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# Trade Marks & Copyright 2026

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## **Malta: Law and Practice & Trends and Developments**

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## Law and Practice

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**Ganado Advocates** has a dedicated IP and TMT practice. The highly experienced team advises on the full range of contentious and non-contentious issues in the technology, media and entertainment space, registers trade marks and designs in Malta and Europe and manages IP portfolios for its clients, drafts and negotiates IP-related agreements, advises and assists on financing and acquisition projects, and assists with obtaining regulatory authorisations and clearances. The team acts as a one-stop shop for all brand and IP matters, covering filing, prosecution and registration services, portfolio management, IP-

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## 1. Trade Mark and Copyright Law

### 1.1 Governing Law

#### Trade Marks

Registered trade marks are governed in Malta by statute. The principal legislative instrument is the Trade Marks Act, Chapter 597 of the laws of Malta (the “TM Act”), which regulates inter alia the registration of trade marks at national level and the rights that their proprietors are entitled to enforce in them. The TM Act transposes the provisions of Directive (EU) 2015/ 2436. It also operates alongside Regulation (EU) 2017/1001 on the European Union Trade Mark (EUTMR), which is directly applicable in Malta. European Union trade marks (EUTMs) registered in accordance with the EUTMR are directly applicable and enforceable in Malta.

The Industrial Property Registrations Directorate (IPRD) within the Commerce Department of the government of Malta is the body responsible for national trade marks registered in Malta. This is headed by the Comptroller of Industrial Property (the “Comptroller”).

Unregistered signs used in trade in Malta may also enjoy protection under the unfair competition provisions within the Commercial Code, Chapter 13 of the Laws of Malta (the “Commercial Code”). This protection constitutes a statutory, civil law remedy.

#### Copyright

Copyright in Malta is also governed by statute, primarily through the Copyright Act (Chapter 415 of the Laws of Malta) (the “Copyright Act”). This Act provides protection for eligible works such as artistic works, audiovisual works, databases, literary works (includ-

ing computer programs), and musical works through copyright. It also includes a system of neighbouring rights protection, applicable to performers, producers and broadcasters. Maltese copyright is largely aligned with the EU copyright directives, which have been transposed into national law.

In Malta, copyright protection is automatic and arises by operation of law upon the creation of a work, without need for registration or other formality.

### 1.2 Conventions and Treaties/Rights of Foreign IP Holders

Malta is a member to most of the principal international IP conventions and treaties, including:

- Paris Convention for the Protection of Industrial Property;
- Berne Convention for the Protection of Literary and Artistic Works;
- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS);
- WIPO Copyright Treaty; and
- WIPO Performances and Phonograms Treaty.

International treaties are not self-executing under Maltese law. Malta has implemented its international obligations on trade marks and copyright primarily through the TM Act and the Copyright Act and their respective subsidiary legislation.

The rights of foreign trade mark and copyright holders in Malta are supported by:

- the TM Act and Copyright Act (eg, “well-known” marks in terms of the Paris Convention);

- applicable EU copyright and trade mark laws; and
- Malta's domestic implementation of its international obligations, including the principles of "national treatment" and "most-favoured-nation treatment" under the Paris Convention, Berne Convention and TRIPS.

## 2. Trade Mark Ownership, Protection and Rights

### 2.1 Types of Trade Marks

Maltese law recognises a broad range of possible trade mark types, including:

- word marks;
- figurative marks consisting of logos, stylised text or graphic elements;
- composite marks, combining word and figurative elements; and
- non-traditional marks, such as shapes, slogans, sounds, patterns, positions.

Effectively, any sign (including "non-traditional" types) could in principle be eligible for trade mark registration in Malta so long as they meet the requirements of distinctiveness, are capable of being represented in a clear and precise manner and do not fall foul of any absolute grounds for refusal. However, some non-traditional marks, such as scents or tastes, are difficult to register in practice, due to difficulties in meeting the representation requirements.

The TM Act expressly recognises collective marks, which distinguish the goods or services of members of an association from those of non-members; and certification marks, which certify characteristics such as quality, origin, material or method of manufacture. Both are subject to specific regulatory requirements, including the filing of governing regulations describing conditions of use.

#### Trade Dress

Trade dress, including the overall appearance of a product or its packaging, may be protected as a registered trade mark only where it is capable of distinguishing origin and is not excluded by functionality rules. Unregistered distinctive devices can benefit

from protection against confusing uses under the unfair competition provisions in the Commercial Code.

#### Geographical Indications

Geographical indications (or designations of origin) are not protected as trade marks per se under Maltese trade mark law. They are protected under separate EU regimes applicable to foodstuffs, wines and spirits. Signs that consist exclusively of geographical indications for protected products are generally excluded from trade mark registration.

#### Surnames

Surnames may in principle be registered as trade marks, provided they are distinctive. In practice, common surnames are likely to face objections and would possibly require a showing of acquired distinctiveness through use to obtain registration.

#### Shapes and Functionality

Maltese law excludes from registration signs that consist exclusively of:

- the shape or characteristics resulting from the nature of the goods;
- shapes necessary to obtain a technical result; and
- shapes that give substantial value to the goods.

#### Industrial Designs

Industrial designs may obtain trade mark registration if the design has a distinctive character and, in particular, does not fall within the functionality exclusions.

#### Statutory Protection for Special Marks

State emblems, flags and official insignia are excluded from registration under the TM Act (unless authorisation is obtained) and protected under international conventions. At time of writing, Malta has not formally acceded to the Nairobi Treaty, but conditions on the use of Olympic symbols are imposed on the Malta Olympic Committee and its members.

#### Well-Known Marks

Well-known marks in terms of the Paris Convention are also afforded protection in Malta. The TM Act defines these as trade 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 Paris 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.

## 2.2 Essential Elements of Trade Mark Protection

Under Maltese law, a sign must meet certain essential requirements to obtain registration.

- Distinctiveness:
  - (a) the mark must be capable of distinguishing the goods or services of one undertaking from those of others.
- Capability of representation:
  - (a) the mark must be represented clearly and precisely in the trade mark register. For example, this could require providing images, or MP3 files in the case of sound marks, or MP4 marks in the case of motion or multimedia trade marks.
- Absolute grounds:
  - (a) marks that are contrary to public policy, morality, or excluded under functionality rules (eg, shapes necessary for technical results) cannot be registered; and
  - (b) the mark must not fall afoul of any of the other absolute grounds for refusal.

When a mark does not possess minimum inherent distinctiveness, it may still be eligible for registration if it has acquired distinctiveness through use in Malta (secondary meaning).

A party can demonstrate acquired distinctiveness by providing evidence on:

- length and scope of use in Malta;
- market share and sales figures showing commercial recognition;
- advertising and marketing campaigns demonstrating public awareness;
- customer surveys or testimony indicating public association of the mark; and
- recognition in trade publications or awards.

The Industrial Property Registrations Directorate (IPRD or the “Office”) or, in the case of an appeal, the courts would consider factors such as:

- duration and continuity of use (eg, longer, consistent use strengthens the case);
- geographical extent of use;
- intensity and extent of advertising under the mark;
- volume of sales – high sales may indicate recognition in the market; and
- evidence of recognition (such as consumer surveys, media coverage, awards).

## 2.3 Trade Mark Rights

Trade mark registration confers various benefits under Maltese law, including:

- exclusive rights are granted to the proprietor of the mark for the use of that mark in connection with the goods and services covered by it;
- the proprietor of a registered trade mark may prevent the use in the course of trade of any identical or similar sign in relation to identical or similar goods or services, where such use gives rise to a likelihood of confusion, including association. Where the registered mark has acquired a reputation, the proprietor may also prevent the use of an identical or similar sign in relation to any goods or services, including dissimilar ones, where the use is without due cause and takes unfair advantage of, or is detrimental to, the distinctive character or reputation of that mark. These (relative) grounds can also be used by a proprietor to oppose and prevent the registration of a later mark;
- a registered trade mark entitles its proprietor to anti-counterfeit measures (see **10.5 Customs Seizures of Counterfeits or Parallel Imports**); and
- registered trade marks may also be given as security (eg, pledges).

Not all trade mark rights necessarily subsist for the entire duration of the registration; for example, registrations may become liable to revocation for non-use for a period of five years or where it has become generic or misleading (such as to the nature, quality etc).

## 2.4 Use in Commerce

To succeed in an infringement action, the proprietor must show that the defendant's use is: (i) in a trade mark sense (ie, indicator of origin); (ii) in the course of trade; and (iii) in relation to goods or services. Prohibited uses include:

- affixing the sign to goods or packaging;
- selling, offering, or stocking goods under the sign;
- importing or exporting goods under the sign;
- using the sign as a trade or company name;
- using the sign in business papers or advertising; and
- using the sign in comparative advertising contrary to Directive 2006/114/EC.

A proprietor may prohibit the use of a sign only to the extent that its rights are not subject to revocation. Non-use can be used as a defence in infringement proceedings and, at the defendant's request, the proprietor may be required to furnish proof of genuine use of the mark in the five years preceding the action. Occasional, sporadic or token use is generally insufficient.

## 2.5 Notices and Symbols

Owners may use the ® or TM symbol, but this is not mandatory and they have no legal status per se. Use of ® or similar symbols is reserved for registered marks. Where a mark is not registered, it would constitute an offence to make use of such markings on it or imply that it is registered.

## 2.6 Related Rights

Logos, designs and other creative works used as trade marks can also be protected by copyright under the Copyright Act if they qualify as eligible works (eg, have an original character). Dual protection is not in principle barred under Maltese law. A distinctive logo may, for instance, be registered as a trade mark and simultaneously also enjoy copyright protection.

Malta recognises moral rights under the Copyright Act, including the right to be identified as the author of a work. In practice, moral rights should not operate to prevent the registration or use of a surname as a trade mark, provided it does not misrepresent authorship or

harm the individual's reputation. Lack of distinctiveness would be the more likely obstacle in such case.

## 3. Copyright Ownership, Protection and Rights

### 3.1 Types of Copyrightable Works

Copyright protection arises automatically upon creation of an eligible work and is not conditional upon registration. No registration, deposit or other formality is required to enforce copyright in a protected work. There is also currently no system of voluntary copyright registration or deposit in Malta. For a work to qualify for protection under the Copyright Act, the author must be a citizen of Malta, domiciled or permanently resident in Malta, or the work must otherwise qualify for protection by virtue of Malta's obligations under international copyright treaties. Legal entities constituted or established under Maltese law, or under the law of a country benefiting from reciprocal protection, may also hold and enforce copyright. The categories or types of eligible works that are explicitly recognised are as follows.

- Artistic works – including paintings, drawings, sculptures, photographs, works of architecture, works of artistic craftsmanship.
- Audiovisual works – films, video recordings and multimedia presentations.
- Databases – collection of independent works, data or materials that are arranged in a structured or methodical way and individually accessible by electronic or other means.
- Literary works – including novels, plays, letters, textbooks, choreographic works, reports and computer programs.
- Musical works – for example, compositions, including lyrics and scores.

The Copyright Act also grants neighbouring rights to performers, producers and broadcasters. These rights grant exclusive control over the fixation, reproduction, distribution and communication to the public of their performances, sound recordings and broadcasts. It also provides for a sui generis database right for databases where there has been a substantial investment in obtaining, verifying or presenting the contents,

granting the owner the right to prevent extraction or reutilisation of substantial parts of the database.

### Industrial Designs and Copyright

Industrial designs may be eligible for copyright protection if (most particularly) they qualify as artistic works under the Copyright Act. “Artistic works” include “works of artistic craftsmanship” as a sub-category, and these are defined as including articles of industrial art. Industrial designs that are purely functional or dictated solely by technical requirements are generally excluded from copyright protection, although they may still be protected through design rights.

## 3.2 Essential Elements of Copyright Protection

Under Maltese law, a work must meet the following elements to be eligible for copyright.

### Originality

The work must be original, meaning it reflects the author’s own intellectual creation. It does not need to be novel in the sense of patent law, but must arise from the author’s creative choices rather than being, for instance, purely functional or commonplace.

### Authorship

Copyright arises for works authored by natural persons or, as to collective works, by two or more physical persons at the initiative and direction of a physical or legal person.

The author is generally the person who creates the work and the presumptive first owner of its copyright. Economic rights conferred by copyright can be assigned or licensed to another party, both during and after the lifetime of the author.

### Fixation

The work must be written down, recorded, fixed or reduced to a material form.

### Protected Subject Matter

The work must generally be capable of classification under one of the categories of eligible works (ie, artistic works, literary works, musical works, etc). Copyright protection does not extend to ideas, procedures,

methods of operations or mathematical concepts as such.

### No Formalities Required

Copyright protection is automatic upon creation; no registration is required. Proof of creation date and authorship can be important for enforcement or licensing.

There are qualification requirements. Copyright protection is qualified by whether the author (or joint authors) is at the time when the work was made a citizen of, or domiciled or resident in Malta, or else a citizen, domiciled or resident in another state in which copyright is protected under an international agreement to which Malta is a party.

## 3.3 Copyright Authorship

The author is generally the natural person who creates the work. The person in such case must contribute original intellectual effort to the creation of the work. Mere mechanical contribution, execution of instructions, or technical assistance, are generally deemed to be insufficient.

Maltese law does not have the concept of works made for hire. Accordingly, if a consultant or independent contractor authored a work, that person would be the presumptive owner of its copyright, unless there is an agreement to the contrary.

For works made in the course of employment, the employee who authored the work would be the presumptive (first) owner of its copyright (subject to any agreements to the contrary).

Exceptions exist for computer programs and databases made in the course of the author’s employment or execution of their duties. Their copyright is deemed to be automatically transferred to the employer, subject to any agreement excluding or limiting such transfer.

Maltese law requires authorship by a natural person. Therefore, in the case of works created or generated by artificial intelligence (AI) tools, animals or other non-human agents, their authorship cannot generally be attributed to a natural person unless they provided

some creative input or contribution (eg, directing its creation).

### Joint Authorship

Joint authorship arises when a work is produced by the collaboration of two or more authors with the intention that their contributions be merged into a unitary whole. The contribution of each author cannot be separable from the contribution of the author/s.

Each joint author owns an equal undivided interest in the work (*pro indiviso*) unless agreed otherwise. Each may exploit the work individually, but typically must account to other authors for any profits arising from such exploitation. An assignment or licence of copyright or neighbouring right granted by a joint right-holder has effect as if granted by the other joint right-holders (provided the others may dispute the terms before the Copyright Board).

### 3.4 Copyright Rights

Copyright under Maltese law consists of a bundle of economic and moral rights. Owners enjoy exclusive economic rights to authorise and prohibit any reproduction (in whole or in part, temporary or permanent), distribution, rental, lending, translation, adaptation or modification, and any public communication, display, performance, or broadcast of their work, by any means.

The right to authorise or prohibit the cable retransmission of a television broadcast is exercisable only through a collecting society. The bundle of neighbouring rights granted to performers, producers of sound recordings and broadcasters cover similar acts, including reproduction, rental and lending, distribution, making available and communication to act. They also have the exclusive right to the fixation of their performances, recordings and broadcasts.

Alongside this, there are various statutory exceptions and limitations to copyright in the Copyright Act. These cover most of the exceptions and limitations found in Articles 5 and 6 of the Information Society Directive (Directive 2001/29/EC) (for example, private copying, incidental inclusion, temporary acts of reproduction, parody, quotations for criticism or review).

Malta recognises moral rights, which are separate from economic rights and cannot generally be assigned during the author's lifetime. They include the right of attribution, namely the right to claim authorship and to be identified as the author of the work (or to remain anonymous or use a pseudonym), and the right to integrity, which allows the author to object to any distortion, mutilation, or modification of the work that would prejudice their honour or reputation.

Performers are also entitled to moral rights in relation to their performances; specifically, the right to be identified as the performer and the right to object to any distortion or modification of the performance that would be prejudicial to their honour or reputation.

### 3.5 Term of Protection and Termination

The term of protection depends on the type of work. Copyright in literary, musical, artistic works and databases lasts 70 years after the end of the year of the author's death, regardless of when the work is made public. For audiovisual works, protection lasts 70 years after the end of the year in which the last surviving principal contributor (director, screenplay author, dialogue author, or composer) dies. Joint works are protected for 70 years after the death of the last surviving author. Neighbouring rights are protected for 50 years: for sound recordings and broadcasts, from first publication or public communication; and for performers, from first lawful publication or communication of the performance or, failing that, from the first performance.

The terms cannot be shortened by agreement or terminated prematurely.

### 3.6 Collective Rights Management Systems

Malta recognises and regulates collective management organisations (CMOs) for copyright and related rights (primarily through the Copyright Act and secondary legislation).

#### Powers and Functions of CMOs

CMOs in Malta are authorised to:

- license works on behalf of rights-holders;

- collect, manage and distribute royalties for uses such as public performance, broadcasting, communication to the public and online exploitation;
- monitor and enforce rights, including pursuing infringement claims; and
- negotiate tariffs and licensing terms.

### Rights-Holder Representation

- Rights-holders may mandate CMOs to manage specific rights or categories of use.
- Mandates may be exclusive or non-exclusive, subject to transparency requirements.
- CMOs may represent foreign rights-holders through reciprocal/bilateral representation agreements with overseas societies.

### Regulatory Oversight and Transparency

Under Maltese law and EU-derived rules, CMOs must:

- operate on a non-discriminatory and transparent basis;
- provide members with regular reporting on collections, deductions and distributions;
- publish tariffs and licensing conditions; and
- provide complaints and dispute resolution mechanisms for members and users. Certain disputes may be referred to alternative dispute resolution or competent authorities, depending on the issue.

A CMO requires prior authorisation from the Maltese Copyright Board in order to operate as such in Malta. The CMO's tariff of royalties must also be submitted to the Board and must obtain its approval. Maltese law also includes the notion of extended collective licensing (ECL), which entitles a CMO to grant licences for rights on behalf of non-member rights-holders, subject to opt-out rights. ECL is particularly used to facilitating licensing of mass-repertoire works.

### 3.7 Copyright Registration

Copyright arises automatically upon creation of an original work, provided the statutory requirements under the Copyright Act are met. Malta does not grant substantive legal advantages (such as presumptions of validity, priority or standing to sue) based on copyright registration. No registration, deposit or other formality is required before enforcement proceedings may be brought. Accordingly, the absence of registra-

tion does not affect either the subsistence of copyright or the right to bring infringement proceedings in Malta.

In addition, Malta does not maintain an official copyright register comparable to trade mark or design registers. There is therefore no publicly available national database for copyright works. In practice, authors or rights-holders may record works through private registries, notaries or third-party services for evidentiary purposes. These however have limited evidentiary value.

There is no requirement for foreign copyright owners to appoint or be represented by a Maltese attorney in order to obtain protection or enforce their rights. Assistance by local counsel is, however, required when initiating court proceedings in Malta.

Maltese law imposes no mandatory formalities such as notices, symbols, or deposits. Use of a copyright notice (copyright symbol, year, owner name) is permitted, but purely voluntary.

### 3.8 Copyright Application Requirements

See 3.7 Copyright Registration.

No filing fee applies since there is no copyright registration mechanism under Maltese law.

### 3.9 Refusal of Registration

There is no registration procedure.

### 3.10 Related Rights

Under Maltese law, a work protected by copyright may also have parallel trade mark protection, provided it independently satisfies the legal requirements of each regime. Maltese law does not automatically exclude copyright protection where the subject matter or parts thereof already benefit from trade mark protection, and vice versa. However, trade mark registrations cannot be used as a means to extend copyright-like protection indefinitely (ie, evergreening), including for purely artistic or decorative works that do not function as indicators of commercial origin.

## 4. Trade Mark Registrations and Applications

### 4.1 Trade Mark Registration

Registration is not strictly required to acquire rights in the use of a trade mark. Unregistered signs used in the course of trade in Malta can benefit from protection through the unfair competition provisions in the Commercial Code. The TM Act also extends protection to “well-known” marks within the meaning of Article 6bis of the Paris Convention.

Please refer to **2.3 Trade Mark Rights**, outlining the rights and benefits that can be obtained from registration. In addition, being able to produce a registration certificate could serve as useful evidence for facilitating the grant of interim measures, such as preliminary injunctions (PIs).

Registrability is in principle assessed according to the same requirements, regardless of the type of mark (ie, distinctiveness, capable of representation and absolute grounds of refusal). In practice, secondary meaning may be required for trade dress and other non-traditional marks.

### 4.2 Trade Mark Register

Malta maintains an official trade mark register administered by the Commerce Department. It records national Maltese trade mark applications and registrations. This register is publicly available and may be searched by third parties.

It is normal and recommended practice to conduct pre-filing clearance searches.

Company name registers, domain name registers and online searches can also be used to identify any existing unregistered trade marks that are in use in Malta. Unregistered trade marks having prior use can be used in Malta as the basis to oppose a trade mark application.

### 4.3 Term of Registration

A registered trade mark in Malta is protected for a term of ten years from its date of filing. The registration may be renewed indefinitely for successive ten-year periods, subject to renewal procedures. Renewals may

be filed within the six months prior to the registration expiry date. A trade mark may still be renewed within six months after its expiry date, subject to payment of a late renewal fee. If, however, the registration is still not renewed within this additional grace period, the Comptroller will proceed to remove the trade mark from the register.

No proof of use is required at renewal stage. However, a mark that has not been put to genuine use for a continuous period of five years following registration, and without legitimate reasons, may be vulnerable to revocation actions for non-use. These would be third-party actions.

If a trade mark has been removed from register, its restoration could be possible if the Comptroller, after considering the circumstances of the case, is satisfied that it is just to do so. A request for restoration must be filed within six months from the date of removal and must be accompanied by the appropriate renewal and restoration fees.

### 4.4 Application Requirements

The standard procedure includes:

- filing a trade mark application with the IPRD;
- examination by the office (formalities and absolute grounds);
- publication of the application;
- opposition period for third parties; and
- registration if no opposition is filed or if opposition is unsuccessful.

A single application needs to be filed for each different class of goods/services under the Nice Classification. A filing fee of EUR115 is currently levied per application. Separate fees apply for renewal, opposition and other actions. A trade mark can be applied for by any natural or legal person and, in the case of collective marks, by any associations of manufacturers, producers, suppliers of services or traders as well as legal persons governed by public law.

There are no nationality or residency restrictions on ownership. Foreign applicants are not required by statute to appoint a Maltese attorney or trade mark agent to file and register a mark. However, local rep-

resentation is customary and advisable, particularly for managing correspondence with the registry and dealing with Office notices and actions.

#### 4.5 Use in Commerce Prior to Registration

There is no use requirement under Maltese law to be able to obtain registration. The TM Act does not require evidence of prior use, submission of an intent to use or specimens, at filing or renewal stage. However, registered marks are subject to post-registration use obligations.

- A trade mark must be put to genuine use in Malta within five years following the date of registration. The initial five years amount to a grace period. Failing this, it would become liable to revocation for non-use upon application by a third party.
- Revocation may similarly arise if its use is suspended for a continuous period of five years following the lapse of the grace period, and without there being proper reasons.

“Genuine use” must be for the mark as registered and in relation to the goods and services in respect of which it is registered. Use must be real and actual (ie, not merely token) and in the course of trade. Minimal use may be acceptable if justified by the nature of the market. Cancellation or revocation is not done by the Office ex officio; it requires a third-party action.

#### 4.6 Consideration of Prior Rights in Registration

In practice, the Office’s examination is limited to formal admissibility and the absolute grounds. Conflicting prior rights may be raised at opposition stage by interested third parties. Prior rights include earlier registered trade marks (EUTMs, trade marks registered in Malta, international registrations designating the EU under the Madrid Protocol, “well-known” marks); earlier unregistered trade marks used in Malta; and earlier rights obtained in copyright or designs.

#### 4.7 Revocation, Change, Amendment or Correction of an Application

An applicant may amend a trade mark application during the registration procedure, subject to certain limitations. Amendments are generally allowed only to correct:

- the name or address of the applicant;
- errors of wording or copying; or
- obvious mistakes,

provided it does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

An applicant may also restrict or limit the goods and services covered by the applications. A request for amendment must be made to the Comptroller for approval.

Amendments cannot materially alter the character of the mark as filed. Typical examples of impermissible changes include:

- changing a word mark to a logo mark or vice versa;
- altering the essential visual elements of a figurative mark; and
- adding new goods or services outside the scope of the original application.

Substantial changes that go beyond clerical corrections or limitation of goods/services typically require a new application.

#### 4.8 Dividing a Trade Mark Application

An applicant may divide a national trade mark application into two or more separate applications by sending a declaration to the Office. This must indicate, for each divisional application, the goods or services covered by the original application which are to be covered by the divisional applications. Division of trade mark registrations is also possible.

#### 4.9 Incorrect Information in an Application

As mentioned in 4.7 **Revocation, Change, Amendment or Correction of an Application**, correction is generally permitted for clerical or obvious errors (eg, applicant name, address, classification errors). Material changes (eg, change of applicant, addition of new goods/services outside the original scope, or changes affecting the distinctive character of the mark) are not permitted and would generally require a new application filing.

## 4.10 Refusal of Registration

Article 5 of the TM Act sets out the absolute grounds for refusal or invalidity, which may be raised *ex officio* at examination stage by the Office. These include (amongst others) signs that cannot constitute a trade mark, including trade marks devoid of distinctive character; trade marks consisting exclusively of descriptive indications relating to the purpose, value, quality, kind, geographical origin, time of production, or other characteristics of the goods or services; signs consisting solely of the shape or other characteristics resulting from the nature of the goods, necessary to achieve a technical result, or giving the goods substantial value; and trade marks that are deceptive or contrary to public policy or accepted principles of morality.

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. Applicants are given the opportunity to provide representations in reply to an examination deficiency notice or amend the application, typically under a timeframe of 90 days. If the refusal is maintained, the applicant may appeal to the Court of Appeal.

## 4.11 The Madrid System

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 advantages offered through the Madrid system.

## 5. Trade Mark Procedure for Inter Partes Proceedings

### 5.1 Timeframes for Filing an Opposition or Cancellation

Upon completion of examination, the application is published for opposition for 90 days. If an opposition is filed within this period, registration is suspended pending the opposition's withdrawal or rejection. However, if upheld, the application is refused, subject to appeal before the Court of Appeal. Late oppositions are not considered. The Office first examines the admissibility of the opposition and, if accepted, notifies the applicant, who has 90 days to withdraw

the application, limit the goods or services, or file a counterstatement.

Revocation and invalidation actions are not subject to statutory limitation periods in Malta; however, invalidation is barred where the proprietor has acquiesced for five successive years to the use of a later registered trade mark, unless the later mark was filed in bad faith.

### 5.2 Legal Grounds for Filing an Opposition or Cancellation

The grounds on which an opposition may be brought are the relative grounds for refusal set out in the TM Act. These include cases of double identity, a likelihood of confusion, and situations where the use of the later mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark. Additional grounds may arise where, on the application or priority date, there exists a mark that is well known in Malta, or where a person holds earlier rights in an unregistered trade mark or an earlier right under copyright or a design right entitling that person to prohibit the use of the filed mark.

### Cancellation and Revocation

An invalidation action may be brought on the ground that it should not have been registered in the first place based on the absolute grounds for refusal, or because it conflicts with an earlier right on the basis of the relative grounds for refusal (outlined above). Revocation actions may be brought on the basis of non-use (please see 4.5 Use in Commerce Prior to Registration). If the action is successful, the registration will be cancelled from the register. Where invalidated, the trade mark will also be deemed to not have had, as from the outset, the effects of its registration.

### 5.3 Ability to File an Opposition or Revocation/Cancellation

Oppositions may be filed primarily by proprietors of earlier rights. Licensees and other persons entitled under applicable law (such as GI holders) may also oppose, subject to proof of authorisation or entitlement. The main categories of earlier rights are outlined in 4.6 Consideration of Prior Rights in Registration. A notice of opposition is subject to a EUR100 filing fee,

with a further EUR100 payable if the opponent maintains its opposition following receipt of the applicant's counterstatement or amendment.

Maltese law does not expressly limit who may initiate revocation or invalidation proceedings before the courts; however, claimants must demonstrate a sufficient juridical interest. By contrast, revocation or invalidation actions before the Comptroller as an office action are generally limited to proprietors of earlier trade marks.

## 5.4 Opposition or Revocation/Cancellation Procedure

### Oppositions

Please see **5.1 Timeframes for Filing an Opposition or Cancellation**.

An opposition may be based on one or more earlier rights and may target all or part of the goods or services covered by the application. Where a counterstatement is filed, the opponent has 90 days to confirm whether it wishes to maintain the opposition and to submit further arguments and evidence, followed by a final response from the applicant. Proceedings are conducted in writing, typically without hearings or oral submissions, and conclude with a decision of the Comptroller, which is notified by email and subject to appeal.

### Revocation and Invalidation

Revocation and invalidation actions may be brought either before the Comptroller as an office action or before the First Hall of the Civil Court by sworn application. Once concluded before the Comptroller, the same action on the same grounds cannot be brought before the courts, and standing requirements may limit who can initiate it before the Comptroller. Such actions may be brought against all or part of the registered goods or services, and a mark may be declared partially invalid or revoked, including for non-use.

## 5.5 Legal Remedies Against the Decision of the Trade Mark Office

Decisions of the Comptroller and Civil Court are subject to appeal before the Court of Appeal. Timeframes are 15 days from the date of service (in the case of Comptroller decisions) and 30 days from the date of

the decision (in the case of court decisions). Decisions need to be final before they can be appealed. However, where a revocation or invalidity action has first been instituted before the Comptroller, the claimant may at any stage bring the same action on the same grounds before the court, in which case the Comptroller proceedings will discontinue.

## 5.6 Amendment in Revocation/Cancellation Proceedings

The proprietor of the contested trade mark may, including in the course of any revocation or cancellation proceedings, surrender the mark's registration in respect of some or all its goods or services. Otherwise, amendments are generally not possible post-registration. The claimant may withdraw all or some of the grounds relied upon; however, in principle new grounds cannot be raised once the proceedings have been instituted (aside from exceptional situations).

## 5.7 Combining Revocation/Cancellation and Infringement

In Malta, infringement actions can only be brought before the courts. A claim for revocation or invalidation may be raised as a counterclaim in an infringement action; in such cases, both matters are heard together and typically determined in a single judgment. Counterclaims may also be raised to an invalidation action – eg, to challenge the earlier rights relied upon.

## 5.8 Measures to Address Fraud

Trade mark applications can be refused registration and, if registered, declared invalid if shown to have been made in bad faith. These would require either bringing an opposition or invalidation action. If bad faith is established, the trade mark will be refused or cancelled.

# 6. Assignments and Licensing

## 6.1 Assignment Requirements and Restrictions

Under Maltese law, both registered and unregistered trade marks may be assigned. In particular, a registered trade mark is: (i) transmissible by assignment, testamentary disposition or operation of law as other personal or moveable property; and (ii) may be trans-

ferred separately from any transfer of the undertaking and in respect of some or all of the goods or services for which it is registered. The assignment of a registered mark is not effective unless made in writing. Recordal of the assignment is not mandatory for its validity. However, until such time that it is recorded, it will be ineffective against good-faith third parties who acquire conflicting rights.

Copyright and neighbouring rights are also transmissible by assignment, operation of law or by testamentary disposition as movable property. An assignment of copyright or neighbouring must be made in writing to have effect. Moral rights of authors or performers are not transmissible during their lifetime. They may be limited in scope, duration and/or territory, and apply to all or only to certain exclusive acts. They can be granted for the whole term of protection or only part of it.

## 6.2 Licensing Requirements or Restrictions

A registered trade mark or pending application may be licensed for some or all of the goods or services and for the whole or part of Malta, on an exclusive or non-exclusive basis. Recordal of the licence is not required. However, until it is filed, the licence is ineffective against good-faith third parties who acquire conflicting rights. The licensee cannot bring infringement proceedings in its own name and is not entitled to damages or an account of profits unless the licence is recorded, or an application for recordal is filed within six months of the grant, or as soon as practicable thereafter where timely filing was not possible.

Copyright and neighbouring rights may also be the subject of a licence. A licence may be granted for all or some of the acts controlled by copyright or neighbouring right. It may be exclusive or non-exclusive, limited to a specified territory or part of the copyright term. The licence must be made in writing in order to have effect.

An assignment, licence or testamentary disposition may be granted or made in respect of a future work or an existing work in which copyright or a neighbouring right does not yet subsist.

## 6.3 Registration or Recording of an Assignment or Licence

Please refer to previous responses in 6. Assignments and Licensing.

## 7. Initiating Trade Mark and Copyright Lawsuits

### 7.1 Timeframes for Filing Infringement Lawsuits

Civil actions under the TM Act are subject to a limitation period of five years. Invalidation actions are also precluded where the proprietor has acquiesced to the use of a later, registered trade mark for a period of five successive years, unless it was filed in bad faith.

Actions for damages arising from copyright infringement are subject to the general two-year limitation period for tort actions under the Civil Code, Chapter 16 of the laws of Malta. Delay is normally a relevant factor in interim measures, such as PIs, and could be detrimental to their grant, particularly where deemed to have been unreasonable.

### 7.2 Legal Claims for Infringement Lawsuits and Their Standards

In trade mark matters, registration is not an absolute prerequisite for legal protection; however, the nature and extent of remedies available differ according to whether the mark is registered. Unregistered marks may be protected on the basis of prior use pursuant to the Commercial Code, which prohibits traders from using a name, mark or other distinctive sign that is capable of creating confusion with a sign lawfully used by another trader, irrespective of registration. Remedies available include damages and interest or (at the claimant's option) a penalty to be fixed by the court and capped at EUR4,658.75, injunctive relief and destruction orders.

For registered trade marks, infringement actions under the TM Act arise in situations of: (i) double identity, namely the use of identical marks for identical goods or services; (ii) likelihood of confusion, involving identical or similar marks used for identical or similar goods or services; and (iii) cases where a later mark, without due cause, takes unfair advantage of, or is detrimental

to, the distinctive character or reputation of an earlier trade mark enjoying a reputation in Malta, irrespective of whether the goods or services are similar or dissimilar. In assessing infringement, the competent authorities take into account the relevant factors set out in **7.3 Factors Determining Infringement**. Available remedies include injunctive relief, damages, orders for the permanent removal or destruction of infringing goods, materials, or articles in the infringer's possession, custody or control.

Copyright and neighbouring rights are infringed under the Copyright Act where, without authorisation or a valid licence, a person performs or authorises acts reserved to the right-holder, imports or commercially deals in infringing articles, circumvents effective technological protection measures, interferes with electronic rights-management information, or manufactures, distributes, or provides devices or services intended to facilitate such circumvention. These provisions encompass direct, contributory and secondary infringement. Remedies include damages, restitution of profits, and orders for the destruction of infringing articles, in addition to the remedies available under the IPR Enforcement Act.

### 7.3 Factors in Determining Infringement

Registered trade mark infringement arises where a registered mark exists and a later, conflicting sign is used without authorisation in the course of trade (eg, advertising or sales). Likelihood of confusion is assessed globally by reference to interdependent factors established in ECJ case law, including: (i) the distinctiveness of the earlier mark; (ii) the similarity of the marks, assessed visually, phonetically and conceptually, with regard to dominant elements; (iii) the similarity of the relevant goods or services; and (iv) the overall likelihood of confusion. Where infringement is alleged on the basis of unfair advantage or detriment, the registered mark must have a reputation, the strength of which is a material factor in the analysis.

Claims concerning unregistered marks under the Commercial Code are limited to likelihood of confusion and generally assessed by reference to the same principles.

Copyright infringement requires proof that copyright subsists in an original, protected work and that the claimant is the right-holder. Infringement occurs where, without authorisation, the defendant carries out a restricted act, such as reproduction, adaptation, distribution or communication to the public. The assessment focuses on whether protectable elements of the work have been taken, rather than unprotected ideas, and whether the whole or a substantial part of the work has been used, assessed qualitatively. In some cases, particularly secondary infringement, the defendant's knowledge or control may also be relevant.

### 7.4 Prerequisites and Restrictions to Filing a Lawsuit

Maltese law does not impose any mandatory pre-action requirements before instituting either a trade mark or copyright infringement lawsuit. In particular, there is no specific obligation to issue a formal demand letter or warning notice, nor is there any express requirement to engage in mediation or other alternative dispute resolution prior to filing suit. Notwithstanding this, it is common practice for rights-holders to send a demand letter before filing an action, including to temper any risk of the proceedings being considered premature or disproportionate.

The TM Act contains an express remedy against groundless threats of infringement proceedings. Where a person threatens another with proceedings for infringement of a registered trade mark, any person aggrieved may bring proceedings for relief before the First Hall of the Civil Court. The court may grant a declaration that the threats are unjustified, an injunction restraining their continuation, and damages in respect of any loss sustained as a result of the threats, unless the proprietor proves that the acts in respect of which proceedings were threatened constitute, or would constitute if carried out, an infringement of the registered trade mark. Even where infringement is established, relief may still be available if the trade mark registration is invalid or liable to revocation. Mere notification that a trade mark is registered, or that an application has been made, does not in itself amount to a threat of proceedings.

## 7.5 Lawsuit Procedure

Please see previous responses in this 7. **Initiating Trade Mark and Copyright Lawsuits**; copyright and trade mark infringement actions must be initiated through a sworn application filed in the First Hall of the Civil Court. Pre-action/litigation costs can vary significantly depending on the particulars of the case and whether evidence needs to be gathered beforehand. These costs are generally not recoverable in court; however, if the action is preceded by a judicial letter or judicial protest, the costs associated with those steps can be included in the court-awarded costs and recovered by the claimant if the award is in their favour.

In general, parties to litigation must be assisted by an advocate admitted to practice in Malta. The court may require a party who is not assisted by an advocate to engage one if it considers that the party is unable to properly present their case. Foreign trade mark or copyright owners can bring infringement claims in Malta, but would generally have to appoint a special mandatory to represent them during the proceedings and ensure their continued presence as a party. The IP rights relied upon must have effect in Malta in order to form the basis of an infringement action.

## 7.6 Declaratory Judgment Proceedings and Other Protections for Potential Defendants

There is nothing in local trade mark or copyright law that prohibits an alleged infringer from instituting declaratory judgment proceedings. As a matter of general civil procedure, a party that is threatened with enforcement action is entitled to seek declaratory relief. Maltese procedural law also provides for the remedy of jactitation suits, which enable any person, whether natural or legal, against whom a right has been asserted in writing, to request the court to order the third-party claimant to institute proceedings within a period not exceeding three months, failing which the claimant would (by consequence) be forever barred from pursuing that claim in the future.

## 7.7 Small Claims

In principle, monetary claims not exceeding EUR5,000 fall within the jurisdiction of the Small Claims Tribunal, where cases are decided by an adjudicator on the basis of equity in accordance with the law. How-

ever, both the Copyright Act and the Trade Marks Act require infringement actions to be brought by sworn application before the First Hall of the Civil Court, effectively excluding such claims from the Tribunal's jurisdiction.

In practice, CMOs often use the Small Claims Tribunal to recover outstanding payments under copyright licences, though these are contractual claims rather than infringement actions.

## 7.8 Effect of Trade Mark and Copyright Office Decisions

At present, copyright and trade mark infringement actions may only be brought before the civil courts. Trade mark oppositions may only be brought before the Comptroller as an office action (with a right of appeal to the courts), whilst both trade mark revocation and invalidity actions may be brought either before the First Hall of the Civil Court or the Comptroller as an office action.

The Copyright Board is vested with the authority to approve requests for the establishment and operation of CMOs in Malta, to approve the tariffs charged and any revisions thereof, as well as to revoke any authorisation to act as a CMO. Decisions of the Board are subject to appeal before the Court of Appeal, which must be lodged within 15 days of service of the Board's decision.

## 7.9 Counterfeiting and Bootlegging

"Counterfeit goods" are addressed in the Intellectual Property Rights (Cross-Border Measures) Act, Chapter 414 of the laws of Malta. They are defined as goods that bear a registered trade mark without authorisation, either directly on the goods or on their packaging, in a way that is identical or essentially indistinguishable from the original, and infringe the trade mark owner's rights. The Act also includes the notion of "pirated goods", which are defined as goods that are or embody copies made without the consent of the copyright, neighbouring rights, or design right-holder – or their authorised representative in the country of production – and that would have infringed those rights under Maltese law if made in Malta. "Counterfeit goods" and "pirated goods" may be subject to Customs actions in the circumstances

outlined in **10.5 Customs Seizures of Counterfeits or Parallel Imports**. The Act also stipulates that persons who import or cause to be imported any goods infringing an IP right shall be liable for every such offence to a fine (multa) equivalent to double the value of such goods.

The Maltese Criminal Code also contains provisions which sanction (as a criminal offence) any person who prints, manufactures, duplicates or otherwise reproduces, or sells, distributes or otherwise offers for sale or distribution, any article or other thing in violation of copyright protected by or under Maltese law, or who has in their possession, custody or control any such article or other thing with a view to carrying out any of the foregoing acts. The unauthorised use/affixation of another's trade mark is also prescribed as a criminal offence under the TM Act.

## 8. Litigating Trade Mark and Copyright Claims

### 8.1 Special Procedural Provisions for Trade Mark or Copyright Proceedings

There are some specific procedural provisions in the Enforcement of Intellectual Property Rights (Regulation) Act, Chapter 488 of the laws of Malta (the "IP Enforcement Act"), which transposes the Enforcement of Intellectual Property Rights Directive (2004/48/EC). These are mostly relevant to provisional and precautionary measures (addressed in **10.1 Injunctive Remedies**).

There are no formally designated technical judges for IP rights cases in Malta. However, due to the way in which case loads are allocated, judges with relevant experience in intellectual property are typically assigned the majority of matters in this field. The court may also appoint experts and judicial assistants to support their work (including for similarity comparisons – eg, in the context of source code copyright claims), while the parties are also entitled to submit their own experts and expert reports to substantiate their respective claims.

Malta has a specialised Patent Tribunal for patent-related actions. However, there is currently no equiva-

lent specialised court or tribunal for copyright or trade mark matters; instead, these continue to be filed before and heard by the ordinary civil courts.

### 8.2 Effect of Registration

Trade mark registrations are particularly beneficial in the context of provisional and precautionary measures (such as PIs), as they provide prima facie evidence of the validity and ownership of the rights relied upon. For instance, the claimant in PI proceedings is only required to show on a prima facie level that it has a right which it is entitled to exercise. Therefore, in a trade mark, it would generally be sufficient for the claimant to produce a registration certificate. PI proceedings are dealt with on a summary basis and, per existing practice, the court would not enter into whether that registration is valid. There is also a statutory defence of acquiescence, available to holders of later registered trade marks.

### 8.3 Costs of Litigating Infringement Actions

The costs associated with a copyright or trade mark infringement action can vary significantly on a case-by-case basis and generally depend on factors such as the complexity of the matter, the appointment of any court experts, whether damages are being claimed and the amount.

Counterfeit actions tend to be less costly, as proceedings are often uncontested by the defendants; however, the plaintiff is typically required to bear the costs associated with the storage and eventual destruction of the counterfeit goods.

## 9. Defences and Exceptions to Infringement

### 9.1 Defences to Trade Mark Infringement

The defences available under the TM Act include:

- that the contested sign is not being used either:
  - (a) in the course of trade; or
  - (b) in relation to goods or services;
- in the context of an action claiming likelihood of confusion, that the sign is either dissimilar to the earlier trade mark, or is being used in relation to

- goods and services that are dissimilar, or there otherwise exists no likelihood of confusion;
- in the context of an action claiming unfair advantage or detriment to distinctive character or reputation, that the earlier trade mark does not have a reputation in Malta or, where based on an EUTM, a substantial part of the European Union and there is due cause for the use of the contested sign; or
  - that the defendant, in accordance with honest commercial practices:
    - (a) is a natural person making use of their own name or address;
    - (b) is using a sign or indication that is not distinctive or is otherwise descriptive in relation to the goods and services (including their characteristics); or
    - (c) is using the mark to identify or refer to goods or services as those of the trade mark owner, such as to indicate the intended purpose of a product.

Enforcement is also restricted by rules relating to acquiescence, invalidation and revocation. A trade mark proprietor who has not put the mark to genuine use in Malta for a continuous five-year period risks revocation. Likewise, where the proprietor of an earlier trade mark has acquiesced for five successive years in the use of a later registered trade mark, they are precluded from seeking invalidity or opposing use, unless the later mark was applied for in bad faith.

In addition, the doctrine of exhaustion is incorporated in the TM Act. It prevents a trade mark proprietor from opposing further commercialisation of goods that have been lawfully placed on the EU market under that trade mark by or with the proprietor's consent, save where legitimate reasons exist, such as where the condition of the goods has been changed or impaired.

Civil actions under the TM Act are also subject to a limitation period of five years.

## 9.2 Defences to Copyright Infringement (Fair Use/Fair Dealing)

Malta does not have a specific statutory "fair use" or "fair dealing" exception for copyright actions. The Copyright Act does however include an extensive list of exceptions and limitations referring to specific situ-

ations; most of which are directly reproduced from Articles 5 and 6 of the Information Society Directive. Amongst them are an exception permitting the reproduction or communication to the public of a work of caricature, pastiche or parody. The concept of parody would be assessed in Malta in accordance with EU law and related CJEU case law (which has held in cases such as *Deckmyn* that it is an autonomous concept of EU law). Neither the TM Act nor the Copyright Act include a specific free speech defence, although there is a copyright exception relating to the use of quotations for criticism or review. Freedom of expression is also constitutionally guaranteed and protected under Maltese law.

## 9.3 Exhaustion

### Trade Marks

The TM Act recognises exhaustion; a proprietor cannot prevent use of a trade mark in relation to genuine goods that have been lawfully placed on the market in the Union by the proprietor or with its consent. Exhaustion does not apply where the goods are not genuine goods or where there exist legitimate reasons for the proprietor to oppose further commercialisation, such as where the condition of the goods has been altered or impaired after being placed on the market (eg, through repackaging, relabelling or co-branding).

### Copyright

The concept of exhaustion also exists under the Copyright Act, specific to the distribution right. The first sale or other transfer of ownership of an original work or its copies within the EU, made by or with the consent of the copyright owner, exhausts the exclusive distribution right. The market in this context refers to the European Union. The Copyright Act does not include specific exhaustion rules relating to digital content; however, EU rules and case law would generally apply (eg, exhaustion can in principle arise for perpetual software licences).

## 10. Remedies

### 10.1 Injunctive Remedies

The IPR Enforcement Act provides for specific provisional and precautionary measures in cases of IP rights infringement. In relation to PIs, case law

requires the court to consider: (i) the proportionality of the measure; (ii) the need for guarantees to cover potential costs or injury to the respondent if the claim is unjustified; and (iii) the risk of irreparable harm to the claimant if relief is delayed. Any delay in taking action, and whether it was reasonable, is also relevant.

The requirement of “irremediable prejudice” (or “irreparable harm”) often presents a practical obstacle to PI relief in Malta. Case law has routinely held that where an infringement can be removed, even by a decision on the merits, then the element of irremediable prejudice does not subsist, and the PI should not be granted. Damages, including pecuniary losses, have also generally not been accepted as a form of “irremediable prejudice”.

In principle, PI proceedings under Maltese law are of a summary nature and heard on a prima facie level, without considering or determining any issues relating to the merits of the dispute. That said, PIs are still treated as an extraordinary measure by our courts.

Other available measures under the above Act include orders for the seizure or delivery-up of infringing goods or seizure of property, blocking or freezing orders of bank accounts, measures for the production and preservation of evidence, orders to provide information on the origin and distribution networks of infringing goods/services. The court may also, at the request of the claimant and expense of the infringer, order appropriate measures for the dissemination of the information concerning the decision, including publishing the decision in full.

## 10.2 Monetary Remedies

The IPR Enforcement Act contains specific provisions on damages for IP rights-related infringement. On application by the injured party, the court may order an infringer who has (either knowingly or being reasonably expected to know) engaged in an infringing activity to pay damages commensurate with the actual prejudice suffered. In assessing damages, the court must take into account all relevant aspects of the infringement, including:

- all the negative economic consequences that may have been suffered by the injured party, including lost profits;
- any unfair profits made by the infringer; and
- where it deems appropriate, other elements such as the moral prejudice caused to the right-holder by the infringement (although not the norm per se, moral damages have been awarded by our courts in previous case law on IP infringements).

As an alternative method of calculation, the court may (where it deems appropriate) set a lump sum of damages payable by the injured party. In such case, the lump sum must include elements such as the amount of royalties or fees which would have been due had the infringer requested authorisation to use the IP rights concerned.

## 10.3 Attorneys’ Fees and Costs

In its decision, the court will normally determine who will bear the costs of the proceedings. These costs are typically made up of Court Registry fees, advocates’ fees and legal procurators’ fees, which are established and levied in accordance with statutory tariffs. These official rates are found in the schedules to the Code of Organisation and Civil Procedure. Recovery of extra-judicial fees is generally not possible. Maltese law does not attempt to restrict judicial discretion in terms of cost allocation, although they are customarily awarded against the losing party.

## 10.4 Ex Parte Relief

A claimant may request the court to issue a preliminary injunction under the IPR Enforcement Act without first hearing the defendant (ie, on an ex parte basis). The scope of the PI would be to prevent an imminent infringement or the continuance of an ongoing infringement and the court may grant this ex parte where it deems it appropriate and in particular, where it considers that any delay would cause irreparable harm to the right-holder. Precautionary seizure measures may also be granted ex parte by the courts on the same basis.

## 10.5 Customs Seizures of Counterfeits or Parallel Imports

Customs seizure of counterfeit and pirated goods may be requested by right-holders or their authorised

representatives under the Intellectual Property Rights (Cross-Border Measures) Act (Chapter 414, Laws of Malta) (the “IP Cross-Border Measures Act”). Malta Customs have broad powers of seizure and detention under this domestic legislation, extending to the entry into Malta, export or re-export, release for free circulation, temporary importation, placing in a free zone or free warehouse of goods found to be infringing an IP right.

Right-holders may register Application for Action (AfA) with Malta Customs, providing details of the IPRs relied upon, a description of the goods and their distinguishing features, proof of ownership (eg, registration certificates) and an EORI number.

Customs may act on the basis of an AfA or ex officio (ie, without an AfA) where infringement is prima facie evident. Upon seizure, the right-holder is notified and must confirm the infringement and request continued suspension of release within the prescribed time limits. The right-holder must then initiate civil proceedings within ten working days of notification, extendable by a further ten working days; failing this, the detention may be lifted and the goods released.

In addition, the TM Act entitles proprietors to prevent third parties from bringing goods into Malta in the course of trade, even where the goods are not released for free circulation, if the goods or their packaging bear an unauthorised trade mark that is identical or essentially indistinguishable from the registered mark. This is subject to the proprietor having the right to prevent the goods from being placed on the market in their intended country of destination. This sits alongside the measures in the IP Cross-Border Measures Act.

The provisions of the Customers Regulation (EU) No 608/20131 are directly applicable in Malta.

## 11. Appeal

### 11.1 Appellate Procedure

Trade mark and copyright infringement actions must be filed before the First Hall of the Civil Court (which serves as a first-instance court). Appeals from their decisions are then heard by the Court of Appeal in its superior jurisdiction. This must be lodged by means of an application, within a non-extendable timeframe of 30 days from the date of the decision, specifying the part of the decision the appellant may wish to be reversed, varied or annulled. The appeal must also be substantiated with detailed reasons in the application. If an appeal is not entered into against the whole decision, then the application must specify the heads of decision being appealed.

### 11.2 Timeframes for Appealing Trial Court Decisions

Please refer to **11.1 Appellate Procedure**.

Currently, the waiting time in Malta for decision on an appeal is around one-and-a-half to two years.

## 12. Additional Considerations

### 12.1 Emerging Issues

At the time of writing, there have been no material decisions from the Maltese courts specifically addressing the interaction between AI and IP. To the authors’ knowledge, as yet the Maltese courts have not ruled on AI-generated content ownership or infringement.

### 12.2 Trade Mark and Copyright Use on the Internet

Largely, matters relating to trade marks and copyright on the internet are regulated by the general rules outlined above. There are provisions in Copyright Act establishing liability for acts of secondary infringement, which could extend to ISPs.

## Trends and Developments

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**Ganado Advocates**

**Ganado Advocates** has a dedicated IP and TMT practice. The highly experienced team advises on the full range of contentious and non-contentious issues in the technology, media and entertainment space, registers trade marks and designs in Malta and Europe and manages IP portfolios for its clients, drafts and negotiates IP-related agreements, advises and assists on financing and acquisition projects, and assists with obtaining regulatory authorisations and clearances. The team acts as a one-stop shop for all brand and IP matters, covering filing, prosecution and registration services, portfolio management, IP-

related litigation, anti-counterfeiting, domain name disputes, as well as transactional matters, including licensing, franchising, distribution and agency agreements, IP audits and acquisition, and IP-related security. Ganado Advocates has a specific IP litigation focus and acts as representative for brand owners and right-holders in customs procedures, including applications for action, to ensure that counterfeit goods entering or traversing the Maltese territorial waters are immediately seized and destroyed in a timely manner.

## Authors



**Paul Micallef Grimaud** is a partner at Ganado Advocates, leading the firm's IP and TMT practice group. He is widely recognised for advising and representing clients in complex IP, media, technology and regulatory disputes and contractual matters, including IP enforcement, licensing and arbitration, and also engages with legal developments in artificial intelligence and innovative technology. Paul serves as Vice President for Professional Advancement of the Chamber of Advocates, is President of the Malta Institute of Privacy Law, and is a member of the ECTA Law Committee, underscoring his professional involvement and leadership within key industry bodies.



**Philip Formosa** is a senior associate within Ganado Advocates' IP and TMT practice group. He advises clients on the full lifecycle of intellectual property matters, spanning both contentious and

non-contentious work. His expertise includes IP protection and enforcement, brand strategy, and structuring and negotiation of IP-driven transactions and commercial agreements, including software licences, IP assignments, end-user licences and franchise arrangements. Philip has been spotlighted in leading legal directories as an up-and-coming practitioner in this area.



**Michela Zammit Lupi** is an associate at Ganado Advocates with expertise in advising on and drafting key IP documentation, IP enforcement and ensuring regulatory compliance in both IP and data protection matters. Her legal experience is complemented by academic qualifications including an LLM in European Intellectual Property Law, contributing depth to her specialised practice, in addition to her being admitted to the Maltese Bar Superior Courts of Malta in 2023.

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Intellectual property (IP) has assumed increasing strategic importance for businesses operating in Malta, particularly as the jurisdiction continues to attract activity in technology, digital services, gaming, financial services and creative industries. Across these sectors, IP rights underpin commercial value, investment decisions, corporate structuring and market positioning.

Malta's IP landscape is undergoing sustained development, driven primarily by European Union (EU) legislative reform, increased cross-border commercial activity, and the rapid evolution of technology. Developments in areas such as digital platforms, software, data-driven business models and artificial intelligence are testing the boundaries of traditional IP regimes and shaping enforcement and compliance practices.

This article outlines key trends currently influencing the Maltese IP framework. It focuses on developments relevant to businesses establishing, protecting, exploiting and enforcing IP rights in Malta, as well as those managing IP portfolios in a cross-border and digital context.

### Malta's Intellectual Property Framework

Malta's intellectual property regime is closely aligned with EU law, reflecting its obligations as a member state. National legislation governing trade marks, designs, patents and copyright largely implements EU directives, while EU regulations play a central role through directly applicable unitary rights such as EU Trade Marks and Registered Community Designs.

Maltese courts regularly rely on the jurisprudence of the Court of Justice of the European Union (CJEU)

when interpreting IP rights, particularly where national provisions derive from harmonised EU legislation. This alignment ensures a high degree of consistency with other EU jurisdictions, providing legal certainty for international operators.

Trade marks are governed primarily by the Trademarks Act operating alongside EU-wide registration systems administered by the European Union Intellectual Property Office (EUIPO). Copyright protection is regulated by the Copyright Act, which reflects successive EU harmonisation initiatives, including those addressing digital content, enforcement mechanisms and collective rights management. Patent protection is available through national filings, European patents designating Malta, and, more recently, the Unitary Patent system. In practice, most commercially significant patent protection involving Malta is obtained through the European Patent Office (EPO).

Given Malta's relatively small domestic market, IP strategies are rarely confined to national protection alone. Businesses operating in Malta typically pursue EU-wide or international protection and enforcement strategies, making EU legislative initiatives and CJEU case law particularly influential.

### Trade Marks and Brand Protection

Trade mark protection remains a central component of IP strategy for businesses operating in or from Malta. The availability of EUTMs continues to shape filing strategies, with many businesses prioritising EU-wide protection from the outset. National registrations remain relevant for locally focused activities, legacy brands, or where specific enforcement considerations arise.

A notable trend is the increased emphasis on early-stage brand clearance and risk assessment. Businesses are undertaking more comprehensive searches prior to adopting new brands, considering registered and unregistered rights, domain names and online usage. This reflects heightened awareness of opposition risks, rebranding costs and potential enforcement exposure.

Trade mark portfolios are becoming broader and more structured. Registrations increasingly cover multiple classes to reflect diversified business models, including digital services, software, data-related activities and virtual goods. There has also been a gradual increase in the protection of figurative and logo marks as part of broader brand portfolios.

Enforcement activity has correspondingly increased. Rights-holders are making greater use of opposition and invalidity proceedings before the Malta Industrial Property Registrations Directorate and the EUIPO. Online monitoring, marketplace surveillance and customs enforcement measures are increasingly integrated into brand protection strategies, particularly given the scale and speed of digital infringement.

## Copyright and the Digital Economy

Copyright law plays a significant role in Malta's expanding digital economy, particularly in software development, online gaming, media production and content-driven platforms. Copyright protection arises automatically upon creation and therefore constitutes a foundational IP right for many technology-focused businesses.

Recent legislative developments have been influenced by EU reforms addressing digital content distribution and platform liability. The transposition of the EU Copyright in the Digital Single Market Directive has introduced new rules concerning online content-sharing services, licensing mechanisms and rights-holder protections. Maltese law reflects these harmonised standards, subject to interpretation through national courts and CJEU jurisprudence.

Key issues for businesses include ownership of copyright in works created by employees and contractors. While Maltese law provides for employer ownership

in certain circumstances, contractual clarity remains essential, particularly in software development, audio-visual production and commissioned works.

Additionally, licensing of software and digital content continues to be a central operational issue. Businesses must address scope of rights, territorial coverage, sublicensing, maintenance obligations and compliance with open-source licensing terms. The use of third-party content in marketing, platforms and user-generated environments also requires careful rights management.

Rights-holders are also increasingly relying on notice-and-takedown procedures, platform enforcement mechanisms and targeted litigation. It is a growing tendency that evidence gathering has become more technical, particularly in cases involving streaming, file-sharing and platform-based distribution.

The interaction between copyright and artificial intelligence has also gained prominence. Questions surrounding the copyright status of AI-generated outputs and the lawful use of copyrighted material for AI training are being addressed at EU policy level, with implications for businesses operating in data-intensive environments.

## Patents and Innovation

Most patent protection relevant to Malta is obtained through the European Patent Office, with Malta designated as a contracting state.

The introduction of the Unitary Patent system represents a significant structural development, allowing for unitary protection across participating EU member states. Although Malta is not currently a participant in the Unified Patent Court, the Unitary Patent is increasingly relevant for Maltese businesses seeking protection in multiple EU markets.

Patent protection is particularly relevant in sectors such as pharmaceuticals, life sciences, engineering, fintech infrastructure and certain software-implemented inventions. Businesses are increasingly formalising invention disclosure procedures, confidentiality protocols and alignment between patent filings and commercialisation strategies.

Patent portfolios are also subject to increased scrutiny in transactional contexts, including licensing arrangements, investment rounds and corporate acquisitions.

## Design Rights and Product Protection

Design protection remains an important tool for businesses operating in sectors where visual appearance and user experience contribute to commercial value. EU design protection, particularly Registered Community Designs, continues to be the preferred route for businesses operating in Malta.

Design rights are increasingly used to protect digital assets such as graphical user interfaces, icons and virtual designs. Proposed EU reforms to design law aim to modernise protection in light of digitalisation and emerging forms of visual expression.

Businesses are adopting more proactive approaches to design protection, including early registration, co-ordination with product launches and the strategic use of design rights in enforcement actions, often alongside trade marks and copyright.

## IP Enforcement and Dispute Resolution

IP enforcement in Malta has become more structured and commercially focused. Malta has a specialised Patent Tribunal for patent-related actions. However, there is currently no equivalent specialised court or tribunal for copyright or trade mark matters; instead, these continue to be filed before and heard by the ordinary civil courts.

However, due to the way in which case loads are allocated, judges with relevant experience in intellectual property are typically assigned the majority of matters in this field. The court may also appoint experts and judicial assistants to support its work (including for similarity comparisons – eg, in the context of source code copyright claims), while the parties are also entitled to submit their own experts and expert reports to substantiate their respective claims.

The enforcement of IP rights in digital environments has introduced new evidentiary and procedural considerations. Online infringement often involves anonymous or foreign-based infringers, rapidly changing content and platform-mediated distribution. Evidence

gathering increasingly relies on technical tools such as digital forensics, website archiving, IP address tracking and transaction analysis. Courts and administrative bodies are required to assess the reliability and admissibility of such evidence, often in the context of evolving technological standards, and therefore, experts remain a reliable source.

Litigation remains an important enforcement mechanism, with interim measures and injunctive relief available where legal thresholds are met. Remedies include damages, account of profits and orders for the removal or destruction of infringing goods.

Alternative enforcement mechanisms are widely used, including opposition and invalidity proceedings before IP registries and customs enforcement against counterfeit goods. Counterfeit actions tend to be less costly, as proceedings are often uncontested by the defendants; however, the plaintiff is typically required to bear the costs associated with the storage and eventual destruction of the counterfeit goods. It is in the author's opinion that alternative dispute resolution measures such as mediation are not yet so popular in Malta. Customs may act on the basis of an Application for Action (AfA) or ex officio (ie, without an AfA) where infringement is prima facie evident. Upon seizure, the right-holder is notified and must confirm the infringement and request continued suspension of release within the prescribed time limits. The right-holder must then initiate civil proceedings within ten working days of notification, extendable by a further ten working days; failing this, the detention may be lifted and the goods released.

In addition, the Trademark Act entitles proprietors to prevent third parties from bringing goods into Malta in the course of trade, even where the goods are not released for free circulation, if the goods or their packaging bear an unauthorised trade mark that is identical or essentially indistinguishable from the registered mark. This is subject to the proprietor having the right to prevent the goods from being placed on the market in their intended country of destination. This sits alongside the measures in the IP Cross-Border Measures Act.

As highlighted earlier, evidence gathering has assumed increased importance, particularly in digital infringement cases involving technical and cross-border elements.

## Regulatory Convergence and IP

A key trend affecting the Maltese IP landscape is the convergence of IP law with technology regulation, data protection and sector-specific compliance regimes. Businesses increasingly face overlapping legal obligations requiring co-ordinated management.

This convergence is particularly evident in areas such as software licensing and GDPR compliance, regulated sectors including gaming and financial services, and the protection of confidential information and trade secrets. Maltese law implements the EU Trade Secrets Directive, providing a harmonised framework for the protection of undisclosed know-how and business information.

Trade secrets protection is contingent on the information being secret, having commercial value because it is secret, and being subject to reasonable steps to keep it confidential. As a result, legal protection is closely linked to internal governance, contractual arrangements and operational practices. Businesses operating in Malta are increasingly formalising confidentiality measures, including non-disclosure agreements, internal access controls and employee training. Disputes involving trade secrets frequently intersect with employment law, competition law and contractual obligations, particularly in cases involving departing employees or collaborative projects.

## IP in Employment and Corporate Structures

The allocation of IP rights in employment and corporate contexts remains a key area of focus. Maltese law provides default rules for ownership of IP created by employees in the course of employment, particularly in relation to copyright and certain patentable inventions.

However, contractual arrangements remain critical in defining ownership, exploitation rights and remuneration. Businesses increasingly adopt comprehensive IP clauses in employment contracts, consultancy agree-

ments and intra-group arrangements to address creation, assignment and waiver of rights.

Corporate restructurings, group reorganisations and shared service models often involve the transfer or licensing of IP assets. These transactions require careful documentation to preserve chain of title and ensure enforceability, particularly in cross-border group structures.

## IP Commercialisation and Transactions

IP assets play a central role in transactions involving Malta-based businesses. Licensing, assignment and contribution of IP rights are common features of commercial agreements, joint ventures and corporate restructurings. Licensing arrangements, technology transfer agreements and joint ventures must be structured to comply with EU competition rules, including block exemptions and guidelines. Issues such as exclusivity, territorial restrictions and pricing arrangements are commonly assessed through a competition law lens.

IP-related due diligence has become more detailed, with increased focus on ownership, registration status, enforceability and open-source software use. IP considerations are also closely linked to tax and corporate structuring in transactions.

## ESG Considerations and IP

Environmental, social and governance considerations are beginning to influence IP strategies, particularly in innovation-driven and consumer-facing sectors. IP rights may protect sustainable technologies, support certification and branding initiatives, and facilitate compliance with emerging reporting obligations.

While ESG-related IP considerations remain at an early stage, EU policy developments suggest increasing relevance over time.

## Conclusion

Malta's intellectual property framework continues to evolve in line with EU legislative developments, technological innovation and changing commercial practices. Ongoing and proposed reforms address areas such as artificial intelligence, data governance, digital

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services, design law modernisation and enforcement mechanisms.

These initiatives are expected to further harmonise IP protection while addressing technological and societal change. Maltese law will continue to evolve in line with these developments, reinforcing the importance of EU-level monitoring for businesses operating in Malta.

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