

User Guidelines

1. Introduction

Title of Regulations	Trademark (Amendment) Rules, 2022
Activity to be regulated	The activities to be regulated are certain procedures related to trademark registration and in particular those procedures which need to be followed when submitting a notice for revocation or a notice for declaration of invalidity of a registered trademark before the Office.
Responsible entity	Commerce Department, Ministry for the Economy, European Funds and Lands
Target Audience	The target audience are business (both foreign and local) who have a trademark in Malta or who wish to protect their brand name by means of trademark registration in Malta.

2. Objectives & Purpose of the Legislation

In 2019 the Trademark Act (Cap 597) transposed Directive (EU) 2015/2436 to approximate the laws of the Member States relating to trademarks. In February 2021, regulations were introduced to compliment said Act whilst updating the rules on trademark search and opposition; (S.L. 597.04).

Further to consultations carried out in line with EU obligations, S.L. 597.04 Trademark Rules is now being amended with the aim to:

- Update the current regulations to further clarify and modify existing rules in the Trademark Regulations (S.L. 597.04); and
- Introduce procedures for notice for revocation and notice for declaration of invalidity of a registered trademark. In line with article 45 of Directive (EU) 2015/2436 which provides that *'Without prejudice to the right of the parties to appeal to the courts, Member States shall provide for an efficient and expeditious administrative procedure before their offices for the revocation or declaration of invalidity of a trade mark.'*; such provisions to comply with Article 45 are to be brought into force by 14 January 2023. This requirement is reflected in Article 52 of the Trademark Act (Cap 597). The new Part VI (regulations 83 to 90) of the proposed amendments to the regulations outline the procedure for notice for revocation and notice for declaration of invalidity of a registered trademark in terms of Article 52 of the Act.

3. Commentary on parts and articles (*Salient points*)

Rule	
<p>Amendment 2 – Amends rule 8 of the principal rules</p>	<p>This is an amendment to rule 8 of the Trademark rules. Rule 8 refers to amendments or representations made by the trademark applicant in terms of Article 48(2) of the Act. Following the amendments or representations made by the applicant, the Comptroller shall decide whether to accept or refuse the application or to seek further clarification from the applicant or his representatives or from other sources as may be necessary.</p> <p>This amendment also provides that such clarifications are to be provided to the Office within thirty (30) days from the date of the Comptroller’s request.</p>
<p>Amendment 3 – Amends rule 31 of the principal rules</p>	<p>This is an amendment to rule 31 of the principal rules and provides that when a representative is appointed in respect of a trademark, the representative or the owner of the trademark in question is to provide the office with a power of attorney document, which confirms the appointment of the representative and stipulates the tasks which the representative may undertake in connection with the trademark in question.</p> <p>This amendment also outlines that when the trademark owner wishes to change or add a representative in respect of a trademark he is to submit a request to the Comptroller. It also lists the requirements that are to be included in the request to the Comptroller in the case of replacing or adding a representative.</p>
<p>Amendment 4 – Amends rule 39 of the principal rules</p>	<p>This amendment to rule 39 deletes the words ‘working days’ from the Maltese version. This simplifies matters in practice and also conforms with the English version of this rule as well as with other time frames provided in these rules. However, in order to ensure that there is no reduction in the timeframe, the time period has been increased from 20 to 30 days.</p>

**Amendment 5 –
Amends rule 40 of
the principal rules**

This amendment is substituting the current rule 40 in order to provide clarifications on procedures to be followed in the different circumstances of the trademark applicant's reaction to an opposition and in turn the opposer's response to the applicant's reaction.

Sub-rule (1) lists the alternatives available to the applicant when an opposition has been filed against his trademark.

Sub-rule (2) provides that the opposition shall be closed where the application is withdrawn

Sub-rule (3) of rule 40 provides that when the applicant opts to restrict the application by deleting some or all of the goods or services against which the opposition is directed, he must state which of the goods or services are being deleted, which are being retained and which of the other goods or services (which the opposer did not object to) are being retained.

Sub Rule (4) provides that the above information is to be forwarded to the opposing party who has to inform the office whether he would still like to proceed with the opposition with regard to any of the goods or services which were originally opposed but which may have not been deleted by the applicant. This sub-rule also provides for the circumstances when opposition proceedings will be considered to be closed.

Sub-rule 5 of rule 40 outlines the action which the applicant can take when the opposer decides to sustain the opposition. Thereby this amendment allows the applicant the possibility of filing a counterstatement to the opposition even after having first opted to delete some of the goods or services against which the opposition was directed.

Sub rule 6 provides that the counterstatement is to be sent to the opposer who in turn must confirm whether he is withdrawing or maintaining his opposition. When maintaining his opposition, he is specify the goods or services against which the opposition is being maintained, in the reasoned statement he is required to submit. If the opposer does not inform the office whether he is withdrawing or maintaining the opposition then the opposition will be considered as withdrawn.

	<p>Sub Rule 7 clarifies the procedure to be followed when the parties decide to attempt to reach a friendly settlement within the time period provided in Article 50(2) of the Act. When such a friendly settlement is reached the parties will have a further 20 days to provide the office with a joint statement outlining the details of the friendly settlement. When the joint statement is not submitted to the office or the office is notified that a friendly settlement is not reached, then the opposition will be considered as maintained. However, the applicant may still file a counter-statement and follow the procedure outlined in sub-rule 40(6).</p> <p>Sub-Rule (8) provides that the application shall be deemed abandoned if within the periods provided for in sub-rules (1) and (5) the Office is not informed of any actions taken.</p> <p>Sub Rule (9) provides that opposition proceedings shall be closed when the Office is informed that the application is rejected in parallel proceedings.</p>
<p>Amendment 7 – Adds a new Part to the principal rules</p>	<p>This amendment introduces a new Part VI to the principal rules and this new Part contains another 8 new rules relating to the filing of a notice for revocation and a notice for declaration of invalidity of a registered trademark before the Office.</p> <p>These new rules are the following:</p> <p>Rule 83 outlines the documents and other requirements which are to be submitted to the office when filing a notice for revocation of a trademark based on Article 29 of the Act.</p> <p>Rule 84 outlines the documents and other requirements which are to be submitted to the office when filing a notice for revocation of a trademark based on Article 30 of the Act.</p> <p>Rule 85 provides that a notice of revocation may be submitted either in paper or electronically. In case where this is submitted in paper it is to be submitted in duplicate.</p> <p>Rule 86 outlines the documents and other requirements which are to be submitted to the office when filing a notice for</p>

	<p>declaration of invalidity of a trademark based on Article 5 of the Act.</p> <p>Rule 87 outlines the documents and other requirements which are to be submitted to the office when filing a notice for declaration of invalidity of a trademark based on:</p> <ol style="list-style-type: none"> a. Article 6 (1) to (3)(a) and (b) of the Act in sub-rule (1); b. Article 6 (3)(c) of the Act in sub-rule (3). <p>Rule 88 specifies that a notice for declaration of invalidity may be submitted either electronically or in paper format. In case of the latter this must be submitted in duplicate</p> <p>Rule 89 relates to the processing of the notice for revocation or the notice for declaration of invalidity by the Office and provides that the applicant shall be invited to remedy any deficiency in his application within a specified timeframe.</p> <p>Failure to comply with such timeframe would result in the rejection of the notice for revocation or the notice for declaration of invalidity by the Office.</p> <p>Rule 90 outlines the procedure applied by the Office when the notice for revocation or the notice for declaration of invalidity is considered to be admissible. It specifies that the Office is to inform the owner of the trademark that within a period of 90 days, the owner may either surrender the trademark, restrict the goods or services covered by the trademark or submit a statement against the notice for revocation or the notice for the declaration of invalidity together with any accompanying documents. This amendment then goes on to outline the process to be followed when the owner restricts the goods or services of the trademark and when the owner submits a statement in reply to the notice for revocation or notice for declaration of invalidity.</p>
<p>Amendment 8 – Amends the schedule of fees of the principal rules</p>	<p>Sub-amendments (a) and (b) in amendment 8 serve to make some minor corrections to items 3 and 4 of the schedule of fees in order that these are in conformity with the changes made to rule 40. There are no changes to the fees.</p> <p>Sub-amendment (c) provides for the fee to be paid when requesting to add or replace a representative of a trademark application or a trademark registration.</p>

	Sub-amendments (d) and (e) provide for the fee to be paid for the cancellation or modification of a right in rem or a levy of execution respectively.
Amendment 9 – Adds new items to the schedule of fees of the principal rules	These new fees are being introduced to reflect fees to be paid in relation to Rules 83 to 90 concerning notice for revocation and notice for declaration of invalidity.

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