

TRADEMARKS

Malta



Trademarks

Consulting editors

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Quick reference guide enabling side-by-side comparison of local insights, including legal framework; registration and use; licensing and assignment; enforcement; and recent trends.

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UPDATE AND TRENDS

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LEGAL FRAMEWORK

Domestic law

What is the primary legislation governing trademarks in your jurisdiction?

National trademarks in Malta are primarily regulated by the Trademarks Act (the Act), Chapter 597 of the Laws of Malta, which transposes the provisions of Directive (EU) 2015/2436. This is then supplemented by the Trademark Rules, Subsidiary Legislation 597.04, which itself prescribes the applicable formalities and procedure for inter alia applications and oppositions. Being an EU member state, Regulation (EU) 2017/1001 on the European Union trademark is also directly applicable in Malta, such that registered European Union trademarks are given automatic effect in Malta.

Law stated - 09 August 2023

International law

Which international trademark agreements has your jurisdiction signed?

Malta is a signatory to a number of international conventions and agreements relating to the protection of intellectual and (or) industry property rights. In the context of trademarks, these include the following:

- the Paris Convention for the Protection of Industrial Property; and
- the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights.

At the time of writing, Malta is not yet formally a contracting party to the Madrid Protocol and relies on its EU membership to benefit from the particular advantages offered through the Madrid system.

Law stated - 09 August 2023

Regulators

Which government bodies regulate trademark law?

The Industrial Property Registrations Directorate within the Commerce Department of the Government of Malta is the body responsible for trademarks in Malta. This is headed by the Comptroller of Industrial Property (the Comptroller), who has been entrusted with the administration of the Act and other trademark legislation in Malta.

Law stated - 09 August 2023

REGISTRATION AND USE

Ownership of marks

Who may apply for registration?

Any legal or natural person may apply for trademark registration.

Law stated - 09 August 2023

Scope of trademark

What may and may not be protected and registered as a trademark?

The Act allows applications to be made in Malta for:

- individual trademarks;
- certification marks; and
- collective marks

The Act then sets out their respective conditions of registrability.

In the case of individual trademarks, the Trademarks Act (the Act) establishes that these 'may consist of any signs', in particular, words (including personal names), or designs, letters, numerals, colours, the shape or packaging of goods or sounds, provided that they are:

- distinctive; and
- capable of being represented in the register in a manner that allows for the clear and precise identification of their subject matter.

By design, the wording used is open-ended and thus, any sign (including 'non-traditional' types) could in principle be eligible for trademark registration so long as they meet the requirements of distinctiveness and representation and do not fall afoul of any absolute grounds for refusal. In fact, the Industrial Property Registrations Directorate's (MIPRD) online filing system includes various non-traditional signs as filing options, such as 3D marks, sound marks, pattern marks or hologram marks.

The Act then sets out the absolute grounds for refusal, some of which include:

- signs that cannot constitute a trademark;
- trademarks that are devoid of any distinctive character;
- trademarks that consist exclusively of signs or indications that are descriptive of the intended purpose, value, kind, quality, geographical origin, the time of production or provision or other characteristics of the goods and services concerned;
- signs that consist exclusively of the shape or other characteristic of the goods that results from the nature of those goods, or is necessary to obtain a technical result, or gives them substantial value;
- trademarks that are contrary to public policy or to accepted principles or morality;
- trademarks that are deceptive, such as to the nature, quality or geographical origin of the goods or services concerned;
- trademarks that have not been authorised by the competent authorities and subject to refusal or invalidation pursuant to article 6ter of the Paris Convention on state emblems and hallmarks;
- trademarks that are excluded from registration pursuant to laws in force or otherwise applicable in Malta in relation to designations of origin and geographical indications;
- trademarks that consist of or contain any of the arms or principal armorial bearings appertaining to the President or Roman Catholic Archbishop of Malta or any insignia or device that closely resembles them (unless it is shown that consent has been by or on behalf of the President or Archbishop); and
- trademarks that consist of a representation of the national flag of Malta.

The Act also contains added restrictions relating to trademarks consisting of, or containing national emblems, flags, armorial bearings, official signs or hallmarks of Paris Convention countries, and further stipulates that the approval of the competent authorities of the country in question must be obtained.

An exhaustive list of the absolute grounds for refusal recognised under Maltese law can be found in article 5 of the Act.

Potential refusals relating to non-distinctiveness, descriptiveness or shape marks may be overcome by establishing that the mark acquired a distinctive character through use in Malta prior to its date of filing.

In addition to these grounds, the Act also provides for a number of relative grounds for refusal, which may be raised by third parties to oppose or invalidate a registration.

Law stated - 09 August 2023

Unregistered trademarks

Can trademark rights be established without registration?

The Maltese Commercial Code, Chapter 13 of the Laws of Malta, establishes that rights to an unregistered trademark may be obtained on the basis of prior, lawful use and prohibits persons from using in the course of trade any name, mark or distinctive device that is likely to cause confusion with any other name, mark or distinctive device being lawfully used by another trader, irrespective of whether it has been registered in terms of the Act or not. Similarly, article 6(4) of the Act provides that rights to a non-registered mark can be used as a basis to oppose the registration of a subsequent trademark, or obtain its invalidation, provided they were acquired prior to the date of the application for this subsequent trademark.

Law stated - 09 August 2023

Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

Well-known marks in terms of the Paris Convention are indeed recognised and afforded protection in Malta. 'Well-known' marks, under the Act, are marks that are well-known in Malta and belong to a person who is a national of, or has a real and effective industrial or commercial establishment in, a Convention country. While the mark needs to be well-known in Malta, its proprietor does not actually have to carry on business or have goodwill in Malta.

The proprietor of a well-known mark is entitled under the Act to restrain, by means of an injunction, the use in Malta of a trademark where:

- it, or the essential part of it, is identical or similar to that well-known mark;
- it covers the same goods or services for which that mark is well-known; and
- such use is likely to cause confusion.

Well-known marks can also be used as a basis to oppose or invalidate the registration of a later mark, unless (in the case of invalidation) the proprietor of the well-known mark has acquiesced for a period of five successive years to the use of the later trademark registered in Malta. Acquiescence is, however, excluded where the registration of the later mark was made in bad faith.

The benefits of registration

What are the benefits of registration?

Trademark registration confers various benefits under Maltese law and include the following:

- exclusive rights are granted to the proprietor of the trademark for the use of that mark in connection with the goods and services covered by it;
- the proprietor also obtains a statutory entitlement to oppose the registration of a later-filed trademark based on the relative grounds for refusal as follows:
 - the right to prevent third parties from using, without its consent, any sign, in the course of trade and in relation to goods and (or) services, which is:
 - identical to its trademark and used in relation to goods or services that are identical for those that its trademark is registered; or
 - identical with, or similar to, its trademark and used in relation to goods or services that are identical with, or similar to, the goods or services for which its trademark is registered. This is also subject to an additional requirement that there must exist a likelihood of confusion on the part of the public, which includes the likelihood of association between the marks;
 - where the registered trademark acquires a reputation in Malta, the proprietor may also additionally prevent third parties from using any sign that is similar or identical to its trademark, irrespective of whether that sign is used in relation to goods or services that are identical with, similar or otherwise dissimilar to those for which its trademark is registered. This applies provided that the proprietor is able to show that the use of that sign is without due cause and that, if allowed, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trademark;
- these relative grounds for refusal, as summarised in (1) and (2) above, can be relied upon by the proprietor of a registered trademark to oppose and prevent the registration of a later mark;
- the proprietor of a registered trademark may also, on the basis of such registration, prevent third parties from bringing goods, in the course of trade, into Malta (even if not released for free circulation), where such goods, including their packaging, come from third countries and bear without authorisation a trademark that is identical with its registered trademark in respect of such goods, or that cannot be distinguished in its essential aspects from the registered trademark. This is, however, subject to the proprietor also having a parallel entitlement to prevent the placing of the goods in question on the market in the country of their intended final destination;
- registered trademarks may also be given as security or otherwise made the subject of rights in rem;
- in an enforcement scenario, registration enables the proprietor to institute a civil court action for trademark infringement and claim damages under the Enforcement of Intellectual Property Rights (Regulation) Act, Chapter 488 of the Laws of Malta. On the other hand, in the case of an unregistered trademark, the type of action available is limited to unfair competition under the Commercial Code;
- being able to claim ownership of a registered trademark and produce a registration certificate could serve as useful evidence for facilitating the grant of interim measures, such as provisional injunctions;
- registration also enables the proprietor to record the registered trademark with Customs Malta, the government agency in charge of preventing trademark counterfeiting by monitoring Malta's borders. In that regard, counterfeit actions instituted on the basis of the domestic procedure set out in the Intellectual Property Rights (Cross-Border

Measures) Act, Chapter 414 of the Laws of Malta, are not subject to the rights holder also having parallel trademark protection in the country of destination and as such, registration in Malta is sufficient by itself.

Law stated - 09 August 2023

Filing procedure and documentation

What documentation is needed to file a trademark application? What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

An application for the registration of a trademark must be filed in English or Maltese and contain:

- a request for the registration of the trademark;
- the name and address of the applicant;
- a statement of the goods or services in relation for which registration is sought;
- an acceptable representation of the mark;
- the name and address of the representative or attorney (where appointed);
- where applicable, a declaration claiming priority; and
- payment of the prescribed fee.

When dealing with applications for collective or certification marks, other documents may also be required, including the regulations governing the use of the mark.

Maltese law does not expressly require the submission of a power of attorney where an agent is filing an application on the applicant's behalf. That said, both the applicant and agent may consider it beneficial to have an executed power of attorney in place to document the agent's authority to act on behalf of the applicant in respect of the trademark application and the limits of that authority. Although not required, notarisation or legalisation is recommendable to ensure the document's authenticity.

Searches or inspections of the trademark register are not mandatory, but can be requested in writing by any interested party subject to its payment of the prescribed fee (which is currently set at €10 per class for a search of any mark. Certified copies of any relevant records or extracts can be obtained for a fee of €2).

Law stated - 09 August 2023

Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

The time frame from application to registration is usually about six to eight months, provided that no filing deficiencies or oppositions are encountered. The official fee for an application to register a trademark in one class of goods or services is €115.

The filing date for an application is the date when all of the following elements are submitted:

- a request for the registration of the trademark;
- the name and address of the applicant;
- a statement of the goods or services in relation for which registration is sought; and
- a representation of the mark.

Where any of these elements are omitted, the application will not be accepted and will be returned to the applicant or his or her attorney. On successfully completing the examination stage, the application will be published for opposition purposes, which is subject to a time limit of 90 days from the date of publication.

If an opposition is received by the Comptroller within the allotted time limit, the trademark will not be registered unless that opposition is either withdrawn or refused. The acceptance of an opposition would also result in the application's refusal, although in such case the applicant would have the right to challenge the decision by filing an appeal before the Court of Appeal. The time frame for the registration process would in such case be prolonged accordingly and added costs are likely to be incurred.

Last, where the examiner is required to manually inspect the goods or services that have been specified in the application (eg, because terms were not selected from the list of automatically validated terms), then this could also potentially lengthen the registration process.

Law stated - 09 August 2023

Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The Nice Agreement Concerning the International Categorization of Goods and Services for the Purposes of the Registration of Marks is the classification system currently adopted in Malta. In the case of multi-class applications, it is technically possible to use a single application to file for the same mark in more than one class. With that said, each class will be treated as a separate application in its own right and will be given its own, distinct trademark application number and would undergo its own registration process. A separate application fee of €115 would be payable for each of the classes filed.

Law stated - 09 August 2023

Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

Following its receipt of a trademark application, the MIPRD will then proceed to examine and confirm that the application is complete and contains an acceptable representation of the mark that is the subject of the application and that this mark does not fall foul of any absolute grounds for refusal. The MIPRD will also carry out an ex officio search of the national trademark database to identify any identical or similar applications or registrations already existing on it. These search results are then notified to the applicant and, where there is one, also the earlier rights holder unless the applicant decides to withdraw its application.

If it appears to the Comptroller that the requirements for registration are not met, the applicant will subsequently be informed and provided with the opportunity to make representations or to amend the application within the specified time period. Should the applicant fail to convince the Comptroller that the requirements have been met, or otherwise fail to amend the application or respond within the specified time limit, the application will be refused registration. On the other hand, if the Comptroller is satisfied that all the necessary requirements are met, the application would be accepted as eligible for registration.

Following the re-introduction of opposition proceedings into Maltese law, letters of consent are no longer in use as a practice by the MIPRD. Accordingly, objections to the registration of a trademark on the basis that it conflicts with an earlier right must be raised by the rights holder of that earlier right.

Law stated - 09 August 2023

Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Use or declaration of intent to use is not a pre-condition for the registration of a trademark in Malta. That said, if the applicant wishes to establish that its mark has acquired a distinctive character, then evidence of prior use in Malta would need to be submitted. Following registration, the proprietor is given a grace period of five years to put its trademark to genuine use within Malta and in default of this, that mark could be subject to revocation unless the proprietor can show proper reasons for such non-use. Revocation may similarly arise if the use of the mark is at any point suspended for a continuous period of five years.

Priority may be claimed in Malta where the applicant has filed an application for the same mark in a foreign country that is a member of the World Trade Organization or party to the Paris Convention within the preceding six months.

Law stated - 09 August 2023

Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Markings such as the phrase 'registered' and any other symbol or word conveying a reference to registration may be used on a voluntary basis, but have no legal status per se. Where a mark is not registered, it would however be an offence to make use of such markings on it or imply that it is registered.

Law stated - 09 August 2023

Appealing a denied application

Is there an appeal process if the application is denied?

Any decision of the Comptroller, including refusals, are subject to appeal before the Court of Appeal. The appeal application would need to be filed within 15 days of service of the Comptroller's decision.

Law stated - 09 August 2023

Third-party opposition

Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Applications are published for opposition purposes as part of the registration process and third parties are allowed a time limit of 90 days within which to bring a notice of opposition. An opposition may be based on one or more earlier marks or rights and directed against all, or part of the goods or services for which protection is being sought under the opposed application.

The grounds for bringing an opposition are the relative grounds for refusal set out in the Act – these comprise cases of double identity, the likelihood of confusion and where the use of the subsequent mark, without due cause, would take unfair advantage, or be detrimental to, the distinctive character or repute of the earlier mark. Other possible grounds include where, on the application or priority date, there exists another mark that is well-known in Malta or if a person has rights to a non-registered trademark or another sign used in the course of trade that confers upon that person the right to prohibit the use of the mark in the application. For opposition purposes, an earlier trademark must either be an application for, or a registered EUTM, Maltese trademark or trademark registered under an international agreement effective in Malta, which has an earlier filing date, or a mark that, at the time of the application's filing, is well-known in Malta. Last, oppositions may also be based on earlier rights such as copyright and registered designs.

Bad faith applications can still be opposed by brand owners who do not have registered trademark protection in Malta where they have rights to a non-registered trademark or a well-known mark.

Notices of opposition are subject to an initial filing fee of €100 payable by the opponent. If the opponent decides to maintain the opposition after receiving notice of the applicant's counterstatement or its amendment to the trademark application, then a further fee of €100 would be payable.

Law stated - 09 August 2023

Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

A Maltese trademark registration is granted for an initial period of 10 years from the date of the application's filing, and with the possibility of renewal for further periods of 10 years each. A request for renewal may be made not earlier than six months before the mark's expiry date. The Act also allows for the possibility of filing a late renewal with a period of six months following the expiry date, subject to the payment of a surcharge. If, however, the registration is still not renewed within this additional grace period, the Comptroller will proceed to remove the trademark from the register.

Genuine use of the registered trademark in Malta is required for the maintenance of its registration. The Act stipulates that if a registered trademark has not been put to genuine use in Malta by, or with the consent of, the proprietor in relation to the goods and services for which it was registered within five years from the completion of its registration, or if such use has been suspended for a continuous five-year period, the trademark will be liable to revocation. This applies unless there are proper reasons for this non-use or if such use is commenced or resumed after the expiry of the five-year period but before a revocation action is filed.

In an action for revocation for non-use, the burden of proof would lie on the proprietor to demonstrate that its registered trademark has been put to genuine use in Malta during the relevant period. Acceptable items of evidence would include invoices, advertising materials, articles, price lists and brochures.

Law stated - 09 August 2023

Surrender

What is the procedure for surrendering a trademark registration?

A registered trademark may be surrendered by its proprietor in respect of some, or all of the goods or services for which that trademark is registered. In such case, the proprietor would need to file a declaration of surrender with the MIPRD containing the trademark number, the proprietor's details and, where the surrender is in part, an indication of the goods or services for which the trademark is to remain registered.

Where the trademark is subject to rights that have been recorded over it by a third party (eg, a security interest), proof of that third party's agreement to the surrender must be submitted. This can take the form of a declaration of consent to the surrender signed by that third party or its representative. Upon the surrender taking effect, this will be entered into the trademark register and published.

Law stated - 09 August 2023

Related IP rights

Can trademarks be protected under other IP rights?

Yes, trademarks and signs are not excluded from having separate protection through other IP rights, provided they meet the respective requirements (eg, logotypes may also enjoy or attract copyright protection if shown to meet, in particular, the applicable standards for originality).

Law stated - 09 August 2023

Trademarks online and domain names

What regime governs the protection of trademarks online and domain names?

The Act covers within its scope the protection of trademarks online. Malta does not, however, presently have specific legislation regulating the protection of domain names and therefore, trademark law is generally relied upon in the case of disputes involving domain names. The Network Information Centre Malta is the entity responsible for the administration of the '.mt' country-specific domain.

Law stated - 09 August 2023

LICENSING AND ASSIGNMENT

Licences

May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement?

A registered trademark may be licensed for some, or all of the goods or services for which it is registered and for the

whole or part of Malta. The licence may also be exclusive or non-exclusive and, in that context, the Trademarks Act defines an exclusive licence as being a licence authorising the licensee to use the trademark in the manner authorised under the licence to the exclusion of the proprietor and all other persons.

The recordal of a licence with the Industrial Property Registrations Directorate is not compulsory for its validity. However, until such time that an application is filed, that licence will be ineffective against any person acquiring in good faith any conflicting interest in the registered trademark and the licensee would also be unable to bring infringement proceedings in its own name in Malta. Moreover, the licensee would not be entitled to damages or an account of profits in respect of any infringement of the trademark until its licence is duly recorded, unless an application for such recordal is made within a period of six months commencing from the date of the licence grant or, alternatively, if the court is satisfied that it was not practicable to file an application before the end of that period and that such application was made as soon as practicable thereafter.

An application to record a licence must include the following particulars:

- the trademark number;
- the licensee's details;
- whether the licence is exclusive or non-exclusive and, where limited, a description of that limitation;
- the licence's duration (if applicable); and
- evidence confirming the existence of the licence, such as a copy of the licence contract.

Law stated - 09 August 2023

Assignment

What can be assigned?

Both registered and unregistered trademarks may be assigned under Maltese law. A registered trademark is held to be transmissible by assignment, testamentary disposition or operation of law as other personal or moveable property. Further, a registered trademark may be transferred separately from any transfer of the undertaking and in respect of some or all of the goods or services for which it is registered. Where the whole of an undertaking is transferred, this will be deemed to also include its trademarks, unless there is an agreement to the contrary or the circumstances clearly dictate otherwise.

Law stated - 09 August 2023

Assignment documentation

What documents are required for assignment and what form must they take? What procedures apply?

An assignment of a registered trademark is not effective unless made in writing and signed by or on behalf of the assignor or a personal representative. An application to record an assignment or other transfer (such as a transfer by way of merger) must contain the following particulars:

- the trademark number;
- the name and address of the new proprietor and (as applicable) its representative;
- where the transfer does not include all the registered goods or services, then the particulars of the registered goods or services to which the transfer relates; and
- evidence duly establishing the transfer.

A copy of the transfer agreement or appropriate extract is usually requested to support the application.

Law stated - 09 August 2023

Validity of assignment

Must the assignment be recorded for purposes of its validity?

Same as with licences, the recordal of an assignment is not mandatory for its validity. That said, until such time that an application for its recordal is filed, the assignment will be ineffective against any person acquiring in good faith a conflicting interest in the registered trademark.

Law stated - 09 August 2023

Security interests

Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

A registered trademark is the personal property of its owner and may, independently of the undertaking concerned, be given as security or be the subject of rights in rem.

A request for the registration of a security interest may either be made by the proprietor jointly with the holder of the security interest, or by the proprietor or the holder of the security interest alone. The type of security interest must be recognised in Malta for it to be capable of registration (such as pledges).

Law stated - 09 August 2023

ENFORCEMENT

Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Proprietors may enforce their trademark rights in Malta by filing the appropriate action before the ordinary civil courts of Malta. IP-specific measures and remedies may also be requested in terms of the Enforcement of Intellectual Property Rights (Regulation) Act, Chapter 488 of the Laws of Malta , including discovery, evidence preservation, injunctions (which may be granted provisionally and ex parte), orders for the seizure of infringing goods and orders for their destruction following a positive decision on the merits. Damages are also available, taking account of the negative economic consequences suffered, including lost profits and any unfair profits made by the infringer, and as appropriate even moral damages.

In addition, both the Trademarks Act and the Maltese Criminal Code, Chapter 9 of the Laws of Malta , prescribe a number of acts that may amount to a criminal offence and be subject to criminal sanctions. By and large, these encompass acts involving the unauthorised use of a trademark having a reputation in Malta (where knowingly done), false trademark representations and fraud involving the use or removal of trademarks.

Procedural format and timing**What is the format of the infringement proceeding?**

Infringement proceedings are actionable by means of a sworn application filed before the First Hall of the Civil Court. During the proceedings, both parties would be able to bring forward their evidence to support their arguments and cross-examine the witnesses produced by the counter-party. The principal forms of evidence are testimony, documents (such as affidavits) and any material objects in writing relating to the facts of the suit, provided they are relevant and not affected by an exclusionary rule of evidence that renders them inadmissible. Ex parte expert evidence may also, in principle, be produced subject to certain formal requirements, and discovery of evidence in the control of the other party may also be requested under the Enforcement of Intellectual Property Rights (Regulation) Act. The relief available for a trademark infringement action is the same as that available under Maltese law in relation to the infringement of any other property right, such as damages and injunctive relief.

Law stated - 09 August 2023

Burden of proof**What is the burden of proof to establish infringement or dilution?**

Under Maltese law, the burden of proving any fact rests on the party alleging it. The standard of proof required in civil proceedings is that of a balance of probabilities. On the other hand, in criminal proceedings, proof of the offence beyond reasonable doubt is required.

Law stated - 09 August 2023

Standing**Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?**

An action for trademark infringement is competent to its owner and, under certain conditions, licensees. Unless the terms of the licence state otherwise, licensees are entitled under Maltese law to call on the trademark owner to take infringement proceedings in respect of any matter affecting their interest. Subsequently, if the owner either refuses to act or fails to do so within two months after being called upon, the licensee would be able to bring proceedings in its own name as though it were the proprietor. An exclusive licence may, however, provide that the licensee shall be entitled to bring proceedings in its own name against any person other than the proprietor and thus, set aside the previous procedure.

Depending on the nature and severity of the offence, criminal proceedings in Malta are either prosecuted ex officio or on complaint of the injured party.

Law stated - 09 August 2023

Border enforcement and foreign activities**What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?**

The Customs Malta (Customs) is empowered under the Intellectual Property Rights (Cross-Border Measures) Act, Chapter 414 of the Laws of Malta, to seize infringing goods that have entered Malta, whether intended for export, re-export, release for free circulation or temporary importation, and (or) even where they have simply been placed in a free zone or free warehouse until further transshipment to outside of the European Economic Area. Seizure may be carried out ex officio by Customs where it is prima facie evident that the goods are infringing an intellectual property right. Alternatively, the law gives rights holders the option to file an application for action and record their intellectual property rights, and thereby assisting Customs with their monitoring activities. Both Maltese and EU trademarks may be recorded, but in the case of European Union trademarks any action taken to obtain the goods' destruction would be subject to the rights holder having equivalent protection in the country of destination as provided in Regulation (EU) 2017/1001 on the European Union trademark. This latter requirement is not specified in the legislation relating to actions against counterfeit goods in breach of local trademarks.

Upon seizure, Customs would proceed to inform the rights holder or its recorded representative and allow the rights holder the opportunity to, within specific time limits, file an application for action or, if already filed, confirm that the goods are infringing and request the suspension of their release. Following this, the rights holder would need to institute judicial (civil) proceedings in relation to the goods; failing this, the other parties would be entitled to apply for the release of the goods or otherwise have their detention revoked.

Law stated - 09 August 2023

Discovery

What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

Orders for discovery and production of evidence in the control of the opposing party may be obtained under the Enforcement of Intellectual Property Rights (Regulation) Act, subject to the protection of confidential information and the claimant filing reasonably available evidence to support its claim. This could involve presenting a reasonable sample of the products allegedly infringing the claimant's rights.

Similarly, measures for the preservation of evidence can also be obtained. These may even be granted on an ex parte basis, provided the court may order the claimant to lodge appropriate security or other assurance to ensure compensation for any prejudice that may be suffered by the other party should the alleged infringement or threat thereof be found not to exist.

Additionally, there is also the possibility to request the court to order the production of information on the origin and distribution networks of infringing goods or services. This may be directed against the infringer, or any person found to be in possession or making use of such infringing goods or services on a commercial scale, or any person providing on commercial-scale services being used for such infringing activities

Law stated - 09 August 2023

Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

In principle, proceedings on preliminary injunctions are of a summary nature and heard on a prima facie level. They, therefore, tend to be quite expeditious, usually involving a single sitting and are frequently even initially granted on an ex parte basis, subject to the respondent's right to request its revocation. The duration of proceedings on the merits varies from one case to another and depends on factors such as the complexity of the action and the nature of the

defence pleas. Cases involving counterfeit goods can, however, be rather expeditious, in particular where the infringing parties are absent from Malta and do not defend themselves.

Law stated - 09 August 2023

Limitation period

What is the limitation period for filing an infringement action?

Civil actions for trademark infringement are barred by the lapse of five years, which is notably longer than the statute of limitations that otherwise applies under Maltese law for general actions in tort (being two years).

Law stated - 09 August 2023

Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The costs associated with a trademark action can vary (even significantly) on a case-by-case basis and, generally, depending on the complexity of the matter, whether it will involve the appointment of court experts and most importantly, whether damages are being claimed. Counterfeit actions tend to be less expensive, as most often the proceedings remain unchallenged, though the plaintiff will have to bear the costs for the storage and eventual destruction of the counterfeit goods.

Recovery of legal costs (but not extrajudicial expenses) is possible and may be awarded by the court in accordance with the tariffs established by law. In counterfeit cases, as the infringers are typically absent from Malta and at times even the European Union, recovery does tend to encounter practical obstacles. Further, the claimant would also typically be required to itself pay the expenses relating to the proceedings, including those for the storage of the goods and their destruction and for the appointment of curators to represent the absent defendants, and then try and obtain recovery from the infringers.

Law stated - 09 August 2023

Appeals

What avenues of appeal are available?

Appeals against decisions of the Industrial Property Registrations Directorate or Civil Court may be brought before the Court of Appeal, while decisions of the Criminal Court may be appealed to the Court of Criminal Appeal.

Law stated - 09 August 2023

Defences

What defences are available to a charge of infringement or dilution, or any related action?

Defences available under Maltese law include:

- that the contested sign is not being used either:
 - in the course of trade; or

- in relation to goods or services; or
- in the context of an action claiming likelihood of confusion, that the sign is either dissimilar to the registered trademark, or is being used in relation to goods and services that are dissimilar to those for which the trademark is registered, or there otherwise exists no likelihood of confusion; or
- in the context of an action claiming unfair advantage or dilution, that the registered trademark does not have a reputation in Malta or there is due cause for the use of the contested sign; or
- that the defendant:
 - is a natural person making use of his or her own name or address; or
 - is using a sign or indication that is either not distinctive or is otherwise descriptive in relation to the goods and services (including their characteristics);
 - is using the trademark in question for the purpose of identifying or referring to goods or services as those of the trademark owner, such as to indicate the intended purpose of a product; or
- that the registered trademark is subject to revocation due to non-use or there exist grounds for its invalidation, which may be brought as a counterclaim to the main action.

Law stated - 09 August 2023

Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc?
What criminal remedies exist?

The judicial remedies available include orders for the destruction of the infringing items or for their definitive removal or recall from circulation within the channels of commerce. Injunctions to restrain the continuation of an infringement may also be obtained. Damages may also be awarded by the court, in which case the law provides that the amount set should take into account all the relevant aspects, including all the negative economic consequences suffered by the claimant, including lost profits, any unfair profits made by the infringer and, as appropriate, other elements such as any moral prejudice suffered by the claimant as a result of the infringement (that is, moral damages).

In terms of criminal action, the Criminal Court may order fines or imprisonment (or a combination of both), depending on the nature of the specific criminal offence.

Law stated - 09 August 2023

ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Arbitration is the main method of ADR in Malta and is generally perceived as a viable, even faster, more flexible and more discreet alternative to court litigation.

Law stated - 09 August 2023

UPDATE AND TRENDS

Key developments of the past year

Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

No noteworthy developments in this area have occurred over the past year, but it should be said that trademark

litigation in Malta, especially with respect to counterfeit goods, is a well-established practice with high numbers of cases being filed before a de facto specialised court.

Law stated - 09 August 2023

Jurisdictions

	Angola	RCF – Protecting Innovation
	Australia	Holding Redlich
	Brazil	Bhering Advogados
	Canada	Bereskin & Parr LLP
	China	Jones & Co
	Colombia	OlarteMoure
	Denmark	Accura Advokatpartnerselskab
	European Union	Noerr PartGmbB
	France	Simmons & Simmons
	Germany	Meissner Bolte
	India	ANA Law Group
	Indonesia	Affa Intellectual Property Rights
	Israel	Reinhold Cohn Group
	Italy	Spheriens
	Japan	Anderson Mōri & Tomotsune
	Macau	RCF – Protecting Innovation
	Malta	Ganado Advocates
	New Zealand	PIPERS
	Portugal	RCF – Protecting Innovation
	Romania	Cabinet M Oproiu Patent & Trademark Attorneys
	Saint Lucia	Goddard-Dorville Legal
	Singapore	Ella Cheong LLC
	South Africa	Spoor & Fisher
	South Korea	Bae, Kim & Lee LLC
	Sweden	Mannheimer Swartling

 United Kingdom	AA Thornton IP LLP
 USA	Kilpatrick Townsend & Stockton LLP
 Vietnam	Bizconsult Law Firm