

Patent Litigation in Malta

Industrial Property Office

Opposition

No pre-grant or post-grant opposition is available. A pre-grant opposition procedure is foreseen.

Appeal

Decisions refusing the grant of a patent are appealable. Any appeal has suspensive effect (Sect. 58 PA).

- The notice of appeal is to be filed with the Office of the Comptroller of Industrial Property within two months from the notice of the decision concerned. Grounds/reasons must be indicated.
- Within three months the Comptroller may consider the appeal to be admissible and well founded and rectify his previous decision. The applicant should be informed of the rectified decision within a further three-month period; otherwise the applicant may lodge an appeal with the Court of Appeal within two months from the expiration of the two-month period from notification of the decision to be appealed against, or within two months from notification from the Comptroller that he has not rectified his decision, whichever period expires earlier.
- If the Comptroller rectifies his decision in full, no further appeal is available. In the case of partial rectification, the unrectified part is still appealable.

Restoration

In case of non-observance of time limits or non-payment of maintenance fee a request for restoration of rights may be made in writing to the Comptroller within two months from the removal of the cause of non-compliance with the time limit or **within the year immediately following the expiry of the unobserved time limit, whichever is the earlier** (Sect. 46 PA). An appeal against the refusal of an application for restoration can be filed within two months (Sect. 58 PA).

Civil procedure

Infringement

Infringement actions are to be brought before the Civil Court, First Hall (Sect. 48 PA).

- The Court may stay proceedings for infringement in respect of a patent application until a final decision has been made by the Comptroller to grant or refuse a patent on that application.
- The defendant in infringement proceedings may in the same proceedings request the nullification of the patent concerned on any of the grounds for nullification. In such a case the Comptroller will be made a party to the proceedings (Sect. 48 (4) PA).
- Infringement actions become statute-barred after five years from the date on which the aggrieved party became aware of the infringement.
- Patent infringement is also a criminal offence; the procedure may be initiated on complaint (Sect. 50 PA).
- Remedies: injunction, damages, confiscation of the machinery and other means used to infringe the patent, as well as of the infringing articles and the apparatus destined for their manufacture, and their delivery up to the owner of the patent.
- Appeal: further ordinary appeal to the Court of Appeal.

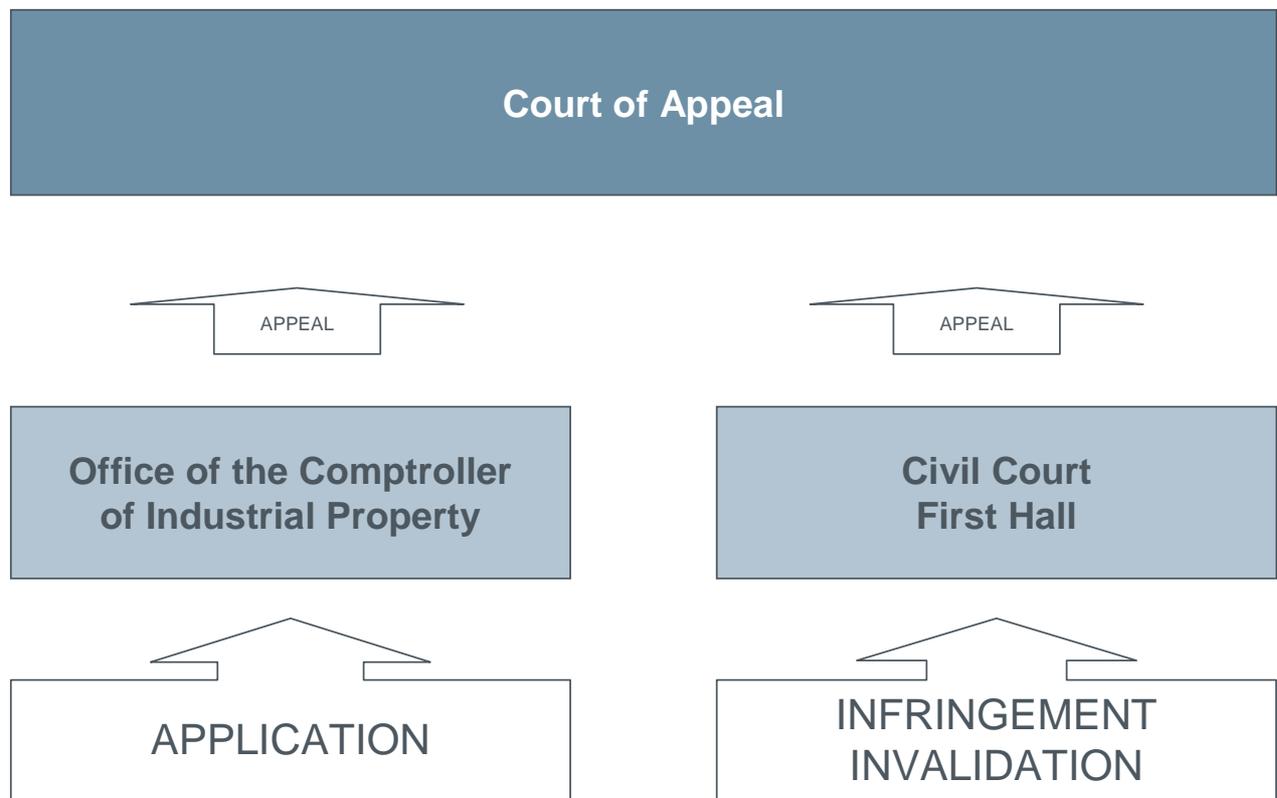
Declaration of non-infringement

Any interested party may institute proceedings before the first Hall, Civil Court against the owner of a patent for a declaration that the performance of a specific act does not constitute an infringement of the patent. Licensees have to be informed of the proceedings by the patentee and have the right to join the proceedings (Sect. 49 PA).

Invalidation

A request for invalidation of a patent may be filed with the Civil Court, First Hall (Sect. 44 PA). Action may be taken during the lifetime of a patent and after the patent has lapsed.

- Invalidation has a retroactive effect (subject to some exceptions – final and enforced decisions prior to the invalidation; contract concluded prior to the invalidation decision, in so far as it has been performed before that decision).
- Partial invalidation is available.



Compulsory licence

May be requested at the Civil Court, First Hall, by any person who proves his ability to work the patent invention in Malta, if the patented invention is not worked or is insufficiently worked in Malta (Sect. 39 PA). The Court will direct the Comptroller to grant a compulsory licence.

- Furthermore, the Minister responsible for IP (at the moment the Minister for Finance, the Economy and Investment) may authorise the licence in cases of national security or public safety (Sect. 40 PA).

Other

Introduction of a Patent Appeal Tribunal is planned.

Bibliography

1. Patents and designs act - to make provision for the registration and regulation of patents and designs. 1st June, 2002, ACT XVII of 2000, as amended by Acts IX of 2003 and XVIII of 2005 [quoted as: PA]
2. "Manual for the Handling of Applications for patents, designs and trademarks throughout the world" Edited by Arnold Siedsma, Kluwer Law International BV 2007, Supplement on Malta, No. 93, December 2002
3. Patents throughout the World, 2008 Thomson Reuters/West, Chapter 110 on Malta, 12/2002