transfer, of the cancellation or of the modification of those rights shall be entered in the Register and published on the official online journal or any other official publication as may be decided by the Comptroller.

(11) The rules and sub-rules applicable to the registration of rights *in rem* shall also be applicable to the registration of a security over a trademark, and any reference to a right *in rem* shall *inter alia* include a reference to a security..

Levy of execution.

18. (1) An application for registration of a levy of execution may be filed with the Office by:

- (a) any interested person following a court or arbitral order to that effect; or
- (b) the trademark proprietor; or
- (c) the beneficiary:

Provided that if the said levy of execution is recognised in Malta.

(2) The application for registration of a levy of execution must be accompanied by the final decision of the Court.

(3) The Office will inform the beneficiary and the trademark proprietor that the levy of execution has been registered.

(4) A registration of a levy of execution may be cancelled or modified. A request for cancellation of the registration of a levy of

execution must be accompanied by proof, comprising a certified copy of the final decision of the Court or Arbitral Authority, showing that the registered levy of execution no longer exists. A request for the modification of the registration of the levy of execution must be accompanied by proof comprising a certified copy of the final decision of the Court or Arbitral Authority showing such modification.

(5) The request for the cancellation or modification of the registration of a levy of execution shall include:

- (a) the trademark number;
- (b) the name and address of the proprietor; and
- (c) the name and address of the beneficiary.

19. (1) An application for a registration of a licence shall contain:

Application for registration of a licence.

- (a) the trademark number;
- (b) the name and address of the licensee;
- (c) whether the licence is exclusive or non-exclusive;
- (d) where the licence is limited, a description of the limitation;
- (e) the duration of the licence, if applicable; and
- (f) evidence duly establishing the licence.

(2) For the purposes of paragraph (f) of sub-rule (1), any of the following shall constitute sufficient evidence of the licence:

- (a) the signing of the application for registration of the licence by the registered proprietor or a representative of that proprietor, and by the licensee or a representative of that licensee;
- (b) where the application is submitted by the registered proprietor or a representative of that proprietor, a declaration signed by the licensee or a representative of that licensee agreeing to the registration of the licence;
- (c) where the application for registration is submitted by the licensee, a declaration signed by the registered proprietor or a representative of that proprietor, that the registered proprietor agrees to the registration of the licence.

20. (1) A declaration of the division of an application or a registration shall contain:

Division of a registration or application.

- (a) the trademark number;
- (b) the name and address of the applicant or proprietor of the trademark;
- (c) the list of goods or services which are to form the divisional application or registration, or, where the division into more than one divisional application or registration is sought, the list of goods or services for each divisional application or registration; and
- (d) the list of goods or services which are to remain in the original application or registration.

(2) The Office shall establish a separate file for the divisional application or registration, which shall consist of a complete copy of the file of the original application or registration, including the declaration of division and the correspondence relating thereto.

(3) The Office shall assign a new number to the divisional application or registration.

Renewal of
registration.

21. (1) Renewal of registration shall be effected by filing a request for renewal in the relevant official form at any time within the period of six (6) months ending on the date of the expiration of the registration.

(2) At any time not earlier than six (6) months nor later than one (1) month before the expiration of the last registration of a trademark, the Comptroller shall, except where renewal has already been effected under sub-rule (1), send to the registered proprietor or the electronic address for service where such has been indicated as in rule 4 notice of the approaching expiration and inform him at the same time that the registration may be renewed in the manner prescribed in sub-rule (1). A copy of said notice is also to be sent to the electronic address for the representative or attorney where such has been indicated in rule 4.

(3) If on the expiration of the last registration of a trademark the renewal fee has not been paid and the request for renewal has not been made, the proprietor may renew the mark within six (6) months from the date of expiration of the last registration provided that the request for renewal is filed on the relevant official form and is accompanied by the renewal fee and the additional renewal fee.

(4) If on the expiration of the last registration of a trademark, the renewal fee has not been paid and the request for renewal has not been made and no action, as prescribed in sub-rule (3), has been taken by the proprietor, the Comptroller shall record the trademark as removed from the register.

(5) Where the Comptroller has removed the mark from the

register for failure to renew its registration in accordance with sub-rule (3), he may, restore the mark to the register and renew its registration, if after considering the circumstances of the failure to renew, he is satisfied that it is just to restore such mark. Request for restoration is to be filed on the relevant official form within six (6) months of the date of the removal of the mark and be accompanied by the appropriate renewal fee and appropriate restoration fee.

(6) The renewal and restoration of the registration shall be published on the official online journal or any other official publication that the Comptroller shall prescribe. The publication shall show the date of renewal or restoration.

- 22.** (1) A declaration of surrender shall contain: Surrender.
- (a) the trademark number;
 - (b) the name and address of the proprietor; and
 - (c) where surrender is declared only for some of the goods or services for which the trademark is registered, an indication of the goods or services for which the trademark is to remain registered.

(2) Where a right of a third party relating to the trademark is entered in the register, a declaration of consent to the surrender, signed by the proprietor of that right or a representative of that proprietor, shall be sufficient proof of the third party's agreement to the surrender.

(3) The Comptroller shall, upon the surrender taking effect make the appropriate entry in the register and publish the same on the official online journal or any other official publication that the Comptroller shall prescribe.

- 23.** (1) These rules shall apply to collective marks and certification marks in so far as these are applicable. Collective marks and certification marks.

(2) Where the collective mark or certification mark is used to indicate a geographical origin, there must be submitted before the Comptroller, evidence that this mark is in fact being used to identify the goods as originating in the territory or in a region or locality in that territory and that a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin.

(3) Within sixty (60) days of the date of the application for the registration of a collective or certification mark, the applicant shall file the regulations governing the use of the mark together with the prescribed fee.

- 24.** In addition to the requirements specified in article 67 of the Act, the regulations governing collective marks shall also specify: Content of regulations governing the use of certification marks.

- (a) the name of the applicant;
- (b) a declaration that the applicant complies with the requirements laid down in article 64(1) of the Act;
- (c) the representation of the certification mark;
- (d) the goods or services covered by the certification mark;
- (e) the characteristics of the goods or services to be certified by the certification mark, which should include, as applicable, the material, mode of manufacture of goods or performance of services, quality or accuracy; and
- (f) the conditions governing the use of the certification mark, including sanctions.

Content of regulations governing the use of collective marks.

25. In addition to the requirements specified in article 81 of the Act, the regulations governing collective marks shall also specify:

- (a) the name of the applicant;
- (b) the object of the association or the object for which the legal person governed by public law is constituted;
- (c) the bodies authorised to represent the association or the legal person governed by public law;
- (d) the representation of the collective mark;
- (e) the goods or services covered by the collective mark including, where appropriate, any limitation introduced as a consequence of the application of article 5(1)(i), (j) or (k) of the Act.

Inspection of register.

26. (1) The register is available online and any interested person may carry out a search directly in this register.

(2) An interested person may also submit a request in writing to the Office for a search to be conducted in respect of a mark or marks in one or more classes of goods and services, at the prescribed fee. If the person or persons requesting the search require copies of any related record, extracts from the register or copies of the representation of the mark, whether certified or uncertified, these shall be provided at the prescribed fee.

Removal of any matter from the register.

27. (1) Where it appears to the Comptroller that any matter in the register has ceased to have effect, before removing it from the register:

- (a) he may, where he considers it appropriate, publish his intention on the official online journal or any other official

publication as may be decided by the Comptroller to remove that matter, and

(b) where any person appears to him to be affected by the removal, he shall send notice of his intention to that person.

(2) Within forty (40) days from the date on which his intention to remove the matter is published, or notice of his intention is sent, as the case may be:

(a) any person may file notice of opposition to the removal on the relevant official form; and

(b) the person to whom a notice is sent under paragraph (b) of sub-rule (1) may file in writing his objections, if any, to the removal.

(3) If the Comptroller is satisfied after considering any objections or opposition to the removal that the matter has not ceased to have effect, he shall not remove it.

(4) Where there has been no response to the Comptroller's notice he may remove the matter.

(5) Where representations objecting to the removal of the entry have been made, the Comptroller may, if he is of the view after considering the objections that the entry or any part thereof has ceased to have effect, remove it or, as appropriate, the part thereof.

28. (1) Subject to article 45(1) of the Act, the Comptroller may consequent upon an amendment of the International Classification of Goods and Services, make amendments to entries on the register as he considers necessary for the purposes of reclassifying the specification of the registered trademark.

Adaptation of entries to new classification.

(2) Before making any amendment to the register under sub-rule (1) the Comptroller shall require the proprietor of the mark to submit his proposals for amendment of the register.

(3) The proprietor shall submit such proposals in writing within thirty (30) days from the date of the communication issued by the Comptroller.

(4) If no proposals are received within the prescribed period, the Comptroller shall decide whether to cancel or refuse to renew the registration of the trademark as specified in article 93(3)(b) of the Act.

29. (1) The Comptroller shall, as soon as practicable, publish the proposals on the official online publication or any other official publication that the Comptroller shall prescribe.

Opposition to proposals.

(2) Notice of any opposition shall be filed within forty (40) days from the date of publication of the proposals under sub-rule(1)

and there shall be stated in the notice the grounds of opposition and, in particular, how the proposed amendments would be contrary to article 93(2) of the Act.

(3) If a notice of opposition under sub-rule (2) is filed within the prescribed period and the Comptroller accepts the opposition, the proposed amendments shall not be entered into the register.

(4) If no notice of opposition under sub-rule (2) is filed within the prescribed period, or where any opposition has been rejected, the Comptroller shall make the amendments as proposed and shall enter in the register the date when they were made.

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(5) The Comptroller's decision shall only be subject to appeal based on points of law before the Court of Appeal composed in the manner provided in sub-article (9) of article 41 of the Code of Organization and Civil Procedure by application within fifteen (15) days of service of the Comptroller's decision.

Inspection of documents.

30. (1) Subject to sub-rules (2) and (3), the Comptroller shall permit all documents filed or kept at the Office in relation to a registered mark to be inspected.

(2) The Comptroller shall not be obliged to permit the inspection of any such document as is mentioned in sub-rule (1) until he has completed any procedure, or the stage in the procedure which is relevant to the document in question, which he is required or permitted to carry out under the Act or these rules.

(3) The right of inspection under sub-rule (1) does not apply to:

(a) any document until fourteen (14) days after it has been filed at the Office;

(b) any document prepared in the Office solely for use therein;

(c) any document sent to the Office, whether at its request or otherwise, for inspection and subsequent return to the sender;

(d) any document issued or received by the Office which the Comptroller considers should be treated as confidential.

(4) Nothing in sub-rule (1) shall be construed as imposing on the Comptroller any duty of making available for public inspection:

(a) any document or part of a document which in his opinion disparages any person in a way likely to damage him; or

(b) any document filed with or sent to the Office before the enactment of the Act.

(5) No appeal shall lie from a decision of the Comptroller under sub-rule (4) not to make any document or part of a document available for public inspection.

31. (1) Where an agent has been authorised under article 104 of the Act, the Comptroller may in any particular case require the personal signature or presence of the agent or the person authorising him to act as agent.

Recognition of
trademark agents.

(2) The Comptroller may by notice in writing sent to an agent require him to produce evidence of his authority.

32. (1) Any communication shall contain the following indications:

Communications
with the
Comptroller.

(a) the name and address of the applicant, owner or other interested person;

(b) the number of the application or trademark to which it relates;

(c) where the applicant, owner or other interested person is registered with the Office, the number or other indication under which he is so registered.

(2) In the case of a communication by an agent for the purposes of a procedure before the Office it shall contain:

(a) the name and address of the agent;

(b) a reference to the power of attorney, or other communication in which the appointment of that agent is or was effected, on the basis of which the said agent acts;

(c) where the agent is registered with the Office, the number or other indication under which he is registered.

(3) An applicant, owner or other interested person shall indicate in any communication an address for correspondence as well as an address for legal service which must be on Maltese territory:

Provided that where no agent is appointed and an applicant, owner or other interested person has provided, as his address, an address on Maltese territory, the Office shall consider that address to be the address for correspondence or the address for legal service unless that applicant, owner or other interested person expressly indicates another such address:

Provided further that where an agent is appointed, the address of that agent shall be considered to be the address for

correspondence or the address for legal service, unless that applicant, owner or other interested person expressly indicates another such address.

(4) Where one or more of the requirements under sub-rules (1) to (3) are not complied with in respect of communications, the Office shall invite the applicant, owner or other interested person, to comply with any such requirement, and to make observations, within thirty (30) days from the date of the invitation:

Provided that where an invitation has not been made because indications allowing the applicant, owner or other interested person to be contacted by the Office have not been filed, the time limit for compliance and observations shall be sixty (60) days from the date on which the communication was received by the Office.

Fees and
supporting
documents.

33. (1) The fees to be paid in respect of any application, registration or any other matter under these rules shall be those prescribed in the Schedule of Fees to these rules:

Provided that when there are extenuating factors, the Comptroller shall decide on a case by case basis:

(a) whether or not a fee is to be remitted;

(b) whether or not an additional fee normally charged because of a non-observance of a time limit is to be partially or totally waived.

(2) The Comptroller may request the submission of documentary evidence before undertaking any act required of him by law.

(3) Fees may be reduced or waived, refunded or compensated in respect of a particular sector, one or more sectors or in respect of all sectors:

(a) during a period of national or sectorial emergency or crisis or *force majeure* which may be declared by Government;

(b) in a designated period of recovery from such;

(c) with a view to promote industrial property rights:

Provided that notice of any reduction, refund, waiver or any compensation of fees is to be specified by a notice in the Gazette:

Provided further that when a reduction, refund, waiver or compensation of fees is tied to the duration of national or sectorial emergency or crisis or *force majeure* or to a period of recovery from such, the designated period shall be specified by notice in the Gazette.

PART II
Trademark Search and Opposition

- 34.** This part specifies: Scope.
- (a) the details of the procedure governing a relative search examination carried out by the Office, and
- (b) the details of the procedure for filing and examining an opposition to the registration of a trademark at the Office.
- 35.** (1) The Office shall carry out *ex officio* a search under the national trademark database for each application received in order to identify identical or similar registrations or applications. Relative search.
- (2) The results of the search shall be notified to the applicant.
- (3) If the applicant wishes to withdraw the application, a request for withdrawal shall be submitted, to the Office, together with the prescribed withdrawal fee within thirty (30) days from receipt of the notification.
- (4) If the applicant does not submit his request to withdraw the application within the specified time period, the Office shall notify the earlier right holder of the results of the search and proceed with the publication of the application accordingly.
- (5) An opposition to such an application may be submitted in terms of article 50 of the Act and these rules.
- 36.** (1) If it appears to the Comptroller that the requirements for registration are met, the Comptroller shall publish the application on the official online journal or any other official publication as may be decided by the Comptroller. Publication of application.
- (2) The publication shall be updated with new applications on a weekly basis.
- 37.** Within a period of ninety (90) days following the publication of a trademark application, notice of opposition to registration of the trademark may be given on the grounds that it may not be registered because of any of the reasons specified in sub-articles (1), (3) and (4) of article 6 of the Act. Opposition period.
- 38.** (1) A notice of opposition may be entered on the basis of one or more earlier marks or other rights within the meaning of article 6 of the Act, provided that the proprietors or authorised persons entering the notice pursuant to article 50 of the Act are entitled to do so for all the earlier marks or rights. Where an earlier mark has more than one proprietor or where an earlier right may be exercised by more than one person, an opposition pursuant to article 50 of the Act may be Notice of opposition.

filed by any or all of the proprietors or authorised persons.

(2) The notice of opposition shall contain:

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

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

(i) where the opposition is based on an earlier mark within the meaning of article 6(1) and (2)(a), or (b) or (c) of the Act, the file number or registration number of the earlier mark, an indication of whether the earlier mark is registered or an application for registration of that mark;

(ii) where the opposition is based on a well-known mark within the meaning of article 6(2)(d) of the Act, a representation of the mark;

(iii) where the opposition is based on an earlier mark within the meaning of article 6(3)(a) of the Act, the file number or registration number of the earlier mark, an indication of whether the earlier mark is registered or there is an application for registration of that mark;

(iv) where the opposition is based on an earlier designation of origin or geographical indication within the meaning of article 6(3)(c) of the Act an indication of its nature, a representation of the earlier designation of origin or geographical indication, and an indication of whether it is protected under Union legislation or the Laws of Malta.

(v) where the opposition is based on the grounds provided in article 6(4) of the Act a representation of the mark.

(c) a statement outlining the grounds on which the opposition is based under article 6(1), article 6(3)(a), article 6(3)(c) or article 6(4) of the Act in respect of each of the earlier marks or rights invoked by the opposing party;

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

(e) in the case of earlier rights pursuant to article 6(3)(c) of the Act the date of application for registration or, if that date is not available, the date from which protection is

granted;

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

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

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

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

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

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

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

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

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

(5) The notice of opposition shall be accompanied by the prescribed opposition fee. The notice of opposition may be submitted either through soft or hard copy:

Provided that if the related documentation is to be submitted in hard copy, this should be submitted in duplicate.

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

(b) In the case where the opposer desires to file additional documentation, such documentation is to be submitted within the ninety (90) day period referred to in rule 37. Additional documentation may be submitted provided that the Office has not yet received a counterstatement from the applicant as in rule 40(1). Where the opposer desires to submit additional documentation, the ninety (90) day period referred to in rule 40(1) will commence from the date of notification to the applicant of such documentation:

Provided that the filing of additional documentation as provided in sub-rule (2) above does not affect the possibility to file additional documentation again as provided in rule 41(1).

(c) In the case where the applicant has not yet submitted his counterstatement, the ninety (90) day period referred to in rule 40(1) shall commence from the date of notification by the Office to the applicant of such documentation.

Admissibility of
the opposition.

39. (1) Where the opposition fee has not been paid within the opposition period laid down in rule 37, the opposition shall be deemed not to have been entered. Where the opposition fee has been paid after the expiry of the opposition period, it shall be refunded to the opposing party.

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

(3) Where the notice of opposition does not comply with the provisions of rule 38(2)(d) to (h), the Office shall inform the opposing party accordingly and shall invite it to remedy the deficiencies noted within a period of twenty (20) days from the date of notification by the Office. If the deficiencies are not remedied before the time limit expires, the Office shall reject the opposition.

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

grounds of inadmissibility under sub-rules (2) or (3):

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

40. (1) Where the opposition is found admissible pursuant to rule 39, the Office shall notify the applicant that within a period of ninety (90) days from the date of notification the applicant may:

Opposition proceedings.

(a) withdraw the application, or

(b) restrict the goods and services covered by the application, or

(c) submit a counterstatement against the opposition and any supporting evidence and reasoned statement on the grounds, the facts and arguments with respect thereto.

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

(3) Where, within the period referred to in sub-rule (1), the applicant restricts the application by deleting some of the goods or services against which the opposition is directed, the Office shall invite the opposing party to state, within twenty (20) days of the date from said invitation and subject to the prescribed fee, whether it maintains the opposition, and if so, against which of the remaining goods or services the opposition is being maintained. Where the opposing party withdraws the opposition in light of the restriction, the opposition proceedings shall be closed.

(4) When the opposing party informs the Office that the opposition is being maintained as in sub-rule (3), the Office shall notify the applicant that the opposition is being maintained against the remaining goods or service. Within a period of thirty (30) days from the date of notification, the applicant may:

(a) withdraw the application as prescribed in rule 9,
or

(b) submit a counterstatement against the opposition and any supporting evidence and reasoned statement on the grounds, the facts and arguments with respect thereto.

(5) (a) Where a counterstatement is submitted, the Office shall notify the opposing party of the counterstatement and also send a copy of the counterstatement to the opposing party. Within ninety (90) days of the date of notification of the counterstatement, the opposing party shall inform the Office in writing, whether it is withdrawing or maintaining the opposition.

(b) In the case where the opposing party informs the Office that the opposition is being maintained, it shall, at the same time, submit the prescribed fee and any additional supporting evidence and reasoned statement on the grounds, the facts and arguments on which the opposition is being maintained.

(c) In the case where the opposing party does not inform the Office, within the period stipulated in sub-rule (5)(a), whether it is withdrawing or maintaining the opposition, the Office shall consider the opposition as withdrawn and proceed with the registration of the trademark.

(6) (a) For the purposes of article 50(2) of the Act, such request shall not be made after the expiry of the period of the ninety (90) days from the date of notification by the Office, of the opposition to the applicant as referred to in sub-rule (1).

(b) When an amicable solution is reached within the period as provided for in article 50(2) of the Act, the parties are to provide a joint statement indicating that such a solution has been reached within twenty (20) days from the expiry of the said period.

(c) The joint statement shall clearly and unequivocally indicate the nature of the amicable solution stating the outcome of the application and the opposition:

Provided that any amendments to the goods or services are to be made as prescribed in rule 9.

(d) When a joint statement is not received within the twenty (20) day period referred to in sub-rule (6)(b) or when, during the period contained in article 50(2) of the Act, one of the parties notifies the Office that no agreement has been reached, it shall be deemed that the opposition is being maintained and the procedure as outlined in sub-rule 5(b) shall apply.

(7) The application shall be deemed as abandoned, if within the time periods provided for in sub-rules 1(a), 4(a) and 6(b), the Office is not informed that any of the actions stipulated in these sub-rules have been undertaken.

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

End of opposition
procedures before
the Office.

41. (1) Where the opposition is maintained, pursuant to rule 40(5)(b), the Office shall notify the applicant accordingly and provide the applicant with a period of ninety (90) days therefrom within which

to file any additional supporting evidence and reasoned statement on grounds, facts and arguments.

(2) The Office shall proceed to take a decision based on the information and evidence provided by the opposing party and the applicant.

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

(4) An appeal from the decision of the Office may be filed according to the provisions of article 100 of the Act.

(5) When a notice of appeal is filed according to sub-rule (3), the party filing the appeal is to inform the Office of such within the time period provided for in article 100 of the Act.

PART III Madrid Protocol

42. This Part specifies the rules which will apply once the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks enters into force with respect to Malta.

Provisions giving effect to the Madrid protocol when this enters into force.

43. In this Part:

Interpretation.

"Contracting Party" means any country or intergovernmental organisation party to the Protocol;

"designation" means the request for extension of protection ("territorial extension") to Malta under Article 3ter (1) or (2) of the Protocol, as the case may be; it also means such extension as recorded in the International Register;

"designated Contracting Party" means a Contracting Party for which the extension of protection ("territorial extension") has been requested under Article 3ter (1) or (2) of the Protocol, as the case may be, or in respect of which such extension has been recorded in the International Register;

"holder" refers to the natural person or legal entity in whose name an international registration is recorded in the International Register;

"international registration" means the registration of a mark effected under the Agreement or the Protocol;

"invalidation" means a final decision by the Court invalidating the effects of the protected international registration designating Malta with regard to all or some of the goods or services covered by the designation or subsequent designation in Malta;

"Office of origin" means the Office of the Contracting Party where, in accordance with Article 2(2) of the Protocol, the international application was filed.

"provisional refusal" means a declaration by the Office, outlining the grounds on the basis of which protection cannot be granted; it also outlines the deficiencies to be remedied by the holder;

"Regulations under the Protocol" means the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks;

"subsequent designation" means the request for extension of protection ("territorial extension") to Malta under Article 3^{ter} (2) of the Protocol; it also means such extension as recorded in the International Register;

"WIPO Gazette" means the periodical gazette referred to in Rule 32 of the Regulations under the Protocol.

Language.

44. (1) Any communication, including an international application, for transmittal to the International Bureau through the intermediary of the Comptroller shall be in English.

(2) Any communication concerning an international application or an international registration addressed to the International Bureau by the Comptroller shall be in English.

Entitlement to file an international application.

45. (1) Any natural person or legal entity, that is a national of Malta, is domiciled in or has a real and effective industrial or commercial establishment in Malta, is entitled to file an international application with the Comptroller provided any basic application or basic registration, as the case may be, used as a basis to file the international application is in the name of that natural person or legal entity.

(2) The applicant shall provide, at the request of the Comptroller, such evidence as may be necessary to satisfy the Comptroller that the applicant is entitled to file the application in accordance with sub-rule (1).

Examination of international applications where Malta is the office of origin.

46. (1) Where an international application is filed with the Comptroller for transmittal to the International Bureau, the Comptroller shall verify that Malta may be considered as the Office of origin for that application, and that the relevant particulars appearing in the international application correspond to those appearing in any basic application or basic registration, as the case may be, in accordance with the provisions of the Protocol and the Regulations under the Protocol.

(2) Where the international application complies with the

prescribed requirements, the Comptroller shall so certify in the international application, indicating also the date on which the international application was received, and shall forward the international application to the International Bureau.

(3) Where the international application does not meet the prescribed requirements, the Comptroller shall not forward it to the International Bureau, and shall inform the applicant accordingly.

47. The prescribed handling fee, shall be due and payable to the Comptroller for the certification and transmittal to the International Bureau of an international application originating in Malta. Handling fee.

48. (1) Where the international application does not comply with the prescribed requirements, the Comptroller shall give the applicant the opportunity to submit the requested information or pay the handling fee within ten (10) days. Irregularities with the international application to be remedied before the Comptroller.

(2) Where the applicant does not provide the requested information or the payment of the handling fee within the stipulated time as determined in sub-rule (1) by the Comptroller, the international application is considered abandoned and the Comptroller shall not forward this to the International Bureau.

49. Where the international application complies with the prescribed requirements, including payment of the handling fee, the Comptroller shall certify the international application, also indicating the date of its receipt and shall forward the international application to the International Bureau. Certification by the Comptroller.

50. The Comptroller shall respond to the International Bureau, as appropriate, to any irregularities issued under Rules 11 to 13 of the Regulations under the Protocol, within the given time limit of three months from the date of the notification of that irregularity by the International Bureau. The Comptroller shall request the applicant to provide the required information within thirty (30) days. The Comptroller shall then forward this information to the International Bureau. Irregularities with the international application, to be remedied before WIPO.

51. The classification of goods and services of an international application shall be subject to Rule 9(4)(xiii) of the Regulations under the Protocol where the decision of the International Bureau shall be final. Classification of goods and services.

52. (1) Where, in accordance with Article 6 of the Protocol, the basic application, the registration resulting from such application, or the basic registration, ceases to have effect, the Comptroller shall inform the International Bureau accordingly, in accordance with Rule 22 of the Regulations under the Protocol, requesting the cancellation of the international registration. Ceasing of effect of the basic application or basic registration.

(2) Where the facts and decisions of the basic registration or

basic application affect the international registration only with respect to some of the goods and services, the Comptroller shall indicate those goods and services which are affected by the facts and decisions or those which are not affected by the facts and decisions.

Effects of an international registration.

53. (1) An international registration designating Malta shall have the same effects as from the date of the international registration or of the subsequent designation of Malta, as the case may be, as an application for the registration of the mark filed directly with the Comptroller under the Act.

(2) The date of filing would be the date of the international registration where Malta is designated in the international registration or the date of the subsequent designation where Malta is designated subsequently to the international registration.

(3) The indication of classes and goods and services set out in the international registration, in which Malta is designated, shall not bind the Comptroller with regard to the determination of the scope of the protection of the mark.

(4) If no refusal is notified by the Comptroller to the International Bureau in accordance with the Protocol and the Regulations under the Protocol, or if a refusal has been so notified but has been subsequently withdrawn, or if a statement or grant of protection is sent by the Comptroller, the protection of the mark in Malta shall be the same as if the mark had been registered directly by the Comptroller on the date of the international registration or of the subsequent designation of Malta, as the case may be.

Examination of international registrations.

54. (1) The Comptroller shall examine the marks that are the subject of international registrations designating Malta in relation to articles 5, 6, 45(2) and (4), 127 and 128 of the Act.

(2) Where any elements of the mark would be in a language other than English, and the holder has not declared that the word has no meaning, a translation into English is required. Where such translation is not included in the international registration, the Comptroller shall issue an *ex officio* provisional refusal under rule 56.

Collective and certification marks.

55. (1) For collective marks in international registrations designating Malta, article 61(b), articles 77 to 90 of the Act shall apply *mutatis mutandis*.

(2) For certification marks in international registrations designating Malta, article 61(a), articles 62 to 76 of the Act shall apply *mutatis mutandis*.

(3) Where the regulations governing the use of collective or certification marks have not been submitted directly to the Comptroller, the Comptroller shall issue an *ex officio* provisional refusal under rule 56.

56. (1) Where the Comptroller finds that, in accordance with the Act, an international registration designating Malta cannot be accepted or can be accepted with conditions only, the Comptroller shall, before the expiry of the refusal period specified in Article 5(2)(b) of the Protocol, notify to the International Bureau of a provisional refusal of protection, complying with the requirements of the Protocol and the Regulations under the Protocol.

Ex officio
provisional refusal
of protection.

(2) The holder of that international registration shall enjoy the same remedies as if the mark had been filed for registration directly with the Comptroller.

(3) Any provisional refusal of the international registration designating Malta must be notified to the International Bureau, together with a statement of all grounds, before the expiry of eighteen (18) months from the date on which the notification of the extension has been sent to Malta by the International Bureau.

(4) The holder may respond to the provisional refusal directly to the "Office" by requesting a review of the decision within a period of sixty (60) days counted from the date of the notification to the holder sent by the International Bureau.

(5) The holder may appoint an agent or attorney to act on their behalf before the Comptroller.

(6) Where the Comptroller has requested the holder to accept a disclaimer or has proposed that the designation shall only be acceptable for specific goods and, or services, the Comptroller may proceed for publication for opposition with the disclaimer or the specific goods and/or services, where the holder has not submitted their disagreement within the given time limit.

(7) Where the holder does not respond to the total provisional refusal within the given time limit, the designation of Malta is deemed abandoned to the extent applicable.

57. (1) Where Malta has been designated in an international registration and the Comptroller finds that the mark that is the subject of that international registration is acceptable, the Comptroller shall publish the international registration as provided for in rule 36.

Publication of
international
registration;
opposition.

(2) A person who opposes the protection of an international registration designating Malta (the opponent) may file with the Comptroller a notice of opposition within the period of sixty (60) days from the date of publication.

(3) Opposition to the international registration shall be governed by the provisions of the Act regarding opposition *mutatis mutandis*.

Possible notification of provisional refusal based on opposition in accordance with Article 5(2)(c) of the Protocol.

58. Where the period to file an opposition against an international registration ends after the expiry of the refusal period specified in Article 5(2)(b) of the Protocol or the Comptroller considers that it will end too late for the Comptroller to send a notification under rule 59 within that refusal period, the Comptroller shall send a communication informing that fact to the International Bureau, complying with the requirements of Rule 16 of the Regulations under the Protocol.

Provisional refusal based on an opposition.

59. (1) Where a notice of opposition is filed with the Comptroller in respect of an international registration designating Malta, the Comptroller shall, before the expiry of the refusal period specified in Article 5(2)(b) or in accordance with Article 5(2)(c) of the Protocol, notify that fact to the International Bureau as a provisional refusal based on an opposition, complying with the requirements of the Madrid Protocol and the Regulations under the Protocol.

(2) Subject to rule 58 any provisional refusal of the international registration designating Malta may be notified to the International Bureau, together with a statement of all grounds, after the expiry of eighteen (18) months from the date on which the notification of the extension has been sent to Malta by the International Bureau, provided this is notified within the time limit set out in Article 5(2)(c)(ii) of the Protocol.

(3) The holder of the international registration concerned shall enjoy the same remedies as if the mark had been filed for registration directly with the Comptroller.

(4) The holder may file his counterstatement within a period of sixty (60) days, counted from the date of the notification to the holder sent by the International Bureau.

(5) Where the holder does not file counterstatement within the given time limit, the designation of Malta is deemed abandoned.

(6) After giving both parties opportunities to present their arguments, the Comptroller shall make his decision on the opposition and the possible protection of the international registration in Malta.

No grounds for refusal – statement of grant of protection.

60. Where after all the procedures before the Office have been completed, the Comptroller has not found grounds to refuse protection, has not received a notice of opposition and, as a result, has not notified a provisional refusal in accordance with rule 56 or rule 59, the Comptroller shall, as soon as possible and before the expiry of the refusal period applicable under Article 5(2) of the Protocol, send to the International Bureau a statement to the effect that protection is granted to the mark in Malta, in accordance with the relevant provisions of the Regulations under the Protocol.

61. Where after the Comptroller has notified the International Bureau of a provisional refusal of protection in accordance with rule 56 or Rule 59 and, all the procedures before the Office having been completed, the mark is either totally or partially protected, the Comptroller shall send to the International Bureau, in accordance with the relevant provisions of the Regulations under the Protocol:

Statement of grant of protection following the notification of a provisional refusal.

(a) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted in Malta for all the goods and services for which protection has been requested; or

(b) a statement indicating the goods and services for which or the conditions under which protection of the mark is granted in Malta.

62. Where the Comptroller has sent to the International Bureau a notification of total provisional refusal in accordance with rule 56 or rule 59 and, all the procedures before the Office having been completed, the Comptroller has decided to confirm such refusal of protection of the mark in Malta for all the goods and services for which protection has been requested, the Comptroller shall send to the International Bureau a statement to that effect, in accordance with the relevant provisions of the Regulations under the Protocol.

Confirmation of total refusal.

63. (1) Any person aggrieved with any decision made by the Comptroller in respect to international registrations designating Malta may appeal therefrom to the Court within a period of fifteen (15) days of service by the International Bureau, of the Comptroller's decision. Article 100 of the Act shall apply *mutatis mutandis*:

Appeals.

Provided that an appeal can only be made to a definitive decision made by the Comptroller.

(2) Any decision, judgement or order of the Court following the appeal filed following sub-rule (1) shall be communicated to the International Bureau as a further decision in accordance with rule 64.

64. Where a notification of provisional refusal has not been sent by the Comptroller within the applicable time limit under Article 5(2) of the Protocol, or, where following the sending of a statement in accordance with rules 60 to 62, a further decision, taken by the Comptroller or the Court, affects the protection of a mark in Malta, the Comptroller shall send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in Malta:

Further decision affecting the protection of a mark.

Provided that in the case where a decision is taken by the Court, the above requirement is subject to the Comptroller being aware of that decision and said requirement is undertaken without prejudice to Rule 19 of the Regulations under the Protocol or rule 65.

Invalidation.

65. Where, upon a final decision, the Court pronounces the invalidation of the effects of an international registration in Malta, the Comptroller shall, provided that the Comptroller is made aware of that decision, notify the International Bureau in accordance with the relevant provisions of the Protocol and the Regulations under the Protocol.

Replacement.

66. (1) (a) Where:

(i) a mark registered in Malta is also the subject of an international registration, and the protection resulting therefrom extends to Malta, and

(ii) the same person is recorded as holder of the registration in Malta and of the international registration, and

(iii) goods and services listed in the national registration are also listed in the international registration in respect of Malta, and

(iv) the extension of that international registration to Malta took effect after the date of registration of the mark in Malta,

the holder of the international registration may request the Comptroller to take note of that international registration in the register.

(b) A request filed with the Comptroller in accordance with paragraph (a), shall be made on the relevant official form and shall be subject to the payment of the prescribed fee.

(c) Replacement of the national registration by an international registration is deemed to be automatic when the conditions under Article 4*bis* (1) of the Protocol are met. Replacement is not depending on any action by the holder or the Comptroller. The effective date of replacement is the date of the international registration or the subsequent designation.

(d) The Comptroller may examine the request referred to in paragraph (1) for compliance with the conditions under Article 4*bis* (1) of the Protocol.

(2) Where the Comptroller has taken note of an international registration in accordance with paragraph (1)(a), the Comptroller shall notify the International Bureau accordingly. Such notification shall indicate the following:

(a) the number of the international registration in question,

(b) where only some of the goods and services listed

in the international registration are concerned, those goods and services,

(c) the filing date and number of the application for registration of the mark in Malta,

(d) the registration date and number of the registration in Malta,

(e) the priority date, if any, of the registration in Malta.

(3) A national registration or registrations shall not be cancelled or otherwise affected by the fact that they are deemed to be replaced by an international registration or that the Comptroller has taken note in its Register of the latter.

(4) Where all the goods and services listed in the national registration or registrations are not listed in the international registration, the scope of replacement shall be limited to the goods and services listed in the international registration.

67. (1) (a) Where an international registration designating Malta is cancelled at the request of the Office of origin, in accordance with Article 6(4) of the Protocol, for all or some of the goods and services listed in the international registration, an application may be made to the Comptroller, within three (3) months from the date on which the international registration was cancelled, by the person who was the holder of the international registration at the date of its cancellation, for registration of the same trademark ("an application resulting from transformation"), for goods and services covered by the list of goods and services contained in the international registration.

Transformation.

(b) Subject to sub-rules (2) and (3), the provisions applicable to a trademark application filed directly with the Comptroller shall apply *mutatis mutandis* to an application resulting from transformation.

(2) (a) An application resulting from transformation shall be made on the relevant official form and shall, in addition, include the following:

(i) a statement that the application is made by way of transformation;

(ii) the international registration number of the international registration which has been cancelled;

(iii) the date of the said international registration or the date of the subsequent designation, as appropriate;

(iv) the date on which the cancellation of the

international registration was recorded;

(v) where applicable, the date of any priority claimed in the international application and recorded in the International Register.

(b) An application resulting from transformation shall be subject to the payment of the prescribed transformation fees.

(3) (a) Where a mark that is the subject of an international registration has become protected in Malta on or before the date on which the international registration was cancelled and, provided that all the requirements relating to an application resulting from transformation have been met, that trademark shall be registered by the Comptroller. The date of registration shall be the date of the cancelled international registration or the date of the subsequent designation, as appropriate, and that registration shall enjoy any priority enjoyed by the cancelled international registration.

(b) Where a mark that is the subject of an international registration has not yet become protected in Malta on or before the date on which the international registration was cancelled, any procedures or measures already undertaken on or before the date on which an application resulting from transformation is filed for the purpose of the international registration shall be considered as having been undertaken for the purposes of the application resulting from transformation. The filing date of the application resulting from transformation shall be the date of the international registration or the date of the subsequent designation, as appropriate.

Renewal of international registrations designating Malta.

68. International registrations which, in accordance with Article 7 of the Protocol, have been renewed in respect of Malta as a designated Contracting Party shall continue to have effect in Malta.

Recordings in the international register.

69. (1) Any recording made in the International Register concerning an international registration, shall, to the extent that it applies to Malta as a designated Contracting Party, have the same effect as if it had been recorded by the Comptroller in the Register.

(2) Where, under the laws of Malta, the Comptroller considers that the recording referred to in sub-rule (1) has no effect in Malta, the Comptroller shall, where so provided for in the Regulations under the Protocol, send a communication to the International Bureau to this effect, in accordance with rules 70 and 71.

Declaration that a change in ownership in an international registration has no effect in Malta.

70. (1) Where the Office is notified by the International Bureau of a change in ownership of an international registration affecting Malta, the Comptroller may declare that the change in ownership has no effect in Malta. The effect of such a declaration shall be that, with respect to Malta as the designated Contracting Party, the international registration concerned shall remain in the name of the

transferor.

(2) The declaration referred to in sub-rule (1) shall indicate:

- (a) the reasons for which the change in ownership has no effect;
- (b) the corresponding essential provisions of the law; and
- (c) whether such declaration may be subject to review or appeal.

(3) The declaration referred to in paragraph (1) shall be sent to the International Bureau before the expiry of eighteen (18) months from the date on which the notification referred to in sub-rule (1) was sent to the Office.

(4) The holder of the international registration may request a review of the declaration by the Comptroller within a period of sixty (60) days, counted from the date of the notification sent by the International Bureau.

(5) The holder may appoint an agent or attorney to act on their behalf before the Comptroller.

(6) Any final decision relating to a declaration made in accordance with sub-rule (4) shall be notified to the International Bureau.

71. For recording of a licence in an international registration with effect for Malta, articles 39 to 42 of the Act shall apply *mutatis mutandis*.

Licences.

72. (1) Upon receiving a notification from the International Bureau of a correction of an international registration where Malta is designated, the Comptroller may declare in a notification of provisional refusal to the International Bureau that it considers that protection cannot, or can no longer, be granted to the international registration as corrected.

Corrections in the international register.

(2) The Comptroller shall send such declaration within a time limit of eighteen (18) months counted from the date of the notification to Malta by the International Bureau.

PART IV European Union Trademark Rules

73. In this Part:

Interpretation.

"the European Union Trademark Regulation" means Regulation EU 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

- Fees. **74.** The fees to be paid in respect of any application, registration or any other matter under these rules shall be those prescribed in the Schedule of Fees to these rules.
- Determination a posteriori of invalidity and liability to revocation. **75.** (1) Where the proprietor of a European Union trademark claims the seniority of a registered trademark which has been removed from the register under article 58(5) of the Act or has been surrendered under article 60 of the Act, application may be made to the Comptroller or to the court by any person for a declaration that, if the registered trademark had not been so removed or surrendered, it would have been liable to be revoked under article 29 of the Act or declared invalid under articles 5 and 6 of the Act.
- (2) Where a registered trademark has been surrendered in respect of only some of the goods or services for which it is registered, sub-rule (1) shall apply in relation to those goods or services.
- (3) The provisions of articles, 5, 6 or 29 of the Act, as the case may be, articles 97, 99 and 100 of the Act, apply in relation to an application under sub-rule (1).
- Groundless threats of infringement proceedings. **76.** The provisions of article 25 of the Act shall apply in relation to a European Union trademark as in relation to a registered trademark.
- Privilege for communications with professional representatives. **77.** The provisions of article 106 of the Act apply in relation to persons on the list of professional representatives maintained in pursuance of Article 120 of the European Union Trademark Regulation ("professional representatives") and for this purpose the definition of "trademark agent" in article 105 of the Act includes professional representatives.
- Offences. **78.** The provisions of articles 108 to 122 of the Act regarding criminal offences committed in respect of locally registered marks shall apply in relation to a European Union Trademark and for the purposes of those provisions:
- (a) references to a registered trademark shall include a European Union trademark;
- (b) references to goods or services in respect of which a trademark is registered shall include goods or services in respect of which a European Union Trademark is registered.
- Designation of European Union Trademark courts. **79.** For the purposes of Article 123 of the European Union Trademark Regulation, the following courts are designated as European Union trademark courts:
- (a) the First Hall of the Civil Court;
- (b) the Court of Appeal.
- Conversion. **80.** (1) The provisions of this rule shall apply where the

applicant for or the proprietor of a European Union Trademark requests the conversion of his European Union Trademark application or European Union Trademark into an application for registration of a trademark under the Act ("conversion application") pursuant to Article 139 of the European Union Trademark Regulation.

(2) Where the Comptroller decides that a request for a conversion application is admissible pursuant to Article 139 of the European Union Trademark Regulation, it shall be treated as an application for registration of a trademark under the Act.

(3) A decision of the Comptroller in relation to a conversion application shall be treated as a decision of the Comptroller under the Act.

PART V Time Limits

81. (1) The Comptroller may, at the request of the person or party concerned or at the Comptroller's own initiative extend a time or period extend any time limit in these rules where he is satisfied that the failure to do something under these rules was wholly or mainly attributed to a delay in, or failure of, a communication service:

Extension of time limits.

Provided that the request for extension is received before the expiration of said time limit.

(2) Any extension under sub-rule (1) shall be:

(a) made after giving the parties such notice; and

(b) subject to such conditions, as the Comptroller may direct.

(3) In this rule "communication service" means a service by which documents may be sent and delivered and includes post, electronic mail, online submissions and courier.

82. (1) The Comptroller may, at the request of the person or party concerned or at the Comptroller's own initiative extend a time or period prescribed by these Rules or a time or period specified by the Comptroller for doing any act required or authorised by the Act. Any extension under this sub-rule shall be made subject to such conditions as the Comptroller may direct:

Alteration of time limits.

Provided that a request for extension under this rule shall be made before the time or period in question has expired.

(2) The Comptroller, may, in the case of natural phenomena and disasters, at his own discretion, or at the request of the person or party concerned, extend a time or period prescribed by these rules.

SCHEDULE OF FEES

	Schedule of Fees	Euro (€)
1.	On application to register a trademark, for one class of goods or services [rule 4]	115
2.	Notice of opposition [rule 38(5)]	100
3.	Notice of maintaining opposition against the restricted goods and services [rule 40(3)]	100
4.	Notice of maintaining opposition [rule 40(5)(b)]	100
5.	Request for alteration of the proprietor's name and address where this forms part of the registered mark [rule 13]	10
6.	Objection to the alteration of a registered trademark where the alteration consists of the proprietor's name and address when this forms part of the registered trademark [rule 14]	70
7.	Request to be recorded as address for service, request for withdrawal, restriction or amendment of an application or registration [rules 4, 9 and 15]	10
8.	On application to register an assignment of a trademark or any right in it, or to register a merger, for the first mark [rule 16]	55
9.	For each additional request, for the registration of an assignment or for the registration of a merger involving the same parties [rule 16]	10
10.	Fee to register a right in rem For each additional request for the registration of a right in rem submitted in the same application [rule 17]	55 10
11.	Fee to register a levy of execution For each additional request for the registration of a levy of execution submitted in the same application [rule 18]	55 10
12.	On application to register a license [rule 19] and on declaration of division of an application or a registration [rule 20]	55
13.	On application for renewal of the registration of a trademark [rule 21]	90
14.	Additional fee where renewal fee is paid within six months after expiration of 10 years [rule 21]	35
15.	Additional fee for restoration of a trademark where removed for non-payment of fee [rule 21]	70
16.	Request for the recordal of surrender of a registered trademark [rule 22]	90
17.	On application to register a collective mark or a certification mark for one class of goods or services [rules 4 and 23]	115

