

CHAPTER 417**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; Legal Notices 181 and 186 of 2006, and 426 of 2007; and Act XXX of 2014.

**PART I
DESIGNATION**

1. The short title of this Act is the Patents and Designs Act.

Short title.
*Amended by:
IX. 2003.106.*

**PART II
DEFINITIONS**

2. In Parts II to XVII of this Act unless the context otherwise requires:

Interpretation.
*Substituted by:
IX. 2003.107.
Amended by:
XXX. 2014.2.*

"biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system;

"Budapest Treaty" means the Treaty for the International Recognition of the Deposit of Micro-organisms for the Purpose of Patent Procedure done at Budapest on the 28th April 1977;

"the Comptroller" means the Comptroller of Industrial Property and includes any other person delegated by the Comptroller or appointed by the Minister to exercise all or any of the powers and to perform all or any of the duties of the Comptroller;

"essential biological process for the production of plants and animals" means any process consisting entirely of natural phenomena such as crossing or selection;

"European Patent Convention" means the Convention on the Grant of European Patents, done at Munich on the 5th October 1973, as revised and amended from time to time;

"European Patent Office" or "EPO" means the office of the European Patent Organisation established by the Convention on the Grant of European Patent of the 5th October 1973, as revised and amended from time to time;

"European Union" means the European Union referred on the Treaty;

"microbiological process" means any process involving, or performed upon, or resulting in, microbiological material;

"Member State" means a state which is a member of the European Union;

"Minister" means the Minister responsible for the protection of industrial property and "Ministry" shall be construed accordingly;

"the Office" means the Office headed by the Comptroller of Industrial Property;

"Paris Convention" means the Paris Convention for the Protection of Industrial Property, done at Paris on the 20th March 1883, as revised and amended from time to time;

"patent" means the exclusive right granted by the Comptroller in terms of the provisions of this Act;

"Patent Co-operation Treaty" means the Treaty done at Washington on the 19th June 1970, as revised and amended from time to time;

"plant varieties" refers to all botanical genera and species, including, *inter alia*, hybrids between genera or species;

"prescribed" means prescribed by Parts of this Act;

Cap. 29. "the register" means the register of patents kept under this Act and includes the register of patents kept under the Industrial Property (Protection) Ordinance, parts of which have been repealed by this Act;

"scheduled invention" means an invention of a type listed in regulations as the Minister may from time to time prescribe;

Cap. 460. "the Treaty" has the same meaning assigned to it by the [European Union Act](#);

"variety" means a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety right or patent are fully met, can be:

- defined by the expression of the characteristics that results from a given genotype or combination of genotypes,
- distinguished from any other plants grouping by the expression of at least one of the said characteristics, and
- considered as a unit with regard to its suitability for being propagated unchanged,

where a plant grouping consists of entire plants or parts of plants as far as such parts are capable of producing entire plants.

PART III THE OFFICE OF THE COMPTROLLER

Appointment and duties of Comptroller.

3. (1) The administration of this Act shall be entrusted to the Comptroller of Industrial Property, hereinafter referred to as "the Comptroller".

(2) The Comptroller shall be appointed by the Minister.

**PART IV
PATENTABILITY**

4. (1) Inventions which are new, involve an inventive step and are susceptible of industrial applications, shall be patentable:

Patentable
inventions.
*Amended by:
IX. 2003.108.*

Provided that such inventions shall also be patentable even if they concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used:

Provided further that biological material which is isolated from its natural environment or produced by means of a technical process may be subject of an invention if it previously occurred in nature.

(2) The following, in particular, shall not be regarded as inventions within the meaning of subarticle (1):

- (a) discoveries, scientific theories and mathematical methods;
- (b) aesthetic creations;
- (c) schemes, rules and methods for performing mental acts, playing games or doing business and programs for computers;
- (d) presentations of information.

(3) The provisions of subarticle (2) shall exclude the patentability of the subject matter or activities referred to in that subarticle only to the extent to which a patent application or patent relates to such subject matter or activities as such.

(4) A method for the treatment of the human or animal body by surgery or therapy and a diagnostic method practised on the human or animal body shall not be regarded as an invention capable of industrial application for the purposes of subarticle (1):

Provided that this subarticle shall not apply to products, in particular substances or compositions, for use in any of these methods.

(5) A patent shall not be granted in respect of:

- (a) an invention the exploitation of which would be contrary to public order or morality:

Provided that exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation;

- (b) the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene:

Provided that an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a

natural element;

- (c) processes for cloning the human body, processes for modifying the germ line genetic identity of the human body and uses of the human embryo for industrial or commercial purposes;
- (d) processes and products for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefits to man or animal;
- (e) plant and animal varieties:

Provided that patents shall not be granted for plant varieties only after a new form of plant variety protection is introduced in such form as may be prescribed:

Provided further that a patent may still be granted for a plant variety in respect of which a patent application is still pending on the date that a new form of plant variety protection is prescribed;

- (f) essentially biological process of the production of plants or animals:

Provided that this is without prejudice to the patentability of inventions which concern a microbiological or other technical process or a product obtained by means of such a process;

- (g) DNA sequence not containing any technical information and in particular any indication of its function.

(6) Inventions which concern plants or animals shall be patentable if the technical feasibility of the invention is not confined to a particular plant or animal variety.

(7) The Minister may make regulations to modify any of the provisions of this article other than article (5)(a), (b), (c) and (d) for the purpose of maintaining them in conformity with developments in science and technology.

Novelty.
Amended by:
XXX. 2014.3.

5. (1) An invention shall be considered novel if it does not form part of the prior art.

(2) The prior art means everything which was available to the public in writing or in other graphic form by an oral description, by use or in any other way anywhere in the world before the filing date or, where priority is claimed, before the priority date of the application:

Provided that only the filing date shall be taken into consideration for the purpose of determining prior art, when the claim for priority had been withdrawn or refused or revoked.

(3) The prior art includes also the content of any patent application as filed in, or with effect for, Malta to the extent that such application or the patent granted thereon is published subsequently by or for the Office of the Comptroller:

Provided that the filing date or, where priority is claimed, the priority date of such application is earlier than the date referred to in subarticle (2).

(4) The provisions of subarticles (1) to (3) shall not exclude the patentability of any substance or composition, comprised in the prior art, for use in a method referred to in article 4(4) provided that its use for any method referred to in the said subarticle (4) is not comprised in the prior art.

6. An invention shall be considered to involve an inventive step if, having regard to the prior art as defined in article 5(2), it is not obvious to a person skilled in the art:

Inventive step.

Provided that if the prior art also includes any of the documents referred to in article 5(3) of this Act, these documents are not to be considered in deciding whether there has been an inventive step.

7. An invention shall be considered industrially applicable if it can be made or used in any kind of industry. For the purposes of this article the term "industry" shall be understood in its broadest sense and shall without prejudice to the foregoing include handicraft, agriculture and fishery.

Industrial applicability.

8. For the purposes of article 5 of this Act, a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months preceding the filing of the patent application and if it was due to, or in consequence of -

Disclosure of the invention.

- (a) an evident abuse in relation to the applicant or his legal predecessor, or
- (b) the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognised, international exhibition.

**PART V
RIGHT TO APPLY FOR AND OBTAIN A PATENT AND BE MENTIONED AS INVENTOR**

9. Any natural person or legal entity may file an application for a patent either alone or jointly with another.

Entitlement to file an application.

10. (1) The right to a patent shall belong to the inventor or his successor in title. Joint inventors shall, unless they agree otherwise, have equal rights and where the application for a patent is made by two or more persons jointly, a patent may be granted to them jointly.

Right to a patent.
*Amended by:
XXX. 2014.4.*

(2) Where two or more applications have been filed by different persons in respect of the same invention and the inventors concerned made the invention independently of each other, the right to a patent for that invention shall belong to the applicant whose application has the earliest filing date or, where priority is claimed, the earliest priority date:

Provided that -

- (a) the first application has been published; and

(b) the priority date of an application shall be ignored by the Comptroller when considering the applications in question if:

- (i) the claim for priority is withdrawn;
- (ii) the claim for priority is refused or revoked by the Comptroller or the Patents Tribunal or the Court of Appeal, as the case may be.

(3) For the purpose of proceedings before a Court the applicant shall be deemed to be entitled to exercise the right to a patent.

Invention made in execution of a commission or an employment contract.

11. (1) Notwithstanding the provisions of article 10, when an invention is made in execution of a commission or a contract of employment, the right to a patent for that invention shall belong, in the absence of contractual provisions to the contrary, to the person having commissioned the work or to the employer.

(2) The employee shall have a right to equitable remuneration taking into account his salary, the economic value of the invention and any benefit derived from the invention by the employer. In the absence of agreement between the parties, the remuneration shall be fixed by the Civil Court, First Hall.

Mention of inventor.

12. The inventor shall be mentioned as such in the patent, unless in a special written declaration addressed to the Comptroller he indicates that he wishes not to be named.

PART VI APPLICATIONS

Requirements of application.
Amended by:
IX. 2003.109;
XXX. 2014.5.

13. (1) An application for a patent shall be made in the prescribed form and shall be filed at the Office of the Comptroller and shall contain -

- (a) a request for the grant of a patent;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract of the invention;
- (f) the title of the invention, which shall clearly and concisely state the technical designation of the invention, provided that the requirements stated in paragraphs (a) to (f) shall also apply to applications which are still pending at the time when this paragraph comes into force.

(2) The application shall designate the inventor or, where there are several inventors, all of them. If the applicant is not the inventor, or is not the sole inventor, the applicant shall indicate the legal grounds for his entitlement to file the application.

(3) The application shall be subject to the payment of a filing fee as may be prescribed.

(4) The application shall be drafted in the prescribed language

and shall satisfy any conditions that may be prescribed.

14. (1) The filing date of an application shall be the date of receipt by the Office of the Comptroller of the documents that contain: Date of filing.

- (a) an express or implicit indication that the granting of a patent is sought;
 - (b) indications allowing the identity of the applicant to be established;
 - (c) a description of the invention for which a patent is applied for;
- (2) (a) If the Comptroller finds that, at the time of receipt of an application, the requirements referred to in subarticle (1) have not been fulfilled, he shall invite the applicant to comply with any requirement that has not been satisfied within such time as may be prescribed.
- (b) If the applicant complies with the invitation referred to in paragraph (a), the filing date of the application shall be the date of receipt of all missing requirements. If the applicant fails to comply with such an invitation, the application shall be treated as if it had not been filed.
- (c) Where the description refers to drawings which are not included in the application, the Comptroller shall invite the applicant to furnish the missing drawings within such period as may be prescribed. If the applicant complies with the said invitation, the filing date of the application shall be the date of receipt of the missing drawings. If the applicant fails to comply with the invitation, the filing date shall be the date of receipt of the application and any reference to the drawings shall be deemed as not having been made.
- (3) (a) The indications referred to in subarticle (1)(a) and (b) must be submitted in such language or languages as may be prescribed, hereinafter referred to as the official languages of the Office.
- (b) If any of the description referred to in subarticle (1)(c) or any text contained in any drawings is in a language other than the official languages of the Office, a translation thereof in one of the official languages of the Office shall be deposited at the Industrial Property Office within such time limit as may be prescribed.

15. (1) The application shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

Disclosure of the invention.
Amended by:
IX. 2003.110.

- (2) (a) Where an application refers to an element isolated from the human body or otherwise produced by means of a technical process including the sequence or partial sequence of a gene, the industrial application of a

sequence or a partial sequence of a gene must be disclosed in the patent application.

- (b) When the application concerns a sequence or a partial sequence of a gene used to produce a protein or part of a protein, it is necessary to specify which protein or part of protein is produced or function or sequence it performs.

(3) Where an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in a patent application in such a manner as to enable the invention to be reproduced by a person skilled in the art, the description shall be considered inadequate for the purpose of this Act unless:

- (a) it is supplemented by a deposit of such material with a depository institution as may be prescribed; and

- (b) the application as filed contains such relevant information as is available to the applicant on the characteristics of the biological material deposited.

(4) Access to the deposited biological material shall be provided through the supply of a sample:

- (a) up to the first publication of the patent application, only to those persons who are authorised under this Act;

- (b) between the first publication of the application and the granting of the patent, to anyone requesting it or, if the applicant so requests, only to an independent expert;

- (c) after the patent has been granted, and notwithstanding revocation or cancellation of the patent, to anyone requesting it.

(5) The sample shall be supplied only if the person requesting it undertakes, for the term during which the patent is in force:

- (a) not to make it or any material derived from it available to third parties; and

- (b) not to use it or any material derived from it except for experimental purposes, unless the applicant for or proprietor of the patent, as applicable, expressly waives such an undertaking.

(6) Where an application is refused or is withdrawn, then at the applicant's request, access to the deposited material shall be limited to an independent expert for twenty years from the date on which the patent application was filed, and in such case the provisions of subarticle (5) shall apply.

(7) The applicant's requests referred to in subarticle (4)(b) and in subarticle (6) may only be made up to the date on which the technical preparations for publishing the patent application are deemed to have been completed.

(8) If the biological material deposited in accordance with this article ceases to be available from the recognised depository

institution, a new deposit of the material shall be permitted on the same terms as those laid down in the Budapest Treaty.

(9) Any new deposit shall be accompanied by a statement signed by the depositor certifying that the new deposited biological material is the same as that originally deposited.

16. (1) The claims shall define the matter for which patent protection is sought. Claims.

(2) The claims shall be clear and concise.

(3) The claims shall be supported by such description as may be necessary or as may be prescribed.

(4) The claims shall be presented in the prescribed manner.

17. The abstract shall merely serve the purpose of technical information; in particular, it shall not be taken into account for the purpose of interpreting the claims. Abstract.

18. (1) An application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Unity of invention.

(2) Failure to comply with the requirement of subarticle (1) shall not be a ground for invalidation or revocation of a patent.

19. (1) Until such time as a grant is made pursuant to a pending application, the applicant may divide such pending application into two or more applications ("divisional application"). Division of application.

(2) Any divisional application shall be deemed to have been filed on the filing date of the earlier application and shall have the benefit of any right to priority attaching to such earlier application provided its content does not go beyond the disclosure as filed in the earlier application.

(3) Priority documents and any required translation thereof that are submitted to the Office of the Comptroller in respect of the initial application shall be considered as having been submitted in respect of all divisional applications.

20. (1) The applicant shall have the right, subject to the payment of such fees as may be prescribed, to amend or correct the application, on his own initiative, up to the time when the application is in order for a grant. Amendment or correction and withdrawal of applications.

(2) No amendment or correction of the application may go beyond what has been disclosed in the application as filed.

(3) The applicant may withdraw the application at any time during which it is pending.

21. After a patent application or the patent granted thereon has been published in accordance with article 25, any person may inspect the files of the application in accordance with such regulations as may be prescribed. Inspection of files.

22. (1) The application may contain a declaration claiming Right of priority.

priority pursuant to the Paris Convention for the Protection of Industrial Property, of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in or for any State party to the said Convention or the World Trade Organisation or for any State with which Malta has made an international arrangement for mutual protection of inventions.

(2) Where the application contains a declaration under subarticle (1), the Office of the Comptroller may require that the applicant furnish, within such time as may be prescribed, a copy of the earlier application, certified as correct by the Office or any regional or international organisation with which it was filed.

(3) The effect of the declaration referred to in subarticle (1) shall be such as is provided in the Convention referred to in that subarticle pursuant to which the declaration has been made.

(4) If the Comptroller finds that the requirements under this article and any regulations as may be prescribed have not been fulfilled, he shall invite the applicant to file the required correction within such time as may be prescribed. If the applicant does not comply with the said invitation, the declaration referred to in subarticle (1) shall be deemed not to have been made.

(5) The Minister responsible for the Industrial Property Office, with the concurrence of the Minister responsible for Foreign Affairs, may by order specify the countries with which any international arrangement as is referred to in subarticle (1) are in force and may by subsequent orders amend, revoke or substitute any such order.

PART VII EXAMINATION AND GRANT OR REFUSAL

Examination as to formalities.
Substituted by:
XXX. 2014.6.

23. (1) Where any application for a patent has been filed and not withdrawn, the Office shall determine whether the application complies with the requirements of these articles and any regulations as may be prescribed.

(2) If the Office finds that not all formal requirements have been complied with, the Office shall request the applicant to amend the application as may be prescribed so as to comply with those requirements.

(3) If the applicant fails to make such amendments within the specified time from the date of issue of the request by the Office, the Comptroller shall refuse the application and inform the applicant accordingly.

(4) After eighteen months from the filing date the Office shall publish the application as prescribed:

Provided that where priority is claimed, the Office shall publish the application eighteen months from the priority date unless the priority claim has in the meantime been withdrawn or rejected:

Provided further that the Office shall not publish the application if the application is withdrawn or refused before the

expiration of seventeen months from the filing date:

So however that, where before the expiration of the said period of eighteen months, the applicant presents a written request to the Office of the Comptroller demanding that his application be published, the Office of the Comptroller shall publish the application promptly after the receipt of the request.

23A. (1) The Comptroller shall have the power to request the applicant for a patent to submit a search report accompanied by a reasoned opinion issued by an international search authority recognized by the World Intellectual Property Organisation, as may be determined by the Comptroller.

Submission of search report and written opinion.
Added by:
XXX. 2014.7.

(2) All costs relating to the acquisition of the search report and reasoned opinion shall be borne by the applicant.

24. (1) Where the applicant has been notified pursuant to article 23(3) that his application complies with all the formal requirements, the Comptroller shall on payment of the prescribed fee, grant a patent on the application.

Grant.

(2) As soon as possible after the decision to grant a patent, the Comptroller shall publish a notification that the patent has been granted and shall publish the patent in the prescribed manner.

25. (*Deleted by Act XXX. 2014.8.*)

PART VIIA SCHEDULED INVENTIONS

Added by:
XXX. 2014.9.

25. The provisions of this Part shall apply to all scheduled inventions in respect of which patent protection is sought in Malta.

Applicability of this Part to all scheduled inventions.
Added by:
XXX. 2014.9.

25A. Notwithstanding the provisions of Parts VI and VII in the case of a scheduled invention the provisions of this Part shall apply.

This Part supersedes the provisions of Parts VI and VII.
Added by:
XXX. 2014.9.

25B. Patent protection in Malta for a scheduled invention shall only be possible through a patent granted following an application filed and processed under the Patent Co-operation Treaty or under the European Patent Convention.

Patent protection for scheduled invention.
Added by:
XXX. 2014.9.

PART VIII EFFECTS OF A PATENT APPLICATION AND A PATENT

26. (1) The term of a patent shall be 20 years from the filing date of the application.

Term of patents and maintenance fees.

(2) The maintenance of a patent shall be subject to the payment of the prescribed fee hereinafter referred to as the maintenance fee. Such maintenance fee shall be due in respect of the third year and each subsequent year thereafter calculated from the filing date of the application and shall be paid by not later than the last day of the month of the prescribed due date.

Amended by:
IX. 2003.111;
XVIII. 2005.2.

(3) When a maintenance fee has not been paid on or before the prescribed due date, it may still be validly paid within six months of that date, provided the prescribed surcharge is paid within that period.

Rights conferred
by a patent.
Amended by:
IX. 2003.112.

27. (1) Where the patent concerns a product, the proprietor of the patent shall have the right to prevent third parties from performing, without his authorisation, the following acts:

- (a) the making of a product incorporating the subject-matter of the patent;
- (b) the offering or the putting on the market of a product incorporating the subject-matter of the patent, the use of such product, or the importation or stocking of such product for such offering or putting on the market or for such use;
- (c) the inducing of third parties to perform any of the above acts.

(2) Where the patent concerns a process, the proprietor of the patent shall have the right to prevent third parties from performing without his authorisation, the following acts:

- (a) the use of a process which is the subject matter of the patent;
- (b) in respect of any product directly obtained by the use of the process, any of the acts referred to in subarticle (1)(b), even where a patent cannot be obtained for the said product;
- (c) the inducing of third parties to perform any of the above acts.

(3) The protection conferred by a patent on biological material possessing specific characteristics as a result of the invention shall extend to any biological material derived from that biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

(4) The protection conferred by a patent on a process that enables a biological material to be produced possessing specific characteristics as a result of the invention shall extend to biological material directly obtained through the process and to any other biological material derived from the directly obtained biological material through propagation or multiplication in an identical or divergent form and possessing those same characteristics.

(5) Save as provided in article 4(5)(b), the protection conferred by a patent on a product containing or consisting of genetic information shall extend to all material, in which the product is incorporated and in which the genetic information is contained and performs its function.

(6) Notwithstanding subarticles (1) and (2), the proprietor of a patent shall have no right to prevent third parties from performing the acts referred to in subarticles (1) and (2)(b) in the following circumstances:

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- (a) where the act is done privately and for non-commercial purposes, provided that such act does not significantly prejudice the economic interests of the proprietor of the patent;
 - (b) where the act consists of making or using such product for purely experimental purposes or for scientific research;
 - (c) where the act consists of the extemporaneous preparation for individual cases, in a pharmacy or by a medical or veterinary doctor, of a medicine in accordance with a medical prescription or of acts concerning the medicine so prepared;
 - (d) when an act is done for purposes which can reasonably be related to the development and presentation of information required by the law of Malta or any other country that regulates the production, use or sale of medicinal or phytopharmaceutical products;
 - (e) when the use of the patented invention is on board vessels of the countries of the Union of Paris for the Protection of Industrial Property in the body of the vessel, in the machinery tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of Malta, provided that the invention is used exclusively for the needs of the vessel;
 - (f) when the use of that patented invention is in the construction or operation of aircraft or land vehicles of countries of the Union of Paris for the Protection of Industrial Property or of accessories to such aircraft or land vehicles when such aircraft or vehicles temporarily or accidentally enter the territory of Malta.
- (7) Notwithstanding the provisions of subarticles (3), (4) and (5):
- (a) the sale or other form of commercialization of plant propagation material to a farmer by the holder of the patent or with his consent for agricultural use implies authorization for the farmer to use the product of his harvest for propagation or multiplication by him on his own farm;
 - (b) the sale of any other form of commercialization of breeding stock or other animal reproductive material to a farmer by the holder of the patent or with his consent implies authorization for the farmer to use the protected livestock for an agricultural purpose. Such use includes making the animal or other animal reproductive material available for the purposes of pursuing his agricultural activity. Such use does not include the sale within the framework of or for the purpose of a commercial reproduction activity.
- (8) (a) Subject to paragraph (b), a patent shall also confer on its proprietor the right to prevent third parties from

supplying or offering to supply a person, other than a party entitled to exploit the patented invention, with means, relating to an element of that invention, essential for carrying out the invention, when the third party knows, or ought to know in the circumstances, that those means are suitable and intended for carrying out that invention. The provision of this paragraph shall not apply where such means are staple commercial products and the circumstances of the supply of such products do not constitute inducement to infringe the patent.

(b) Persons performing any acts referred to in subarticle (6)(b), (c), (d), (e), (f) and (g) of shall not be considered to be parties entitled to exploit the invention within the meaning of the preceding paragraph.

(9) (a) The propagation of a patent shall have no right to prevent third parties from performing acts referred to in subarticles (1)(b) and (2)(b) where the act concerns a product which has been put on the market by the proprietor of the patent, or with his express consent, insofar as such as act is performed after that product has been so put on the market.

(b) The protection referred to in subarticles (3), (4) and (5) shall not extend to biological material obtained from the propagation or multiplication of biological material placed on the market by the holder of a patent or with his consent where the multiplication or propagation necessarily results from the application for which the biological material was marketed:

Provided that the material obtained is not subsequently used for other propagation or multiplication.

(c) For the purposes of this subarticle "market" means the market in Malta and from 1st May, 2004, the European Union.

(10) The Minister may make regulations giving effect to any international agreement or obligation entered into by Malta with regard to matters covered by this article and may by such regulations regulate the above rights and limitations to reflect the provisions of any such agreement or obligation.

Rights conferred
by a patent
application after
publication.
*Amended by:
XXX. 2014.10.*

28. (1) A patent application shall, where published under article 23, provisionally confer upon the applicant from the date of such publication the same rights in respect of the subject matter of the application as are conferred by article 27 in respect of the subject-matter of a patent.

(2) A patent application shall be deemed never to have had the effects set out in subarticle (1) if it is withdrawn, or deemed to be withdrawn or finally refused.

29. (1) A patent shall have no effect against any person who in good faith, for the purposes of his enterprise or business, before the filing date, or, where priority is claimed, before the priority date of the application on which the patent is granted, and within Malta was using the invention or was making effective and serious preparations for such use. Any such person shall have the right, for the purposes of his enterprise or business, to continue such use or to use the invention as envisaged in such preparations.

Prior user.

(2) The right of the prior user may only be transferred or may only devolve together with his enterprise or business, or with that part of his enterprise or business in which the use or preparations for use have been made.

30. (1) The extent of the protection conferred by the patent shall be determined by the claims, which are to be interpreted in the light of the description and drawings so as to combine fair protection for the proprietor of the patent with a reasonable degree of certainty for third parties.

Extent of protection.

(2) For the purposes of determining the extent of protection and in accordance with such regulations as may be prescribed, due account shall be taken of elements which at the time of any alleged infringement are equivalent to the elements as expressed in the claims.

(3) For the period up to the grant of the patent, the extent of the protection conferred by a patent application shall be determined by the latest filed claims contained in the publication under article 25. However, the patent as granted or as amended in invalidation proceedings shall determine retroactively the protection conferred by the patent application, in so far as such protection is not thereby extended.

(4) In determining the extent of protection, due account shall be taken of any statement unambiguously limiting the scope of the claims made by the applicant or the proprietor of the patent during procedures concerning the grant or the validity of the patent.

(5) If the patent contains examples of the embodiment of the invention or examples of the functions or results of the invention, the claims shall not be interpreted as limited to those examples.

PART IX ASSIGNMENT OF PATENTS

31. (1) Any contract assigning a patent application or a patent shall, on pain of nullity, be made in writing and shall be signed by the parties to the contract.

Change in ownership of patent applications or patents.

(2) Any change in the ownership of a patent application or a patent shall be recorded in the patent register on payment of the prescribed fee. The new proprietor of the application or patent shall be entitled to institute any legal proceedings concerning the patent only if he has been recorded in the patent register as the new proprietor.

(3) The transfer or assignment of a patent application or patent shall not affect rights acquired by third parties before the date of

such transfer or assignment and shall have effect *vis-à-vis* third parties only after entry thereof is made in the patent register, unless such third parties having acquired rights after the date of the transfer or assignment but before its entry into the register knew of the transfer or assignment at the date on which such rights were acquired:

Provided that where there is a judicial assignment of a patent by order of the Court under article 32 all licences and other rights shall lapse upon the registration of the person entitled to the patent in the patent register except where the former proprietor of the patent or his licensee, before the institution of the legal proceedings, acting in good faith, had used the invention or made effective and serious preparations to do so in which case the former proprietor of the patent or his licensee may continue to use the invention provided he requests within the prescribed time a non-exclusive licence of the patent from the new proprietor whose name is entered in the patent register.

The non-exclusive licence referred to above shall be granted for a reasonable period and upon reasonable terms.

Judicial
assignment of
patent application
or patent.

32. If a patent application is filed or a patent is granted to a person who is not entitled to the patent under article 10 or 11, the person entitled to it may request the Civil Court, First Hall, within two years from the date of publication of such application or patent to order the assignment to him of the patent application or patent:

Provided that if the person who is not entitled to a patent knew at the time when the patent application was filed or granted to him that he was not entitled to the patent, such period of limitation shall not apply in his regard.

Joint ownership of
patent application
or patent.

33. (1) Where there are joint applicants of a patent application, each of them may with or without the agreement of the others separately assign or transfer by succession his share of the application, but the joint applicants may only act jointly to withdraw the application or conclude licence contracts with third parties under the application.

(2) Where there are joint proprietors of a patent, each of them may with or without the agreement of the others separately assign or transfer by succession his share of the patent or institute court proceedings for an infringement of the patent, but the joint owners may only act jointly to surrender the patent or conclude licence contracts with third parties under the patent.

(3) The provisions of this article shall be applicable only in the absence of an agreement to the contrary between the joint applicants or owners.

Patent register.

34. (1) The Comptroller shall maintain a patent register in which patent applications and patents granted shall be recorded.

(2) The patent register shall include such matters constituting or relating to the patent application or patent as may be prescribed and entries of all corrections, amendments, change in ownership or other matters that he is empowered or required by or under this Act

to record. No entry shall be made in the register prior to the publication of the application.

(3) The patent register shall be *prima facie* evidence of all matters directed or authorised by or under this law to be entered therein.

(4) The patent register shall, subject to such regulations as may be prescribed, be open to public inspection.

PART X CONTRACTUAL LICENCES AND LICENCES OF RIGHT

35. (1) A patent application or patent may be licensed in whole or in part for the whole or part of Malta. A licence may be exclusive or non-exclusive. Licence contract.

(2) A licence contract shall in pain of nullity be made in writing and shall be signed by the parties to the contract. For the purposes of this law, "licence contract" means any contract by which a party ("the licensor") allows the other party ("the licensee") to perform any of the acts referred to in article 27 in respect of an invention claimed in a patent or a patent application.

(3) A licence may be recorded in the patent register on payment of the prescribed fee. Article 31(3) shall apply *mutatis mutandis* to the grant or transfer of a licence.

36. (1) In the absence of any provision to the contrary in the licence contract, the agreement given by the licensor to the licensee shall extend to the performance in respect of the invention of all the acts referred to in article 27 without limitation as to time, in the entire territory of Malta, and through any application of the invention. Rights of licensee.

(2) In the absence of any provisions to the contrary in the licence contract, the licensee may not allow a third person to perform in respect of the invention any of the acts referred to in article 27.

37. (1) In the absence of any provision to the contrary in the licence contract, the licensor may allow a third person to perform in respect of the invention any of the acts referred to in article 27 and shall not be prevented from performing them himself. Rights of licensor.

(2) If the licence contract provides that the licence is exclusive, and unless it is expressly provided otherwise in the licence contract, the licensor may neither allow a third party to perform nor perform himself in respect of the invention any of the acts referred to in article 27 which are covered by the said contract.

38. (1) Where the proprietor of a patent files a written statement with the Office of the Comptroller that he is prepared to allow any person to use the invention as a licensee in return for appropriate compensation, the maintenance fees which fall due after receipt of the statement shall be reduced as may by regulations be prescribed. Licences of right.

(2) If no one has informed the proprietor of the patent of his

intention to use the invention, the statement may be withdrawn at any time upon written notification to this effect to the Office of the Comptroller:

Provided that the statement shall be deemed to be withdrawn when following a judicial assignment of a patent by order of the Court under article 32 the name of the person entitled to the patent is entered in the patent register.

(3) The statement may not be filed as long as an exclusive licence is recorded in the patent register.

(4) On the basis of the statement, any person shall be entitled to use the invention as a licensee under such conditions as may be laid down. Any licence so obtained shall be treated as a contractual licence.

(5) No request for recording an exclusive licence in the patent register shall be admissible after the statement has been filed, unless the said statement is withdrawn or be deemed to be withdrawn.

PART XI NON-VOLUNTARY LICENCES AND GOVERNMENT EXPLOITATION

Non-voluntary
licences.
Amended by:
IX. 2003.113;
L.N. 181 of 2006;
L.N. 186 of 2006.

39. (1) The Civil Court, First Hall, may, on a sworn application filed by any person who proves his ability to work the patented invention in Malta, made after the expiration of a period of four years from the date of filing the application for the patent or three years from the grant of the patent, whichever is later, direct the Comptroller to grant a non-exclusive, non-voluntary licence if the patented invention is not worked or is insufficiently worked in Malta.

(2) The grant of the non-voluntary licence shall be subject to the payment of such equitable remuneration to the proprietor of the patent as may be determined by the Civil Court, First Hall, and may be permitted if, prior to the institution of such proceedings, the proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and if such efforts have not been successful within a reasonable period of time.

(3) Notwithstanding subarticle (1), a non-voluntary licence shall not be granted if the Court is convinced that circumstances exist which justify the non-working or insufficient working of the patented invention in Malta.

(4) In deciding whether to grant a non-voluntary licence, the Court shall give both the proprietor of the patent and the person requesting the non-voluntary licence an adequate opportunity to present arguments according to the provisions of the [Code of Organization and Civil Procedure](#).

(5) Any non-voluntary licence shall be revoked when the circumstances which led to its granting cease to exist, taking into account the legitimate interests of the proprietor of the patent and of the licensee. The continued existence of these circumstances

shall be reviewed upon the request of the proprietor of the patent by sworn application before the Civil Court, First Hall.

(6) Article 27(3)(a) of this Act shall be interpreted in the sense that if the patented product is put on the market by a licensee pursuant to a non-voluntary licence, it will not be deemed to have been put on the market with the express consent of the proprietor of the patent.

(7) The scope and duration of a non-voluntary licence shall be limited to the purpose for which it was authorised and shall be:

- (a) non-exclusive,
- (b) non-assignable, except with that part of the enterprise or goodwill which enjoys such authorisation,
- (c) terminated if and when the circumstances which led to it cease to exist, and
- (d) predominantly for the supply of the domestic market.

(8) The Civil Court, First Hall, may on a sworn application filed by the owner of a patent (the second patent) which cannot be exploited without infringing an earlier patent (the first patent), direct the Comptroller to grant a non-exclusive, non-voluntary licence provided that:

- (i) the invention claimed in the second patent shall involved an important technical advance of considerable economic significance in relation to the invention claimed in the first patent;
- (ii) the owner of the first patent shall be entitled to a cross-licence on reasonable terms to sue the invention claimed in the second patent; and
- (iii) the use authorised in respect of the first patent shall be non-assignable except with the assignment of the second patent.

(9) Where a breeder cannot acquire plant variety protection or exploit a plant variety without infringing a prior patent, he may apply to the Civil Court, First Hall, for a compulsory licence for non-exclusive use of the invention protected by the patent in so far as the licence is necessary for the exploitation of the plant variety to be protected, subject to payment of an appropriate royalty. Where such a licence is granted, the holder of the patent will be entitled to a cross-licence on reasonable terms to use the protected variety:

Provided that an applicant for a licence referred to in above shall demonstrate that:

- (a) he had applied unsuccessfully to the holder of the prior patent to obtain a contractual licence;
- (b) the plant variety constitutes significant technical progress of considerable economic interest compared with the invention claimed in the prior patent.

(10) Where the holder of a patent concerning a biotechnological invention cannot exploit it without infringing a prior plant variety

right, he may apply for a compulsory licence for non-exclusive use of the plant variety protected by that right, subject to payment of an appropriate royalty. Where such a licence is granted, the holder of the variety right will be entitled to a cross-licence on reasonable terms to use the protected invention:

Provided that an applicant for a licence referred to in above shall demonstrate that:

- (a) he had applied unsuccessfully to the holder of the prior plant variety right to obtain a contractual licence;
- (b) the invention constitutes significant technical progress of considerable economic interest compared with the plant variety protected by the prior plant variety right.

(11) With regard to plant variety protection subarticles (9) and (10) shall only come into force when the relevant form of plant variety protection comes into force as provided in article 4(5)(e).

Exploitation by Government or by third parties authorised by Government.
Amended by:
L.N. 181 of 2006;
L.N. 186 of 2006.

40. (1) Where the national security or public safety so requires, the Minister may authorise, even without the agreement of the proprietor of the patent or the patent application, by notice published in the prescribed form, a Government agency or a person designated in the said notice to make, use or sell an invention to which a patent or an application for a patent relates, subject to payment of equitable remuneration to the proprietor of the patent or the application for the patent.

(2) The conditions set out in article 39(7) and (8) shall also apply in respect of an authorisation issued by the Minister under this article.

(3) Any decision taken by the Minister under this article may be the subject of an appeal in an action by sworn application before the Civil Court, First Hall.

PART XII AMENDMENTS, SURRENDER AND INVALIDATION

Changes in patents.

41. (1) The proprietor of a patent shall, in accordance with such regulations as may be prescribed, have the right to request the Comptroller to make changes in the patent in order to limit the extent of the protection conferred by it.

(2) The proprietor of a patent shall have the right to request the Comptroller to make changes in the patent in order to correct mistakes or clerical errors, made in good faith.

(3) No such change in the patent may go beyond what has been disclosed in the application as filed.

(4) Where the Comptroller makes changes in a patent he shall publish the changes and the extent thereof and shall record them in the patent register.

Surrender.

42. (1) The proprietor of a patent may surrender the patent in its entirety by written declaration submitted to the Office of the Comptroller. Such surrender shall not have effect until it is entered in the patent register.

(2) A surrender will be entered in the patent register only with the agreement of any third party who has a right in rem recorded in the register or has instituted proceedings under article 32. If a licence is recorded in the register such surrender will only be entered if the proprietor of the patent proves to the satisfaction of the Comptroller that he has previously informed the licensee of his intention to surrender.

43. (1) A patent shall lapse:

Lapse.

- (a) at the end of the term laid down in article 26;
- (b) if the proprietor of the patent surrenders it, on the date when surrender takes effect;
- (c) if a maintenance fee and any surcharge have not been paid in due time, on the date when the maintenance fee was due;
- (d) if the extent of the protection has been limited under article 41, to the extent that the patent is not maintained, on the date when the limitation is entered in the patent register.

(2) The Office of the Comptroller shall record any lapse of the patent in the patent register.

44. (1) Any person who wishes that a patent be revoked may, after publication of the grant of the patent, file a notice for revocation either with the Comptroller or before the Patents Tribunal.

Revocation of a patent.
Amended by:
L.N. 181 of 2006;
L.N. 186 of 2006.
Substituted by:
XXX. 2014.11.

(2) A notice for revocation of a patent filed with the Comptroller may only be made:

- (a) where the patent concerns an invention in respect of which, before the filing date or, where priority is claimed, before the priority date of the application of said patent, there already exists a published patent; or
- (b) in respect of a patent where there is a priority claim, on the grounds that -
 - (i) the application for a patent on the basis of which priority was claimed was originally filed at another Patent Office more than one year before the filing date of the application of the patent in respect of which a notice for revocation has been filed with the Comptroller; and
 - (ii) the application on the basis of which priority was claimed or the resulting patent were published by the other Patent Office referred to in sub-paragraph (i) before the filing date of the application of the patent in respect of which a notice for revocation has been filed with the Comptroller:

Provided that both the grounds in sub-paragraph (i) and sub-paragraph (ii) are cited in the case of a notice for revocation filed under paragraph (b).

(3) A notice for revocation on the above grounds may not be filed with the Patents Tribunal if it has already been filed before the Comptroller and vice versa.

(4) A notice for revocation filed directly before the Patents Tribunal may only be based on the following grounds:

- (a) that the subject matter of the patent is not patentable within the terms of articles 4 to 7;
- (b) that the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art as stipulated in article 15;
- (c) that the right to the patent does not belong to the person to whom the patent was granted within the terms of articles 10 and 11;
- (d) that the subject matter of the patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application, beyond the content of the earlier application as filed subject to any action carried out under articles 20 and 41; and
- (e) that the protection conferred by the patent has been extended by an amendment which should not have been allowed.

(5) A notice of revocation shall include:

- (a) detailed grounds on the basis of which the revocation of the patent is being sought;
- (b) a request for the patent to be revoked.

(6) A notice for revocation before the Comptroller or the Tribunal shall be accompanied by the prescribed fee where such a fee has been prescribed and -

- (a) in the case of a notice of revocation filed on the basis of sub-article (2)(a), it shall also be accompanied by a certified copy of the published patent referred to in that paragraph;
- (b) in the case of a notice of revocation filed on the basis of sub-articles (2)(b) and (4)(a) to (e), it is accompanied by certified copies of documentation substantiating the grounds referred to in the said paragraphs.

(7) Non-compliance with any of the above requirements shall render the notice for revocation inadmissible.

(8) If the grounds for revocation affect the patent only in part, any revocation pronounced shall be in the form of a corresponding limitation of the patent.

(9) A patent and the application on which it is based shall, to the extent that the patent has been revoked, be deemed to have been invalidated and never to have had the effects referred to in articles 27 and 28:

Provided that this shall not affect:

- (a) any decision on infringement which has become final and has been enforced prior to the decision of revocation; or
- (b) any contract concluded prior to the decision of revocation, in so far as it has been performed before that decision, subject to the right on grounds of equity of repayment to an extent justified by the circumstances, of sums paid under the relevant contract.

44A. (1) In the case of a notice of revocation filed with the Comptroller, the latter shall as soon as possible on receipt of said notice and the prescribed fee, if such fee is applicable, forward the notice to the owner of the patent in question at the address of service in Malta and shall inform him that within ninety days from the date of service to him of the notice of revocation he is to file a reply indicating clearly whether he accepts that his patent be revoked:

Procedure following receipt of notice of revocation.
Added by:
XXX. 2014.12.

Provided that, if it appears that the owner of the patent upon whom such a notice of revocation is to be served, is abroad, or that access to his place of service in Malta cannot be obtained, or that his place of service in Malta is not known, the Comptroller may cause without delay a summary of the notice of revocation to be published as may be prescribed. Service shall be deemed to have been made on the third working day after the date of publication. The Comptroller may also adopt such other measures as he may deem fit to serve the owner of the patent with the notice of revocation.

- (2) The reply to the Comptroller shall include:
 - (a) a clear indication of whether or not the owner of the patent is in agreement with the notice for revocation;
 - (b) if the owner of the patent is not in agreement with the notice for revocation, detailed grounds upon which he is basing his disagreement accompanied by certified copies of documentation to which reference is being made.
- (3) Non-compliance with the deadline given by the Comptroller or the above requirements shall render the reply inadmissible.
- (4) The Comptroller shall initiate proceedings before an arbiter to determine the case brought before him after ninety days from the date of service by him of the notice for revocation to the owner of the patent:

Provided that if the owner of the patent informs the Comptroller in writing that he accepts the notice for revocation, the Comptroller shall revoke the application for the patent:

Provided further that where proceedings are initiated before an arbiter, the arbiter shall give his decision within six months from the date of initiation of the said proceedings before him, and in the

event that the arbiter does not conclude the said proceedings within the said time limit of six months the applicant who shall have made the demand for the revocation of the patent shall have a right to demand that the proceedings be transferred to the Patents Tribunal.

(5) On the arbiter reaching a decision the Comptroller shall inform the party requesting the revocation and the patent owner accordingly.

(6) (a) The Comptroller shall duly record the arbiter's decision and shall as soon as possible publish notice of the said decision as may be prescribed.

(b) Any party entering an appeal from the decision of the arbiter shall within ten days from the filing of the said appeal inform the arbiter of that fact.

(c) The notice referred to in paragraph (a) shall be without prejudice to any right of appeal from the decision of the arbiter. Upon a final decision at appeal modifying or revoking the arbiter's decision, the Comptroller shall duly record such decision and publish it as may be prescribed.

Procedure to be adopted by the Patents Tribunal.
Added by:
XXX. 2014.12.

44B. (1) In the case of a notice for revocation filed directly before the Patents Tribunal, the Tribunal shall, as soon as possible upon receiving a notice for revocation of a patent, notify the owner of the patent who shall within ninety days from the date of service file his reply.

(2) The Patents Tribunal shall hear and determine the case for revocation as far as possible within nine months from the date of the institution of the case.

(3) The Patents Tribunal shall regulate its own procedure.

Revocation of a priority claim.
Added by:
XXX. 2014.12.

44C. (1) Any person who wishes that a priority claim be revoked may, after publication of the grant of the patent, file a notice for revocation with the Comptroller.

(2) A notice of revocation of a priority claim may only be filed on the basis that the application for a patent on whose account priority was claimed, was originally filed more than one year before the filing date of the application of the patent in respect of which a notice for revocation has been filed with the Comptroller:

Provided that a notice of revocation of a priority claim may only be filed before the Comptroller.

(3) A notice for revocation of a priority claim shall include:

(a) detailed grounds on the basis of which the revocation of the priority claim is being sought, incorporating references to relevant documentation; and

(b) a request for the priority claim to be refused.

(4) A notice for revocation of a priority claim shall be accompanied by the prescribed fee, where such a fee has been prescribed, and certified copies of any documentation to which reference has been made pursuant to sub-article (3)(a).

(5) Non-compliance with any of the above requirements shall render the notice for revocation of a priority claim inadmissible.

44D. (1) On receipt of a notice for revocation of a priority claim the Comptroller shall, as soon as possible on receipt of the said notice and, if applicable, the prescribed fee, forward the notice to the proprietor of the patent in question at his address of service in Malta and shall inform him that within ninety days from the date of service to him of the notice for revocation of a priority claim he may file a reply indicating clearly whether or not he accepts that the priority claim in question be revoked:

Duties of the
Comptroller after
receiving notice.
Added by:
XXX. 2014.12.

Provided that if it appears that the proprietor of the patent upon whom such a notice for revocation of a priority claim is to be served is abroad, or that access to his place of service in Malta cannot be obtained, or his place of service in Malta is not known, the Comptroller may cause without any delay a summary of the notice for revocation of a priority claim to be published as may be prescribed. In such cases, service shall be deemed to have been made on the third working day after publication. The Comptroller may also adopt such other measures as he may deem fit to serve the proprietor of the patent with the notice for revocation of a priority claim.

(2) The reply to the Comptroller shall include:

- (a) a clear indication of whether or not the owner of the patent is in agreement with the notice for revocation;
- (b) if the proprietor is not in agreement with the notice for revocation, detailed grounds upon which he is basing his disagreement accompanied by certified copies of documentation to which reference is being made.

(3) Non-compliance with the deadline given by the Comptroller, or with the above requirements, shall render the reply inadmissible.

(4) The Comptroller shall initiate proceedings before an arbiter to determine the case brought before him after ninety days from the date of service by him of the notice for revocation of a priority claim to the owner of the patent:

Provided that if the proprietor informs the Comptroller in writing that he accepts the notice of revocation, the Comptroller shall refuse the priority claim:

Provided further that where proceedings are initiated before an arbiter, the arbiter shall give his decision within six months from the date of initiation of the said proceedings before him, and in the event that the arbiter does not conclude the said proceedings within the said time limit of six months the applicant who shall have made the demand for the revocation of the claim for priority shall have a right to demand that the proceedings be transferred to the Patents Tribunal.

(5) On reaching a decision the Comptroller shall inform the person who submitted the notice of revocation, and the owner of the patent accordingly.

- (6) (a) The Comptroller shall duly record the arbiter's decision and shall as soon as possible publish notice of the said decision as may be prescribed.
- (b) Any party entering an appeal from the decision of the arbiter shall within ten days from the filing of the said appeal inform the Comptroller of that fact.
- (c) The notice referred to in paragraph (a) shall be without prejudice to any right of appeal from the decision of the arbiter. Upon a final decision at appeal modifying or revoking the arbiter's decision, the Comptroller shall duly record such decision and publish it as may be prescribed.

Proceedings.
Substituted by:
XXX. 2014.13.

45. (1) An action to revoke a patent may be taken even if the patent has lapsed.

(2) When a decision to revoke a patent, in whole or in part, becomes final before the Patents Tribunal, the Tribunal shall notify the office of the Comptroller which shall as soon as possible record the decision in the patent register and publish such decision as may be prescribed.

(3) When a decision to revoke a patent, in whole or in part, is taken by the arbiter, the Comptroller shall as soon as possible record the decision in the patent register and publish such decision as may be prescribed.

PART XIII RE-ESTABLISHMENT OF RIGHTS

*Rerstitutio in
intergrum.*

46. (1) The applicant for or proprietor of a patent who, notwithstanding having taken all due care required by the circumstances, was unable to observe a time limit set by the Comptroller shall, upon his request, have his rights re-established if the non-observance in question has the direct consequence of causing the refusal of the patent application, or the refusal of a request, or the lapse of the patent, or the loss of any other right or means of redress.

(2) The request shall be filed in writing 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, after the omitted Act has been completed. In the case of non-payment of a maintenance fee, the period specified in article 26(3) shall be deducted from the period of one year.

(3) The request shall state the grounds on which it is based, and shall set out the facts on which it relies. It shall not be deemed to have been filed until after the prescribed fee for the re-establishment of the rights in question has been paid.

(4) This article shall not apply to the time limits referred to in subarticle (2) of this article and in article 22.

(5) The decision to re-establish any rights under subarticle (1) shall be recorded in the patent register.

(6) Any person who in good faith has used or made effective and serious preparations for using an invention which is the subject of a published patent application or a patent in the course of the period between the loss of rights referred to in subarticle (1) and the publication of the decision to re-establish such rights, may without payment continue such use in the course of his business or for the needs thereof.

PART XIV INFRINGEMENT - CIVIL ACTIONS

47. (1) Any person who in contravention to article 27 exploits an invention which is the subject-matter of a patent or patent application shall be liable in damages towards the proprietor of the patent or of a patent application or the licensee.

Act of
infringement -
sanctions.
Amended by:
XXX. 2014.14.

(2) The application to sue for damages under sub-article (1) may be made before the Patents Tribunal without prejudice to the right of such person to apply for the issue of any precautionary warrant as provided in the [Code of Organization and Civil Procedure](#) to protect his rights.

Cap. 12.

(3) The Patents Tribunal may, moreover, on the demand of the plaintiff, order that the machinery or other industrial means or contrivances used in contravention of the patent, the infringing articles, and the apparatus destined for their production, be forfeited, wholly or partially, and delivered up to the proprietor of the patent or of the patent application, without prejudice to the relief mentioned in this article.

48. (1) Infringement proceedings shall be brought before the Patents Tribunal and may not be instituted after five years from the date when the injured party has obtained knowledge of the infringement and of the identity of the alleged infringer.

Infringement
proceedings.
Substituted by:
XXX. 2014.15.

(2) Where the subject-matter of the patent or the patent application is a process for obtaining a new product, the same product when produced by any other party shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process or the process contained in the patent application. In the assessment of any proof to the contrary by the defendant, the legitimate interests of the defendant in protecting his manufacturing and business secrets shall be taken into account by the Patents Tribunal.

(3) The Patents Tribunal shall stay any proceedings for infringement in respect of -

- (a) a patent application filed with the Comptroller until after a final decision has been made by the Comptroller to grant or refuse a patent on the application;
- (b) a patent application filed at the EPO until after a final decision has been made by the EPO to grant or refuse a patent on the application.

(4) The defendant in any proceedings referred to in this article may, in the same proceedings, request the revocation of the patent

on any of the grounds referred to in article 44. In any such case, the Comptroller shall be made a party to the proceedings.

Declaration of non-infringement.
Amended by:
XXX. 2014.16.

49. (1) Subject to subarticle (4), any interested person shall have the right to request, by instituting proceedings against the proprietor of the patent or of the patent application, that the Patents Tribunal declare that the performance of a specific act does not constitute an infringement of the patent.

(2) If the person making the request proves that the act in question does not constitute an infringement of the patent, the Tribunal shall grant a declaration of non-infringement.

(3) The proprietor of the patent or of the patent application shall notify any licensees of the proceedings. The licensees shall have the right to join in the proceedings in the absence of any provision to the contrary in the licence contract.

(4) If the act in question is already the subject of infringement proceedings, the defendant in the infringement proceedings may not institute proceedings for a declaration of non-infringement.

(5) Save where revocation is requested under article 48(4), proceedings for a declaration of non-infringement may be instituted together with proceedings to revoke the patent.

PART XV INFRINGEMENTS - CRIMINAL ACTIONS

Offences.
Amended by:
L.N. 426 of 2007.

50. (1) Whoever puts into circulation, or sells any article, falsely representing that it is a patented article shall, on conviction, be liable to a fine (*multa*) of not less than two hundred and thirty-two euro and ninety-four cents (232.94) and not more than eleven thousand and six hundred and forty-six euro and eighty-seven cents (11,646.87).

(2) If any person puts into circulation or sells an article having stamped, engraved or impressed thereon or otherwise applied thereto the word "patent", "patented", or any other word expressing or implying that a patent has been obtained for the article, he shall be deemed for the purpose of this article to represent that the article is a patented article.

Where owner of goods is unknown.

51. If the owner of any goods or things, which, if he were convicted of any of the offences referred to in this Part, would be liable to forfeiture, is unknown or cannot be found, any Magistrate if he is satisfied on information on oath that such goods or things by means of which an offence under this Part has been committed are in any house or premises, and that the offender is unknown or cannot be found, may by warrant under his hand direct any officer of the Executive Police to be named in the warrant, to enter any house, premises or place so named therein, and there to search for, seize and remove such goods or things.

Forfeiture of things seized.

52. The goods and things so seized shall be produced before the Court of Magistrates sitting as a Court of criminal judicature, and such Court shall determine whether they are liable to forfeiture under this Act.

53. (1) In the case referred to in article 51 the Court shall order the issue of banns which shall be published twice, with an interval for at least eight days, in the Government Gazette, and posted up at the entrance of the building wherein the court sits, and in any other place which the court may deem fit, stating that the goods or things seized shall be forfeited, unless at the time and place named in the banns the proprietor of such goods or things or other person interested in such goods or things attends before the court and shows cause to the contrary.

Procedure where owner is unknown.

(2) If the owner or any person on his behalf, or other person interested in the said goods or things, fails to attend at the time and place named in the banns to show cause to the contrary, it shall be lawful for the Court to direct that such goods or things or any of them be forfeited.

54. The Court may direct that the goods or things so forfeited be destroyed or disposed of, and may also direct that, out of the net proceeds which may be realised by the disposal of such goods or things and up to the amount thereof, any persons who, being in good faith, were injured by the forfeiture, be awarded compensation for any loss caused to them.

Award of compensation to parties in good faith.

55. Criminal actions under this Act shall be barred by the lapse of three years from the day on which the act constituting the offence was committed, if the person to whose prejudice the act was committed, had no previous knowledge thereof; in all other cases the period of limitation shall be one year from the day on which such person became aware of that act.

Limitation of criminal actions.

56. The provisions of article 50 to article 55 shall apply without prejudice to the payment of damages to persons entitled thereto.

Right to damages not affected.

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

Employer and employee.

PART XVI RIGHT OF APPEAL

58. (1) An appeal, which shall have suspensive effect, may be made from a decision of the Comptroller or the arbiter, as applicable, where the decision consists of:

Right of appeal.
*Substituted by:
XXX. 2014.17.*

- (a) a refusal of a patent, in which case the appeal may be made only by the applicant;
- (b) a refusal of a notice for revocation of a patent, in which case the appeal may be made only by the person filing the notice;
- (c) an acceptance of a notice for revocation of a patent, in which case the appeal may be made only by the proprietor of the patent;
- (d) a refusal of a notice of revocation of a priority claim,

in which case the appeal may be made only by the person filing the notice;

- (e) an acceptance of a notice of revocation of a priority claim, in which case the appeal may be made only by the proprietor of the patent;
- (f) a refusal of an application for the re-establishment of rights, in which case the appeal may be made only by the proprietor of the patent;
- (g) a refusal of any other request of the patent applicant or patent proprietor, in which case the appeal may be made only by the patent applicant or patent proprietor respectively.

(2) The appeal referred to in sub-article (1) may only be made in the Court of Appeal within thirty days of the date of service of the decision of the Comptroller.

(3) In the case of revocation proceedings initiated directly with the Patents Tribunal in accordance with article 44, any party to the proceedings that feels aggrieved by the decision of the Patents Tribunal may appeal to the Court of Appeal on points of law only by means of an application filed in the registry of that court within thirty days from the date of the decision of the Patents Tribunal.

Cap. 12.

(4) The Court of Appeal shall be constituted in accordance with article 41(6) of the [Code of Organization and Civil Procedure](#).

(5) The Rule-Making Board established under article 29 of the [Code of Organization and Civil Procedure](#) may make rules governing appeals to the Court of Appeal under this Act.

(6) The Court of Appeal may, in regard to costs, make an order in accordance with the provisions of article 223 of the [Code of Organization and Civil Procedure](#).

*Added by:
XXX. 2014.18.*

PART XVIA* THE PATENTS TRIBUNAL

*The Patents
Tribunal.
Added by:
XXX. 2014.18.*

58A. (1) There shall be a Tribunal to be known as the Patents Tribunal, which shall have jurisdiction to hear and determine claims concerning claims for the revocation of a patent, civil claims for infringement, applications for declarations of non-infringement and precautionary actions related to the above, provided that claims for damages arising from any infringement shall continue to be determined by the Civil Court, First Hall.

(2) The Patents Tribunal shall be appointed by the Prime Minister and shall consist of a chairman, who shall be a Judge or a Magistrate, and two other members.

(3) Decisions of the Patents Tribunal shall be delivered by the chairman and shall be taken by simple majority so however that it shall be necessary that the chairman shall be part of that majority.

(4) The chairman and members of the Patents Tribunal shall be appointed for a term of three years and shall be eligible for re-

*in the amendment introduced by Act XXX. 2014.18., this Part was erroneously introduced as Part XVIIIA rather than Part XVIA.

appointment.

(5) The Patents Tribunal shall be independent and shall not act under the direction or control of any other person in the performance of its functions.

(6) The Patents Tribunal shall for the purposes of conducting its proceedings have the same powers as are granted to the Civil Court, First Hall, by or under the Code of Organization and Civil Procedure. In determining any application filed before it, the Patents Tribunal shall give an opportunity to all parties concerned to put forward their evidence and submissions and it may also order the production of any additional expert evidence and secure expert opinion as it may consider necessary. In its decision, the Patents Tribunal shall also decide upon responsibility for the payment of any costs incurred in the proceedings, including the cost of expert evidence or searches or opinions.

Cap.12.

(7) The chairman and members of the Patents Tribunal may be challenged or abstain for any of the reasons for which a judge may be challenged or may abstain in accordance with the Code of Organization and Civil Procedure. In such case, the Prime Minister shall appoint a person having the same qualifications as those of the chairman or member challenged or abstaining, to sit in substitution.

Cap.12.

(8) A member of the House of Representatives, or of the European Parliament, or of a local council, shall be disqualified from being appointed or continuing to be a member of the Patents Tribunal for as long as such member holds that office.

(9) The chairman or member of the Patents Tribunal may only be removed from office by the Prime Minister on grounds of gross negligence, conflict of interest, incompetence, or acts or omissions unbecoming of a member of the Patents Tribunal. In doing so, the Prime Minister shall lay before the House of Representatives a statement giving the reasons for the removal of the said chairman or member.

(10) The chairman or a member of the Patents Tribunal shall, for a period of one year following the termination, for whatever reason, of his appointment, not engage in any activity which, because of conflict of interest, would have been incompatible with the exercise of his functions. Any person who acts in breach of the provisions of this sub-article shall be guilty of an offence against this Act and shall, on conviction, be liable to a fine (*multa*) of not more than two thousand and five hundred euro (€2,500) and shall be barred from being appointed to any similar posts for a period of not less than ten years.

(11) The Prime Minister shall designate a person to serve as secretary to the Patents Tribunal, who shall serve in such capacity in accordance with the ethical standards appropriate to his position.

(12) The Prime Minister shall appoint an advocate or a legal procurator to assist the Patents Tribunal.

(13) The registry of the Civil Court, First Hall, shall be the registry of the Patents Tribunal.

(14) The Minister responsible for justice may, by regulations under this article, establish the fees payable in the registry of the court in relation to the filing of judicial acts in connection with proceedings under this article and article 23A:

Cap. 12. Provided that until such fees are so established, the fees in Schedule A of the Code of Organization and Civil Procedure shall apply.

Cap. 12. (15) The Board established under article 29 of the Code of Organization and Civil Procedure may make Rules of Court governing proceedings before the Patents Tribunal.

The arbiter.
Added by:
XXX. 2014.18.

58B. (1) For the purposes of this Act, the Minister may appoint one or more persons to serve as arbiters in cases that may be referred to them from time to time, so however that:

- (a) in all cases the person so appointed shall have held a warrant to practise the profession of advocate in Malta for at least seven years; and
- (b) the appointment shall be for a period of three years and may be renewed.

(2) The arbiter shall, before entering upon his duties, take an oath of office before the Attorney General in the form approved by the Minister.

(3) (a) The arbiter shall have the power to take expert advice when necessary, at his discretion, and to summon any person to appear before him to give evidence on oath and, or to produce documents; and for these purposes he shall have the powers which are conferred by law on the First Hall of the Civil Court.

(b) Every summons shall be signed by the arbiter and shall be served either personally or by registered post, and in the latter case, in proving service, it shall be sufficient to prove that the summons was properly addressed and posted.

(4) The Comptroller or his representative shall be entitled to appear and be heard in any proceedings before the arbiter.

Cap. 12. (5) The arbiter shall abstain from taking cognizance of a case or may be challenged in any of the circumstances in which a judge would abstain or can be challenged in accordance with the provisions of article 734 of the Code of Organization and Civil Procedure and in every such case the provisions of Sub-Title II of Title II of Book Third of that Code shall apply so far as applicable.

(6) The arbiter shall have jurisdiction to hear and determine claims made in terms of article 44(2).

Liability.
Added by:
XXX. 2014.18.

58C. The Comptroller, the arbiter and the chairman and members of the Patents Tribunal shall not be held liable for any act or omission done in good faith in the course of the exercise of their functions under this Act.

**PART XVII
MISCELLANEOUS**

59. (1) The Minister may from time to time make regulations not inconsistent with this Act prescribing all matters which by this Act are required or permitted to be prescribed or which are necessary or desirable to be prescribed for carrying out or giving effect to this Act, or for the conduct of any business relating to the Office of the Comptroller including the fees payable to the Government as may be prescribed under this Act. Regulations.

(2) The Minister may also make regulations giving effect in Malta to the provisions of an international or regional patent registration instrument or any related agreements to which Malta becomes a party.

60. The Minister responsible for justice may by regulations establish fees payable in the registries of the Courts of Malta and Gozo for the filing of appeals before the Court of Appeal under this Act, and until such fees are established the tariff or registry fees annexed to the [Code of Organization and Civil Procedure](#) shall apply. Fees.
Cap. 12.

61. (1) Where by this Act any act has to be done by or to any person in connection with any proceeding or matter under this Act, the act may under and in accordance with the regulations be done by or to an agent of that person duly authorised in the prescribed manner. Agents.
*Amended by:
IX. 2003.114.*

(2) Where an applicant does not have his ordinary residence or principal place of business in Malta, he shall authorise in the prescribed manner an agent who has his ordinary residence or principal place of business in Malta, to represent him:

Provided that this subarticle shall not apply as from the 1st May 2003 in respect of an applicant who has his ordinary residence or principal place of business in any Member State.

62. (1) Part I of the Industrial Property (Protection) Ordinance (hereinafter in this article called "the repealed law") and every reference to patents in Part IV, Part V and Part VI thereof are hereby repealed. Repeal and transitional provisions.
*Amended by:
IX. 2003.115.
Cap. 29.*

Provided article 17 shall remain in force in respect of designs and trademarks until such time that the provisions contained in Part II and Part III are repealed.

(2) Any patent the term of which, upon the coming into force of this Act, has expired under the Industrial Property (Protection) Ordinance shall not be reactivated under or by virtue of the provisions of this Act.

(3) Where an application for the registration of a patent has been filed before the coming into force of the Act, the provisions of the Industrial Property (Protection) Ordinance shall, notwithstanding the repeal of the same by this Act, continue to apply thereto. Provided that upon the granting of any such patent the provisions of this Act shall apply thereto.

(4) Where an application for the registration of a patent has been filed before the coming into force of this Act any registration of a patent granted pursuant to such an application shall, notwithstanding any other of the provisions of this Act, be subject to being deemed null or to being annulled only in accordance with the provisions of Title V of Part I of the Industrial Property (Protection) Ordinance as in force before the coming into force of the Act.

(5) Any patent registered under the Industrial Property (Protection) Ordinance before the coming into force of this Act, the term of which has not upon the coming into force of this Act, lapsed, shall enjoy the term of protection of the duration stipulated under this Act and shall benefit from any rights granted in respect of patents under this Act:

Provided that in the case of a patent which has been registered, by virtue of the Industrial Property (Protection) Ordinance, before the coming into force of this Act and which has been granted an extension of not more than five years in accordance with the provisions of Title II of Part I of the same Ordinance, that patent shall enjoy, from the date of the filing of application for the patent, the term of protection of the duration stipulated under this Act and shall benefit from any rights granted in respect of patents under this Act:

Provided further that in the case of a patent which has been registered, by virtue of the Industrial Property (Protection) Ordinance, before the coming into force of this Act and which has been granted an extension of not less than seven years and not more than fourteen years, in accordance with the provisions of Title II of Part I of the same Ordinance, that patent shall still benefit from the extension granted and shall benefit from any rights granted in respect of patents under this Act:

Provided further that in the case of a patent which has lapsed and which was granted under the Industrial Property (Protection) Ordinance:

Cap. 29.

- (i) that patent if restored shall, subject to the payment of the maintenance fees, enjoy the term of protection stipulated in this Act from the filing date of the patent application; and
- (ii) the provisions contained in article 46 shall apply when a request for a restoration is made.

(6) Any regulation, order, requirement, certificate, notice, decision, direction, authorisation, consent, application, request or thing made, issued, given or done under the repealed law shall, if in force at the commencement of this Act, insofar as they could have been made, issued, given or done under this Act, continue in force and have effect as if made, issued, given or done under the corresponding provision of this Act.

**PART XVIII
INTERPRETATION**

63. (1) In Parts XVIII to XXIV of this Act, unless the context otherwise requires -

Interpretation.
Added by:
IX. 2003.116.

"complex product" means a product which is composed of multiple replaceable components permitting disassembly and reassembly of the product;

"Comptroller" means the Comptroller of Industrial Property and includes any other person appointed or assigned by the Comptroller to exercise all or any of the powers and perform all or any of the duties of the Comptroller;

"European Union" means the European Union referred to in the Treaty;

"designs" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and, or materials of the product itself and, or its ornamentation;

"Office" means the office responsible for the registration of designs in Malta under the provisions of this Act;

"infringement proceedings" in relation to a registered design, includes proceedings under article 115;

"Locarno Classification" means the Classification contained in the Locarno Agreement establishing an International Classification for Industrial Designs, as revised or amended from time to time;

"made available to public" means made available to the public by the owner of the design or by any other party;

"Member State" means a state which is a member of the European Union;

"Minister" means the Minister responsible for the protection of industrial property;

"Paris Convention" means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time;

"prescribed" means prescribed by this Act or by any regulations made thereunder;

"product" means any industrial or handicraft item, other than a computer program, including *inter alia* intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces;

"publish" means make available to the public, and references to publication in relation to registration, are to publication under article 95(4);

"register" means the register of designs kept under this Act and includes the register of designs kept under the Industrial Property (Protection) Ordinance;

Cap. 29.

Cap. 460. "the Treaty" has the same meaning assigned to it by the [European Union Act](#).

(2) The provisions of Parts II to XVII of this Act do not apply to designs which are regulated by Parts XVIII to XXIV of this Act exclusively.

PART XIX REGISTRABILITY

Property right.
Added by:
IX. 2003.116.

64. A registered design is a property right obtained by the registration of the design under this Act. The proprietor of a registered design has the rights and remedies provided by this Act.

Requirements for
protection.
Added by:
IX. 2003.116.

65. (1) Designs shall be protected by registration, and exclusive rights shall be conferred upon their holders in accordance with the provisions of this Act.

(2) A design shall be protected by a design right to the extent that it is new and has individual character.

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

(a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter, and

(b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

(4) The expression "normal use" within the meaning of subarticle (3)(a) means use by the end user, excluding maintenance, servicing or repair work.

Novelty.
Added by:
IX. 2003.116.

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

Provided that designs whose features differ only in immaterial details shall also be deemed to be identical.

Individual
character.
Added by:
IX. 2003.116.

67. (1) A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority.

(2) In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

Disclosure.
Added by:
IX. 2003.116.

68. (1) For the purpose of applying articles 66 and 67, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these

events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, and as from the 1st May, 2004, within the European Union before the date of filing of the application for registration or, if priority is claimed, the date of priority. The design shall not, however, be deemed to have been made available to the public because of the sole reason that it has been disclosed to a third party under explicit conditions of confidentiality.

(2) A disclosure shall not be taken into consideration for the purpose of applying articles 66 and 67 if a design for which protection is claimed has been made available to the public by the designer, his successor in title, or a third party as a result of information provided or action taken by the designer, or his successor in title and such disclosure took place during the twelve-month period preceding the date of filing of the application or, if priority is claimed, the date of priority.

(3) Subarticle (2) shall also apply if the design had been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

69. (1) A right in a registered design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

Designs dictated by their technical function and designs of inter-connections.

Added by:
IX. 2003.116.

(2) A right in a registered design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.

(3) Notwithstanding subarticle (2), a right in a registered design shall, under the conditions set out in articles 66 and 67, subsist in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

70. A right in a registered design shall not subsist in a design which is contrary to public policy or to accepted principles of morality.

Designs contrary to public policy or morality.

Added by:
IX. 2003.116.

71. (1) The scope of the protection conferred by a right in a registered design shall include any design which does not produce on the informed user a different overall impression.

Scope of protection.

Added by:
IX. 2003.116.

(2) In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

72. (1) Upon registration, a design which meets the requirements of article 65(2) shall be protected by a design right for a period of five years from the date of filing of the application.

Term of protection.

Added by:
IX. 2003.116.

(2) The right holder may have the term of protection renewed in accordance with article 73 for one or more periods of five years each, up to a total term of twenty-five years from the date of filing.

Renewal of
registration.
Added by:
IX. 2003.116.

73. (1) The registration of a design may be renewed at the request of the proprietor, subject to the payment of the prescribed renewal fee:

Provided that the request is made and the fee is paid before the date of expiry and such action be taken not more than six months before such date:

Provided that the request may be made and the fee paid up to six months after the date of expiry, in which case any additional renewal fee as may be prescribed is also paid within that period.

(2) Renewal shall take effect from the expiry of the previous registration.

(3) If the registration is not renewed in accordance with the above provisions, the Comptroller shall remove the design from the register.

Grounds for refusal
of a registration.
Added by:
IX. 2003.116.

74. A design shall be refused registration:

- (a) if the design does not fall within the definition of a design in article 63;
- (b) if it consists of or is significantly made up of the national flag of Malta;
- (c) if it contains a representation of the national flag of Malta and it appears to the Comptroller to be misleading or offensive;
- (d) if it consists of or contains:
 - (i) the arms, or any of the principal armorial bearings of the arms appertaining to the President or to the Roman Catholic Archbishop of Malta, or any insignia or device so nearly resembling such arms or any such armorial bearing as to be likely to be mistaken for them or it,
 - (ii) a representation of the Presidential or Episcopal flags,
 - (iii) a representation of the President or the Archbishop, or any colourable imitation thereof, or
 - (iv) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Presidential or Episcopal patronage or authorisation,

unless it appears to the Comptroller that consent has been given by or on behalf of the President or the Archbishop;
- (e) if it is contrary to public policy or accepted principles of morality; or
- (f) if the applicant for the right in a registered design is not entitled to it under Maltese law.

75. (1) The registration of a design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importation, export or use of a product in which the design is incorporated or to which it is applied, or stocking such a product for such purposes.

Exclusive rights conferred by the design right.
Added by:
IX. 2003.116.

(2) Any reference in this Act to the infringement of a registered design shall be deemed to be a reference to any such infringement of the rights of the proprietor.

(3) The rights of the proprietor have effect from the date of registration reckoned in accordance with article 95(3):

Provided that -

- (a) no infringement proceedings may be begun before the date on which the design is in fact registered, and
- (b) no offence under article 117 shall be committed by anything done before the date of publication of the registration.

76. (1) The rights conferred by the design right upon registration shall not be exercised in respect of:

Limitation of the rights conferred by the design right.
Added by:
IX. 2003.116.

- (a) acts done privately and for non-commercial purposes, or
- (b) acts done for experimental purposes, or
- (c) acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.

(2) In addition, the right conferred by a design right upon registration shall not be exercised in respect of:

- (a) the equipment on ships and aircraft registered in another country when these temporarily or accidentally enter the territory of Malta, or
- (b) the importation into Malta of spare parts and accessories for the purpose of repairing such craft, or
- (c) the execution of repairs on such craft.

77. (1) A registered design shall not entitle the proprietor to prohibit the use of a product in which the design is incorporated or to which the design is applied when the product has been put on the market by the proprietor or with his consent:

Exhaustion of rights.
Added by:
IX. 2003.116.

(2) For the purposes of this article:

"the market" means the market in Malta and as from 1st May 2003, the market in another member state; and

"use" includes the offering, selling, buying or export of the product.

Relationship to other forms of protection.
Added by:
IX. 2003.116.

78. (1) The provisions of Parts XVIII to XXIV of this Act shall be without prejudice to any other provisions of Maltese law relating to unregistered design rights, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability or unfair competition.

Cap. 415.

(2) A design protected by a design right registered in accordance with this Act shall also be eligible for protection under the [Copyright Act](#), as from the date on which the design was created or fixed in any form.

Nature of registered design.
Added by:
IX. 2003.116.

79. A registered design is the personal property of its owner.

Co-ownership of a registered design.
Added by:
IX. 2003.116.

80. (1) Where a registered design is granted to two or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered design.

(2) The following provisions apply where two or more persons are co-proprietors of a registered design, by virtue of subarticle (1) or otherwise.

(3) Subject to any agreement to the contrary, each co-proprietor is entitled, personally or through his agents, to do for his own benefit and without the consent of or the need to account to any other co-proprietor, any act which would otherwise amount to an infringement of the registered design.

(4) Notwithstanding the provisions of subarticle (3), a co-proprietor may not without the consent of the other or others -

- (a) grant a licence to use the registered design, or
- (b) assign or cede control of his share in the registered design.

(5) Infringement proceedings may be brought by any co-proprietor, but a co-proprietor may not, with the leave of the Court, proceed with the action unless the other, or each of the other co-proprietors, is joined in the suit.

A co-proprietor who is thus joined in the suit shall not be liable for any costs in the action.

Nothing in this subarticle affects the making of any precautionary warrant on the application of a single co-proprietor.

(6) Nothing in this article affects the rights and obligations of trustees or personal representatives, or their rights and obligations as such.

Transmission of a registered design.
Added by:
IX. 2003.116.

81. (1) A registered design is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.

It is so transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or other transmission of a registered design may be partial and limited so as to apply in relation to the use of the design in a particular manner or a particular locality.

(3) An assignment of a registered design is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, his personal representative.

(4) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered design as part of the goodwill of a business.

82. (1) On application being made to the Comptroller by a person claiming to be entitled to an interest in or under a registered design by virtue of a registrable transaction, or any other person claiming to be affected by such a transaction, the relevant details of the transaction shall be entered in the register.

Registrations of transactions affecting a registered design.
Added by:
IX. 2003.116.

(2) The following are registrable transactions:

- (a) an assignment of a registered design or any right therein;
- (b) the grant of a licence under a registered design;
- (c) the transfer of a registered design by testamentary disposition;
- (d) an order of a Court or other competent authority transferring a registered design or any right in or under it.

(3) Until an application has been made for registration of a registrable transaction -

- (a) the transaction is ineffective as against a person acquiring in good faith a conflicting interest in the registered design, and
- (b) articles 86 or 87 shall not apply in respect of a person claiming to be a licensee by virtue of the transaction.

(4) Where a person becomes the proprietor or a licensee of a registered design by virtue of a registrable transaction, he shall not be entitled to damages or an account of profits in respect of any infringement of the registered design occurring after the date of the registrable transaction and before the transaction is registered, unless:

- (a) an application for registration of the transaction is made before the end of the period of six months beginning with the date of the transaction, or
- (b) the Court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as possible thereafter.

83. The provisions of articles 79 to 82 apply *mutatis mutandis* in relation to an application for the registration of a design in the same manner as they apply in relation to a registered design.

Application for registration of design as object of property.
Added by:
IX. 2003.116.

84. (1) A licence to use a registered design may be general or limited. A limited licence may, in particular, apply in relation to use of the design in a particular manner or a particular locality.

Licensing of a registered design.
Added by:
IX. 2003.116.

(2) Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest, and references in this Act to doing anything with, or without, the consent of the proprietor of a registered design shall be construed accordingly.

(3) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include a sub-licence or sub-licensee.

Exclusive licences.
Added by:
IX. 2003.116.

85. (1) In Parts XVIII to XXIV of this Act an "exclusive licence" means a licence (whether general or limited) authorising the licensee to the exclusions of all other persons, including the person granting the licence, to use a registered design in the manner authorised by the licence.

(2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

General provisions
as to the rights of
licensees in case of
infringement.
Added by:
IX. 2003.116.

86. (1) The provisions of this article shall apply with respect to the rights of a licensee in relation to infringement of a registered design:

Provided that they shall not apply where or to the extent that, in accordance with article 87(1) an exclusive licensee has a right to bring proceedings in his own name.

(2) A licensee is entitled, unless his licence provides otherwise, to call on the proprietor of the registered design to take infringement proceedings in respect of any matter which affects his interests.

(3) If the proprietor refuses to do so, or fails to do so within two months after being called upon the licensee may bring proceedings in his own name as if he were the proprietor.

(4) Where infringement proceedings are brought by a licensee by virtue of this article, the proprietor shall be joined in the suit.

(5) In infringement proceedings brought by the proprietor of a registered design any loss suffered or likely to be suffered by licenses shall be taken into account by the Court which shall give such directions as it thinks fit with regard to the disposal and distribution of any sum awarded as a remedy for the infringement.

Exclusive licensee
having right and
remedies of
assignee.
Added by:
IX. 2003.116.

87. (1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect or matters occurring after the grant of the licence as it the licence had been an assignment.

Where or to the extent that such provision is made, the licensee shall be entitled, subject to the provisions of the licence and to the following provisions of this article, to bring infringement proceedings in his own name against any person other than the proprietor.

(2) The rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered design; and references in this Act to the proprietor of a registered design relating to infringement shall be construed accordingly.

(3) In an action brought by an exclusive licensee under this article a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered design.

(4) Where proceedings for infringement of registered design are brought by the proprietor or by the exclusive licensee relating to an infringement in respect of which they have concurrent right of action, the proprietor or, as the case may be, the exclusive licensee who are not the plaintiff shall be jointed in the suit.

(5) (a) Where an action for infringement of a registered design relating to an infringement in respect of which the proprietor and an exclusive licensee have concurrent right of action is brought -

(i) the Court shall in assessing damages take into account the terms of the licence, and any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(ii) no account of profits shall be ordered to be made if an award of damages has been made, or an account of profits has been ordered, in favour or either of them in respect of the infringement; and

(iii) the Court shall, if an account of profits has been ordered, apportion subject to any agreement between the proprietor and the exclusive licensee, the profits between them as the Court considers just.

(b) The provisions of this subarticle apply whether action is brought by the proprietor alone, or it is brought by the proprietor and the exclusive licensee; and if they are not both parties the Court may give such directions as it deems fit with regard to the disposal and distribution of any sum awarded as remedy for the infringement.

(6) The proprietor of a registered design shall notify any exclusive licensee who has a concurrent right of action before applying for an order under article 115; and the Court may on the application of the licensee make such order under that article as it thinks fit having regard to the terms of the licensee.

(7) The provisions of subarticles (4) to (6) shall be without prejudice to any agreement to the contrary between the exclusive licensee and the proprietor.

PART XX APPLICATIONS

88. An application for registration of a design shall be filed with the Comptroller in the Maltese or English language and shall contain the following:

- (a) a request for registration of a design;
- (b) the name and address of the applicant;

Application for
registration.
Added by:
IX. 2003.116.

- (c) the design which is the subject of the application;
- (d) the name and address of the agent or representative, in cases where one has been appointed; and
- (e) a declaration claiming priority in cases where the applicant wishes to take advantage of an earlier application.

The application shall be subject to the payment of a fee as may be prescribed.

Date of filing.
Added by:
IX. 2003.116.

89. (1) The date of filing of an application for registration of a design is the date on which the elements prescribed in article 88 are furnished to the Comptroller by the applicant:

Provided that where the elements are furnished on different days, the date of filing shall be the date on which the last element is so furnished.

(2) References in Parts XVIII to XXIV to the date of application for registration shall be construed as a reference to the date of filing of the application.

Classification of designs.
Added by:
IX. 2003.116.

90. (1) Designs shall be classified for the purpose of the registration of designs according to the Locarno Classification.

(2) Any question arising as to the class within which any design falls shall be determined by the Comptroller, whose decision shall be final.

Claim to priority of Convention application.
Added by:
IX. 2003.116.

91. (1) A person who has duly filed an application for protection of a design in a state which is a member of the World Trade Organisation or a party to the Paris Convention, hereinafter in this Act referred to as a "Convention application", or his successor in title, has a right to priority, for the purposes of registering the same design under this Act for which such an application has been filed, for a period of six months from the date of filing of the first such application.

(2) If the application for registration under this Act is made within such six-month period:

- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and
 - (b) the registrability of the design shall not be affected by any use of the same in Malta in the period between that date and the date of the application under this Act.
- (3) (a) Any filing in a state member of the World Trade Organisation or party to the Paris Convention which is equivalent to a regular national filing under its domestic legislation, shall be treated as giving rise to the right of priority.
- (b) For the purposes of this subarticle "regular national filing" means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent application.

(4) A subsequent application concerning the same design as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (the filing date of which is the starting date of the period of priority), if at the time of the subsequent application:

- (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and
- (b) it has not yet served as a basis for claiming right of priority, and the previous application may not thereafter serve as a basis for claiming a right of priority.

(5) Provisions may be made by regulations as to the manner of claiming a right to priority on the basis of a Convention application.

(6) A right to priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently.

92. (1) The Minister may make regulations conferring on a person who has duly filed an application for protection of a design in a country or territory in relation to which the Government of Malta is a party to a treaty, convention, arrangement or engagement for the reciprocal protection of designs, a right to priority, for the purpose of registering the same designs under this Act for any or all of the same goods or services, for a such period as may be specified in the regulations from the date of filing of that application.

Claim to priority from other relevant overseas applications.
Added by:
IX. 2003.116.

(2) Such regulations may make provisions similar to those contained in article 91 in relation to Convention applications or such other provision as appears to the Minister to be appropriate for the purpose of giving effect to the treaty, convention arrangement or engagement.

93. (1) The Comptroller shall examine whether an application for registration of a design satisfies the requirements of this Act.

Examination of application.
Added by:
IX. 2003.116.

(2) If it appears to the Comptroller that the requirements for registration are not met, he shall inform the applicant and give him an opportunity to make representations or to amend the application within such period as the Comptroller may specify.

(3) If the applicant fails to satisfy the Comptroller that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the Comptroller shall refuse the application.

(4) If it appears to the Comptroller that the requirements for registration are met, he shall accept the application as eligible for registration.

Withdrawal, or amendment, of application.

Added by: IX. 2003.116.

94. (1) The applicant may at any time withdraw his application.

(2) An application may be amended, at the request of the applicant, only by correcting -

- (a) the name or address of the applicant,
- (b) errors of wording or of copying, or
- (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the design.

Registration.

Added by: IX. 2003.116.

95. (1) Where an application has been accepted as eligible for registration, the Comptroller shall register the design, unless it appears to him having regard to matters coming to his notice after he accepts the application that it was accepted in error.

(2) A design shall not be registered and the application shall be deemed to be withdrawn unless any fee prescribed is paid within thirty working days from the date of filing.

(3) A design when registered shall be registered as of the date of filing of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

(4) On the registration of a design the Comptroller shall issue to the applicant a certificate of registration, and he shall publish in the Gazette the fact that the design has been registered and is available to be viewed by the public at the Office.

Alteration of registered design.

Added by: IX. 2003.116.

96. (1) A registered design shall not be altered in the register, during the period of registration or on renewal.

(2) Notwithstanding the provisions of subarticle (1), the Comptroller may, at the request of the proprietor, allow the alteration of a registered design where the design includes the proprietor's name or address and the alteration is limited to the alteration of that name or address and does not substantially affect the identity of the design.

(3) Provision shall be made by regulations prescribing the manner of publication of any such alteration and the making of objections by any person claiming to be affected thereby.

Surrender of a registered design.

Added by: IX. 2003.116.

97. (1) A registered design may be surrendered by the proprietor by sending notice to the Comptroller including the name and address of any person having a contractual interest in the design, or any other interest under the Act. The proprietor shall also certify that any such person:

- (a) has been sent not less than ninety days' notice of the proprietor's intention to surrender the design, or
- (b) is not affected, or if affected consents thereto.

Grounds for invalidity of registration.

Added by: IX. 2003.116.

98. (1) The registration of design may be declared invalid on the following grounds:

- (a) if the provisions of article 74 have not been complied with;

- (b) if it does not fulfil the requirements of articles 65 to 70;
- (c) if the design is the same or similar to a prior design which has been made available to the public after the date of filing of the application or, if priority is claimed, after the date of priority, and which prior design is protected from a date prior to the said date by a registered design or an application for a registered design in a territory covered by an international agreement to which Malta is a party;
- (d) if a distinctive sign is used in a subsequent design and the rightholder of the sign has the right to prohibit such use;
- (e) if the design constitutes an unauthorised use of work protected under copyright;
- (f) if the design involved the use of:
 - (i) the armorial bearings, flags or other emblems, and
 - (ii) the abbreviations and names, of international intergovernmental organisations of which one or more Paris Convention countries are members.

(2) The grounds provided under article 74(f) may be invoked only by the person entitled to the right under Maltese law.

(3) The grounds in subarticles (1)(c), (1)(d) and (1)(e) may be invoked solely by the applicant for or the holder of the conflicting right.

(4) The grounds in subarticle (1)(f) may be invoked solely by the entity associated therewith.

(5) When a design has been refused registration pursuant to article 74, or a design right has been declared invalid pursuant to subarticle (1), the design may be registered or the design right maintained in an amended form, if in that form it complies with the requirements for protection and the identity of the design is retained. Registration or maintenance in an amended form may include registration accompanied by a partial disclaimer by the holder of the right in the registered design or entry in the design register of a court decision declaring the partial invalidity of the design right.

99. (1) The following provisions apply where an application for registration of a design is made by a person who is an agent or representative of a person who is the proprietor of the design in a Convention country.

Acts of agent or representative.

Added by:
IX. 2003.116.

Amended by:
L.N. 181 of 2006;
L.N. 186 of 2006.

(2) The proprietor may by sworn application before the First Hall of the Civil Court:

- (a) demand a declaration of invalidity of the registration, or
- (b) demand the rectification of the register in order to substitute his name as the proprietor of the register

design.

(3) The proprietor may restrain any use of the design in Malta which is not authorised by him.

(4) Subarticles (2) and (3) shall not apply if, or to the extent that, the agent or representative shows that his actions were authorised by the proprietor.

(5) An application under subarticle (2) must be made within three years of the proprietor becoming aware of the registration; and no order may be made under subarticle (3) in respect of a use in which the proprietor has not taken action for a continuous period of three years or more.

Effect of
acquiescence.
Added by:
IX. 2003.116.

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

(2) In the case referred to in subarticle (1), where the action is brought on the basis of an earlier registered design or an earlier acquired right the proprietor of the registered design is not entitled to oppose the use of the earlier design or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier design or right may no longer be invoked against his registered design.

PART XXI

ADMINISTRATIVE AND SUPPLEMENTARY PROVISIONS

Maintenance and
content of register.
Added by:
IX. 2003.116.

101.(1)(a) The Comptroller shall maintain a register of designs.

(b) Reference in Parts XVIII to XXIV this Act to "the register" are to that register; and references to registration, in particular, in the expression "registered design", are, unless the context otherwise requires, to registration in that register.

(2) There shall be entered in the register in accordance with this Act:

- (a) registered designs;
- (b) the relevant particulars of registrable transactions affecting a registered design, including:
 - (i) the date of registration as determined in accordance with articles 89 and 95,
 - (ii) the priority date (if any) to be accorded pursuant to a claim to a right to priority made under article 91 or 92,
 - (iii) the name and address of the proprietor, and
- (c) in the case of an assignment of a registered design:
 - (i) the name and address of the assignee, and
 - (ii) the date of the assignment;
- (d) in the case of the grant of a licence under a registered design:

- (i) the name and address of the licensee,
 - (ii) where the licence is limited, a description of the limitation,
 - (iii) where the licence is an exclusive licence, that fact,
 - (iv) the duration of the licence if the same is or is ascertainable as a definite period, and
 - (v) the date on which the entry is made;
- (e) in the case of a court or other competent authority transferring a registered design:
- (i) the name and address of the transferee,
 - (ii) the date of the order, and
 - (iii) the date on which the entry is made;
- (f) in the case of a transfer of a registered design by testamentary disposition, or otherwise by inheritance:
- (i) the name and address of the person in whose favour the testamentary disposition is made, or the inheritance devolves if any, and
 - (ii) the date of the testamentary disposition if any, and of the death of the previous holder;
- (g) in the case of merger, the requirements specified for the registration of an assignment; and
- (h) such other matters relating to registered designs as the Comptroller may deem necessary.

102. (1) Without prejudice to the provision of article 105, the register shall be open for public inspection at the Office during such hours as may be determined by the Office.

Public inspection
of register.
Added by:
IX. 2003.116.

(2) A search in the register may be conducted in respect of a design or designs in one of the following manners:

- (a) an interested person may on payment of the prescribed fee call at the Office and conduct a search for a design or designs. If the person or persons conducting the search request copies of any related record, extracts from the register or copies of the design, whether certified or uncertified, these shall be provided on payment of the prescribed fee;
- (b) an interested person may on payment of the prescribed fee submit a request in writing to the Office for a search to be conducted in respect of a design or designs. If the person or persons requesting the search require copies of any related record, extracts from the register or copies of the design, whether certified or uncertified, these shall be provided on payment of the prescribed fee.

Rectification or correction of the register.

Added by:
IX. 2003.116.
Amended by:
L.N. 181 of 2006;
L.N. 186 of 2006.

103. (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a design.

(2) Provided that an application for rectification may not be made either to the Comptroller or by sworn application against the Comptroller and any person interested before the Civil Court, First Hall:

Provided that if proceedings concerning the registration in question are pending before a Court:

- (a) the application must be made by application before Court in the acts of the proceedings; and
- (b) if the application is made to the Comptroller, he may at any stage of the proceedings direct the applicant to refer the matter to the Court in accordance with subarticle (2).

(3) Except where the Comptroller or the Court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) The Comptroller may, on request by the proprietor of a registered design, or a licensee, enter any change in his name or address as recorded in the register.

(5) The Comptroller may remove from the register any matter appearing to him to have ceased to have effect.

Power to require the use of forms.

Added by:
IX. 2003.116.

104. The Comptroller may require the use of such forms as he may direct for any purpose relating to the registration of a design or any other proceeding before him under this Act.

Information about applications and registered designs.

Added by:
IX. 2003.116.

105. (1) After publication of the registration of a design, the Comptroller shall on request provide a person with such information and permit him to inspect all documents filed or kept at the Office relating to the registered design, as maybe specified in the request.

Any such request must be accompanied by such fee as may be prescribed.

(2) Before publication of registration of a design, documents or information constituting or relating to the application shall not be published by the Comptroller or made available to the public except with the consent of the applicant.

(3) The Comptroller shall not be obliged to permit the inspection of any such document as is mentioned in subarticle (1) above 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.

(4) The right of inspection under subarticle (1) does not apply to:

- (a) any document until fourteen 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 request for information under this article;
- (e) any document issued or received by the Office which Comptroller considers should be treated as confidential;
- (f) any document or part of a document which in the opinion of the Comptroller disparages any person in a way likely to damage him; or
- (g) any document filed with or sent to the Office before the enactment of the Act.

106. (1) Registration by the Comptroller shall not be deemed to be a warranty by him of the validity of the registration of a design under this Act or under any treaty, convention, arrangement or engagement to which Malta is a party.

Exclusion or liability in respect of official acts.
Added by:
IX. 2003.116.

(2) The Comptroller shall not be liable by reason of, or in connection with, any examination required or authorised by this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent to such examination.

(3) No action shall lie against an officer of the Comptroller in respect of any matter for which, by virtue of this article, the Comptroller is not liable.

107. In all legal proceedings relating to a registered design (including proceedings for rectification of the register) the registration of a person as proprietor of a design shall be *prima facie* evidence of the validity of the original registration and of any subsequent assignment or other transmission thereof.

Registration to be *prima facie* evidence of validity.
Added by:
IX. 2003.116.

108. If in proceedings before the Court the validity of the registration of a design is contested and it is found by the Court that the design is validly registered, the Court shall give judgement accordingly.

Certification of validity of contested registration.
Added by:
IX. 2003.116.

109. (1) In proceedings before the Court involving a demand for -

- (a) the revocation of the registration of a design,
- (b) a declaration of the invalidity of the registration of a design, or
- (c) the rectification of the register,

Comptroller's appearance in proceedings involving the register.
Added by:
IX. 2003.116.

the Comptroller shall be notified with the proceedings and shall be entitled to intervene *in statu et terminis*.

(2) Unless otherwise directed by the Court, the Comptroller may, instead of intervening, file in the record of the case a statement in writing signed by him, giving particulars of:

- (a) any proceedings before him in relation to the matter in issue,
- (b) the grounds of any decision given by him affecting it,
- (c) the practice of the Office in like cases, or
- (d) such matters relevant to the issues and within his knowledge as he thinks fit,

and the statement shall be deemed to form part of the evidence in the proceedings.

Appeals from the Comptroller's decision.
Added by:
IX. 2003.116.
Cap. 12.

110. (1) Any decision of the Comptroller under Parts XVIII to XXIV of this Act, may be appealed from, before the Court of Appeal composed in the manner provided in article 41(6) of the [Code of Organization and Civil Procedure](#) by application within fifteen days of service of the Comptroller's decision.

(2) For the purposes of subarticle (1) "decision" means any act, other than such acts as may by regulations be prescribed, done by the Comptroller in exercise of a discretion vested in him by or under this Act.

(3) The Minister with the concurrence of the Minister responsible for Justice may make rules governing appeals to the Court of Appeal under Parts XVIII to XXIV of this Act, and presenting a scale of costs and fees in relation to such appeals.

Business hours.
Added by:
IX. 2003.116.

111. (1) The Comptroller may give directions specifying the hours of business of the Office for the purpose of the transaction by the public of business under this Act, and the days which are business days for that purpose.

(2) Business done on any business day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which not a business day, that time shall be extended to the next business day.

(3) Directions under this article may make different provision for different classes of business and shall be published in the prescribed manner.

Recognition of agents.
Added by:
IX. 2003.116.

112. (1) Where by Parts XVIII to XXIV of this Act any act has to be done by or to any person in connection with any proceeding or matter under the said parts of this Act, the act may under and in accordance with the regulations be done by or to an agent of that person duly authorised in writing:

Provided that the Comptroller may in any particular case require the personal signature or presence of the agent or the person authorising him to act as an agent.

(2) If an applicant does not have his ordinary residence or principal place or business in Malta, he shall authorise an agent who has his ordinary residence or principal place of business in Malta to represent him in the manner as prescribed in subarticle (1):

Provided that this subarticle shall not apply as from the 1st

May 2004 with regard to an applicant who has his ordinary residence or principal place of business in a Member State.

PART XXII INFRINGEMENT

113. (1) Any person who in contravention to article 75 exploits a registered design shall be liable in damages towards the proprietor of the design right or the licensee.

Action for infringement.
Added by:
IX. 2003.116.

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

(3) In an action for infringement all such remedies as are in respect of the infringement of any other property right shall be available to the plaintiff.

114. (1) The Court may, moreover, on the demand of the plaintiff, order that the machinery or other industrial means or contrivances used in contravention of the design, the infringing products, and the apparatus destined for their production, be forfeited, wholly or partially, and delivered up to the proprietor of the design or such other person as the Court may direct, without prejudice to any other remedy.

Order for delivery up of infringing machinery, products or material.
Added by:
IX. 2003.116.

(2) An action for an order under subarticle (1) may not be made after the end of the period of five years from the date on which the infringing products were made except as provided in the following subarticle.

(3) While during the whole or part of that period the proprietor of the registered design is prevented by fraud or concealment from discovering the facts entitling him to take action for an order, an application may be made at any time before the end of the period of five years from the date on which he could with reasonable diligence have discovered those facts.

115. (1) Where infringing goods, material or products have been delivered up in pursuance of an order under article 114, an action by sworn application against any person having an interest in the products may be brought before the Court by any party interested:

Order as to disposal of infringing machinery, products or material.
Added by:
IX. 2003.116.
Amended by:
L.N. 181 of 2006;
L.N. 186 of 2006.

- (a) for an order that they be destroyed or forfeited to such person as the Court may deem fit, or
- (b) for a decision that no such order should be made.

(2) In considering its decision, the Court shall consider whether other remedies available in an action for infringement of the registered design would be adequate to compensate the proprietor and any licensee to protect their interests.

(3) Any person having an interest shall be entitled:

- (a) to appear in proceedings for an order under this article, whether or not he was served with a notice, and

(b) to appeal against any order made, whether or not he appeared at first instance, and any such order shall not take effect until the end of the period within which an appeal may be filed or, if before the end of that period an appeal is so filed, until the final determination or abandonment of the proceedings on the appeal.

(4) Where there is more than one person interested in the products, the Court shall make such order as it thinks fit.

(5) If the Court decides that no order should be made under this article, the person in whose possession, custody or control the products were before being delivered up shall be entitled to their return.

Remedy for
groundless threats
of infringement
proceedings.

Added by:
IX. 2003.116.

Amended by:
L.N. 181 of 2006;
L.N. 186 of 2006.

116. (1) Where a person threatens another with proceedings for infringement of a registered design other than those provided for in this Act, any person aggrieved may bring proceedings for relief under this article by sworn application before the Civil Court, First Hall.

(2) The relief which may be applied for is all or any of the following -

- (a) a declaration that the threats are unjustified,
- (b) an injunction against the continuance of the threats,
- (c) damages in respect of any loss the plaintiff may have sustained by the threats,

and the plaintiff shall be entitled to such relief unless the defendant shows that the acts in respect of which proceedings were threatened constitute, or if done would constitute, an infringement of the registered design concerned.

(3) Where the defendant shows that the acts in respect of which proceedings were threatened constitute or would constitute an infringement of the registered design, the plaintiff shall nevertheless be entitled to relief if he shows that the registration of the design is invalid or liable to be revoked.

(4) The mere notification that a design is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this article.

Unauthorised use
of registered
design.

Added by:
IX. 2003.116.

Amended by:
L.N. 426 of 2007.

117. (1) Any person who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor, in contravention of article 75 exploits a registered design shall be guilty of an offence against this article and shall be liable on conviction to imprisonment for a term not exceeding three years or to a fine (*multa*) of not more than twenty-three thousand and two hundred and ninety-three euro and seventy-three cents (23,293.73) or to both such fine and imprisonment.

(2) It shall be a defence for a person charged with an offence against this article to show that he believed on reasonable grounds that the use of the design in the manner in which it was used, or was to be used, was not an infringement of the registered design.

118. (1) Any person who knowing or having reason to believe that it is false -

- (a) makes, or causes to be made, a false entry in the register of designs; or
- (b) makes, or causes to be made, anything falsely purporting to be a copy of an entry in the register, or
- (c) produces or tenders or causes to be produced or tendered in evidence any such thing,

Falsification of register.
Added by:
IX. 2003.116.
Amended by:
L.N. 426 of 2007.

shall be guilty of an offence against this article.

(2) A person guilty of an offence against this article shall be liable on conviction to imprisonment for a term not exceeding two years or a fine (*multa*) of not more than eleven thousand and six hundred and forty-six euro and eighty-seven cents (11,646.87) or to both such fine and imprisonment.

119. (1) Whoever puts into circulation, or sells any product, falsely representing that a design applied to, or incorporated in any product sold by him is registered, shall be guilty of an offence against this subarticle and, on conviction, be liable to a fine (*multa*) of not less than two hundred and thirty-two euro and ninety-four cents (232.94) and not more than eleven thousand and six hundred and forty-six euro and eighty-seven cents (11,646.87).

Falsely representing a design as registered.
Added by:
IX. 2003.116.
Amended by:
L.N. 426 of 2007.

For the purposes of this article a person who sells a product having stamped, engraved or impressed thereon or otherwise applied thereto the word "registered", or any other word expressing or implying that the design applied to the products is registered, shall be deemed for the purposes of this article to represent that the design applied to the product is registered.

(2) Any person, who after the right in a registered design is expired, marks any product to which the design has been applied with the word "registered", or any word or words implying that there is subsisting right in the design under this Act, or causes any such product to be so marked, shall be guilty of an offence against this subarticle and shall on conviction, be liable to a fine (*multa*) not less than two hundred and thirty-two euro and ninety-four cents (232.94) and not more than eleven thousand and six hundred and forty-six euro and eighty-seven cents (11,646.87).

120. (1) A person shall not without the authority of the President use in connection with any business any device, emblem or title in such a manner as to be calculated to lead to the belief that he is employed by, or supplies goods or services to, the President.

Unauthorised use of certain devices, emblems, etc.
Added by:
IX. 2003.116.
Amended by:
L.N. 426 of 2007.

(2) Any person who contravenes the provisions of subarticle (1) shall be guilty of an offence against this article and shall, on conviction, be liable to a fine (*multa*) of not more than six thousand and nine hundred and eighty-eight euro and twelve cents (6,988.12).

Delivery up of
infringing
machinery, goods,
etc.

Added by:
IX. 2003.116.

121. The Court may, moreover, in the cases referred to in article 117, on the demand of the prosecution, order that the machinery or other industrial means or contrivances used in contravention of the rights of the proprietors of the designs, the infringing products, and the apparatus destined for their production, be forfeited, wholly or in part, and delivered to the holder of the design, without prejudice to any other right to relief under this Act.

Powers of
Magistrates.

Added by:
IX. 2003.116.

122. Pending any proceedings for any one of the offences referred to in this Part, any Magistrate, if he is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of, or in relation to which the offence has been committed, are in any house or premises of the accused, or are in his possession or under his control in any other place, may, by a warrant under his hand, direct any officer of the Police to be named in the warrant, to enter any house, premises or place, also to be named therein, and there to search for, seize and remove such goods or things.

Where owner of
goods is unknown.

Added by:
IX. 2003.116.

123. If the owner of any goods or things, which, if he were convicted of any of the offences referred to in this Part, would be liable to forfeiture, is unknown or cannot be found, any Magistrate may in the like manner and in the circumstances required in article 122 issue the said warrant.

Forfeiture of things
seized.

Added by:
IX. 2003.116.

124. The goods and things so seized shall be produced before the Court of Magistrates sitting as a court of criminal judicature, and such Court shall determine whether they are liable to forfeiture under this Act.

Procedure where
owner is unknown.

Added by:
IX. 2003.116.

125. (1) In the case referred to in article 123, the Court shall order the issue of banns which shall be published twice, with an interval of at least eight days, in the Gazette, and posted up at the entrance of the building wherein the Court sits, and in any other place which the court may deem fit, stating that the goods or things seized shall be forfeited, unless at the time and place named in the banns the owner of such goods or things or other persons interested in such goods or things attends before the Court at the time and place indicated in the banns and shows cause to the contrary. The person from whose possession the goods or things were seized, shall also, where his whereabouts are known, be notified with the banns.

(2) If the owner or any person on his behalf, or other person interested in the said goods or things, fails to attend at the time and place named in the banns to show cause to the contrary, it shall be lawful for the Court to direct that such goods or things or any of them be forfeited.

Award of
compensation to
parties in good
faith.

Added by:
IX. 2003.116.

126. The Court may direct that the goods or things so forfeited be destroyed or disposed of, and may also direct that, out of the net proceeds which may be realized by the disposal of such goods or things and up to the amount thereof, any persons who, being in good faith, were injured by the forfeiture, be awarded compensation for any loss caused to them.

127. Criminal actions under this Act shall be barred by the lapse of three years from the day on which the act constituting the offence was committed, if the person to whose prejudice the act was committed, had no previous knowledge thereof; in all other cases such action shall be barred by the lapse of one year from the day on which such person became aware of that act.

Limitations of criminal actions.
Added by:
IX. 2003.116.

128. The provisions of this Part shall apply without prejudice to the right of any person to claim damages in consequence of any act constituting an offence.

Rights to damages not affected.
Added by:
IX. 2003.116.

129. No proceedings shall be instituted against any person in the service of another person, if, he shows that in good faith, he acted in obedience to the instructions of his employer, and, on being questioned by the Police, gives full information relating to his employer and of the facts of the case as known to him.

Employment and employee.
Added by:
IX. 2003.116.

PART XXIII GENERAL PROVISIONS

130. In any civil proceedings under this Act if a question arises as to the use to which a registered design has been put, the burden of proof that a particular use has been made shall lie on the proprietor.

Burden of proving use of design.
Added by:
IX. 2003.116.

131. Civil actions under Parts XVIII to XXIV of this Act shall be barred by the lapse of five years in all cases in which no other period within which such actions may be brought is fixed in this Act.

Limitations of civil actions.
Added by:
IX. 2003.116.

PART XXIV REGULATIONS

132. (1) The Minister may make regulations for the better administration of Parts XVIII to XXIV of this Act, making such rules as are required by any provisions of the said parts of this Act, prescribing anything authorised or required by any provision to be prescribed, and generally for regulating practice and procedure under the said Parts, and in particular provision may be made:

Power of Minister to make regulations.
Added by:
IX. 2003.116.

- (a) with regard to the interpretation of terms used in the said Parts of this Act;
- (b) with regard to the grant, refusal or surrender of a registered design;
- (c) with regard to the terms of renewal of a registered design;
- (d) with regard to the manner of filing of applications and other documents as well as all respective and other fees under the said Parts of this Act;
- (e) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (f) with regard to the service of documents;
- (g) with regard to matters relating to the register of designs, in particular as to:
 - (i) amendment of registered particulars relating to a

licence so as to reflect any alteration of the terms of the licence, and

- (ii) the removal of such particulars from the register;
- (h) with regard to the classification of registered designs;
- (i) authorising the rectification of irregularities of procedure;
- (j) with regard to procedures, sanctions and anything else relating to the infringement of the provisions of the said Parts of this Act;
- (k) prescribing time limits for anything required to be done in connection with any proceeding under the said Parts of this Act;
- (l) providing for the extension of any time limit so prescribed, or specified by the Comptroller whether or not the time limit has already expired; and
- (m) regulating administrative and other supplementary provisions.

(2) The Minister may also from time to time make regulations not inconsistent with the said Parts of this Act prescribing all matters which by this Act are required or permitted to be prescribed or which are necessary or desirable to be prescribed for carrying out or giving effect to this Act, or for the conduct of any business relating to the Office of the Comptroller.

(3) The Minister may also make regulations giving effect in Malta to the provisions of any international or regional design registration instrument or any related agreements to which Malta becomes a party.

Repeal of
Industrial Property
(Protection)
Ordinance, and
transitory
provision.
Added by:
IX. 2003.116.
Cap. 29.

133. (1) Subject to the provisions of this article, the Industrial Property (Protection) Ordinance is hereby repealed.

(2) In this article:

"existing registered design" means a design, registered under the Industrial Property (Protection) Ordinance immediately before the commencement of Parts XVIII to XXIV of this Act;

"former register" means the register kept under the old law;

"new register" means the register kept under Parts XVIII to XXIV of this Act;

"old law" means the Industrial Property (Protection) Ordinance and any other enactment or rule of law applying to existing registered designs immediately before the commencement of Parts XVIII to XXIV of this Act.

(3) For the purposes of this article -

- (a) an application shall be treated as pending on the coming into force of Parts XVIII to XXIV of this Act, if it was made but not finally determined before such coming into force; and
- (b) the date on which it was made shall be taken to be the

date of filing under the old law.

- (4) Existing registered designs shall, on the commencement of this article, be transferred to the new register and subject to the provisions of this article, shall have effect as if they were registered under Parts XVIII to XXIV of this Act. Existing registered designs.
- (5) Proceedings under the old law which are pending on the commencement of this article shall be dealt with under the Old Law and any necessary alteration pursuant to such proceedings shall be made to the new register. Proceedings under old law.
- (6) (a) Upon the coming into force of this article, articles 75 and 76 of this Act shall apply in relation to, an existing registered design and subject to paragraph (b), article 113 shall apply in relation to any infringement of an existing registered design committed after the commencement of this article. Effects of registration infringement
- (b) After the coming into force of this article, it shall not be an infringement of -
- (i) an existing registered design, or
- (ii) a registered design of which the distinctive elements are the same or substantially the same as those of an existing registered design,
- to continue with any use which did not amount to infringement of the existing registered design under the old law.
- (7) Article 114 shall apply to infringing goods, material or products whether made before or after the commencement of this article. Infringing goods, material or products.
- (8) Article 86 shall apply to licences granted before the commencement of this article, but only in relation to infringement committed after its commencement. Rights and remedies of licensee.
- (9) The provisions of article 80 shall apply as from the commencement of this article to an existing registered design of which two or more persons were immediately before the commencement of this article registered as joint proprietors. Co-ownership of a registered design.
- (10) (a) Article 81 shall apply to transactions and events occurring after the commencement of this article in relation to an existing registered design; and the old law shall continue to apply in relation to transaction and events occurring before its commencement. Assignment, etc., of a registered design.
- (b) Where, before the commencement of this article a person become entitled by assignment or transmission to an existing registered design but has not registered his title, any application for registration of an assignment after its commencement shall be made under article 83.
- (11) Articles 84 and 85 shall apply only in relation to licences granted after the commencement of this article. Licensing of a registered design.
- (12) An application for registration of a design under the old law

which is pending on the commencement of this article shall be dealt with under the old law, and, when registered, the design shall be treated for the purposes of this article as an existing registered design.

(13) (a) In the case of a pending application for registration filed before the commencement of this article the applicant may give notice to the Comptroller demanding to have the registrability of the mark determined in accordance with the provisions of Parts XVIII to XXIV of this Act.

(b) The notice must be accompanied by the appropriate fee and be given no later than six months after the commencement of this article.

(c) Notice duly given shall be irrevocable and shall have the effect that the application shall be treated as if made immediately after the commencement of this article.

(14) The Comptroller may exercise the powers conferred by this Act to ensure that any existing registered designs which do not conform to the system of classification prescribed under article 90 are brought in conformity with such system.

(15) Article 91 shall apply to an application for registration under this Act made after the commencement of this Part notwithstanding that the Convention application was made before commencement.

(16) Articles 72 and 73 shall apply in relation to the registration of a design in pursuance of an application made after the commencement of this article:

Provided that in the case of a design registration under the old law, whose term of protection has not yet expired at the coming into force of this article registration may be renewed as provided for in articles 72 and 73.
