

Trademarks Act (2000)

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A BILL entitled

AN ACT to regulate Trademarks (May 15,2000)

BE IT ENACTED by the President, by and with the advice and consent of the House of Representatives, in this present Parliament assembled, and by the authority of the same, as follows:—

PART I. PRELIMINARY ➡

Short title and commencement.

1. This Act may be cited as the Trademarks Act, 2000, and shall come into force on such date as the Minister responsible for the protection of Industrial Property may by notice in the Gazette establish and different dates may be so established for different provisions and different purposes thereof.

Interpretation.

2. (1) In this Act, unless the context otherwise requires:

“business” includes a trade or profession;

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

“infringement proceedings” in relation to a registered trademark, includes proceedings under section 16;

“Minister” means the Minister responsible for the protection of Industrial Property;

“Paris Convention” means the convention referred to in section 49 of this Act;

“prescribed” means prescribed by this Act or by any regulations made thereunder;

“publish” means make available to the public, and references to publication in relation to registration, are to publication under section 37(4);

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“register” means the register of trademarks kept under this Act and includes the register of trademarks kept under the Industrial Property (Protection) Ordinance, partly repealed by this Act;

“trade” includes any business or profession;

“trademark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trademark may, in particular, consist of words (including personal names), figurative element, letters, numerals or the shape of goods or their packaging;

(2) (a) References in this Act to a trademark include, unless the context otherwise requires, reference to a collective mark or certification mark referred to respectively in sections 45 and 46.

(b) References in this Act to use (or any particular description of use) of a trademark or of a sign identical with, similar to or likely to be mistaken for a trademark, include use (or that description of use) otherwise than by means of a graphic representation.

PART II. REGISTERED TRADEMARKS ➔

Introductory

Property right.

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

Grounds for refusal of registration

Absolute grounds for refusal.

4. (1) The following shall not be registered as trademarks—

(a) signs which do not fall within the definition of trademarks in section 2;

(b) trademarks which are devoid of any distinctive character;

(c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;

(d) trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that a trademark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trademark if it consists exclusively of—

(a) the shape which results from the nature of the goods themselves,

(b) the shape of goods which is necessary to obtain a technical result, or

(c) the shape which gives substantial value to the goods.

(3) A trademark shall not be registered if it is—

(a) contrary to public policy or to accepted principles of morality, or

(b) of such a nature as to deceive the public or likely to deceive the public as to the nature, quality or geographical origin of the goods or service or in any other manner.

(4) A trademark shall not be registered if or to the extent that its use is prohibited in Malta by any enactment or rule of law.

(5) A trademark shall not be registered in the cases specified, or referred to, in section 5.

(6) A trademark shall not be registered if, or to the extent that, the application is made in bad faith.

Specially protected emblems.

5. (1) A trademark which consists of or contains—

(a) the arms, or any of the principal armorial bearings of the arms appertaining to the President or the Roman Catholic Archbishop of Malta, or any insignia or device so nearly resembling such arms or any such armorial bearing as to be likely to be mistaken for them or it,

(b) a representation of the Presidential or Episcopal flags,

(c) a representation of the President or the Archbishop, or any colourable imitation thereof, or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Presidential or Episcopal patronage or authorization,

shall not be registered unless it appears to the Comptroller that consent has been given by or on behalf of the President or the Archbishop.

(2) A trademark which consists of a representation of the national flag of Malta shall not be registered.

(3) A trademark which contains a representation of the national flag of Malta shall not be registered if it appears to the Comptroller that the use of the trademark would be misleading or grossly offensive.

(4) A trademark shall not be registered in the cases specified in section 51 or section 52:

Provided that the Minister may by regulation extend the applicability of the provisions of this subsection to apply mutatis mutandis in respect of religions other than the Roman Catholic Apostolic Religion.

Relative grounds for refusal of registration.

6. (1) A trademark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trademark is applied for are identical with the goods or services for which the earlier trademark is protected.

(2) A trademark shall not be registered if because it is either identical with an earlier trademark and is to be registered for goods or services similar to those for which the earlier trademark is protected, or it is similar to an earlier trademark and is to be registered for goods or services identical with or similar to those for which the earlier trademark is protected, there exists a likelihood of confusion on the part of the public, including the likelihood of association by the public with the earlier trademark:

Provided that the mere association without the likelihood of confusion shall not prevent a mark from being registered.

(3) A trademark which -

(a) is identical with or similar to an earlier trademark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trademark is protected,

shall not be registered if, or to the extent that, the earlier trademark has reputation in Malta and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.

(4) A trademark shall not be registered if, or to the extent that, its use in Malta is liable to be prevented -

(a) by virtue of any rule of law protecting an unregistered trademark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in paragraph (a) hereof or in subsections (1) to (3) in particular by virtue of the law of copyright, or registered designs.

A person thus entitled to prevent the use of a trademark is referred to in this Act as "the proprietor of an earlier right" in relation to the trademark.

(5) Nothing in this section prevents the registration of a trademark where the proprietor of the earlier trademark or the proprietor of an earlier right consents to the registration.

Meaning of “earlier trademark”.

7. (1) In this Act an “earlier trademark” means -

(a) a registered trademark, which has a date of application for registration earlier than that of the trademark in question, taking account (where appropriate) of the priorities claimed in respect of the trademarks,

(b) a trademark which, at the date of application for registration of the trademark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well-known trademark.

(2) Subject to its being so registered, references in this Act to an earlier trademark includes a trademark in respect of which an application for registration has been made and which, if registered, would be an earlier trademark by virtue of subsection 1(a).

(3) A trademark as is referred to in subsection (1)(a) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry thereof. However, if the Comptroller is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry no account shall be taken of the expired mark.

Power to remove relative grounds for refusal of registration.

8. (1) The Minister may make regulations providing that a trademark shall not be refused registration on a ground mentioned in section 6.

(2) Such regulations may make such consequential provision as appears to the Minister appropriate with respect to -

(a) the carrying out by the Comptroller of searches of earlier trademarks, and

(b) the persons by whom an application for declaration of invalidity may be made on the grounds specified in section 43(2).

(3) Regulations making such provision as is mentioned in subsection (2)(a) may direct that the provisions of section 35 in so far as they require a search to be carried out shall not have effect.

(4) Regulations making such provision as is mentioned in subsection (2)(b) may provide that section 43(3) in so far as it provides that any person may make an application for a declaration of invalidity shall have effect subject to the provisions of the order.

(5) Regulations under this section may contain such transitional provisions as appear to the Minister to be appropriate.

Effects of a registered trademark

Rights conferred by a registered trademark.

9. (1) The proprietor of a registered trademark has exclusive rights in the trademark. Such rights are infringed by such use of the trademark in Malta as is specified in section 10

without the consent of the proprietor.

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

(3) The rights of the proprietor have effect from the date of registration reckoned in accordance with section 37(3):

Provided that -

(a) no infringement proceedings may be begun before the date on which the trademark is in fact registered; and

(b) no offence under section 72 shall be committed by anything done before the date of publication of the registration.

Infringement of a registered trademark.

10. (1) A person infringes a registered trademark if he uses in the course of trade a sign which is identical with the trademark in relation to goods or services which are identical with those for which it is registered.

(2) A person infringes a registered trademark if he uses in the course of trade a sign where because -

(a) the sign is identical with the trademark and is used in relation to goods or services similar to those for which the trademark is registered, or

(b) the sign is similar to the trademark and is used in relation to goods or services identical with or similar to those for which the trademark is registered,

there exists a likelihood of confusion on the part of the public, including the likelihood of association with the trademark:

Provided that the mere association without the likelihood of confusion shall not be considered as constituting an infringement.

(3) A person infringes a registered trademark if he uses in the course of trade a sign which -

(a) is identical with or similar to the trademark, and

(b) is used in relation to goods or services which are not similar to those for which the trademark is registered,

where the trademark has a reputation in Malta and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.

(4) For the purposes of this section a person uses a sign if, in particular, he -

(a) affixes it to the goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;

(c) imports or exports goods under the sign; or

(d) uses the sign on business papers or in advertising.

(5) A person who applies a registered trademark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trademark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(6) Nothing in the preceding provisions of this section shall be construed as preventing the use of a registered trademark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee.

However, any such use otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trademark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trademark.

Limits on effect of a registered trademark.

11. (1) A registered trademark is not infringed by the use of another registered trademark in relation to goods or services for which the latter is registered.

(2) A registered trademark is not infringed by -

(a) the use by a person of his own name or address,

(b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services, or

(c) the use of the trademark where it is necessary to indicate the intended purpose of a product or service (in particular, as accessories or spare parts):

Provided the use is in accordance with honest practices in industrial or commercial matters.

(3) (a) A registered trademark is not infringed by the use in the course of trade in Malta of an earlier right.

(b) For the purposes of this subsection an “earlier right” means an unregistered trademark or other sign continuously used in relation to goods or services by a person or his predecessor in title from a date prior to whichever is the earlier of—

(i) the use of the first-mentioned trademark in relation to those goods or services by the proprietor or his predecessor in title, or

(ii) the registration of the first-mentioned trademark in respect of those goods or services in the name of the proprietor or a predecessor in title of his; and

(iii) an earlier right shall be regarded as applying if, or to the extent that, its use is protected by virtue of any rule of law.

Exhaustion of rights conferred by a registered trademark.

12. (1) A registered trademark is not infringed by the use of the trademark in relation to goods which have been put on the market in Malta under that trademark by the proprietor or with his consent.

(2) Subsection (1) shall not apply where there exist legitimate reasons for the proprietor to oppose further dealings in the goods in particular but without prejudice to the generality hereof, where the condition of the goods has been changed or impaired after they have been put on the market.

Registration subject to disclaimer or limitation.

13. (1) An applicant for registration of a trademark, or the proprietor of a registered trademark, may—

(a) disclaim any right to the exclusive use of any specified element of the trademark, or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

(2) The Comptroller may disclaim any right to the exclusive use of any specified element of the trademark.

(3) The Minister may make rules providing for the publication and entry in the register of a disclaimer or limitation.

(4) Where the registration of a trademark is subject to a disclaimer or limitation, the rights conferred by section 9 shall be restricted accordingly.

Infringement proceedings

Action for infringement.

14. (1) Subject to the provisions of sections 28 and 29, an infringement of a registered trademark is actionable by the proprietor of the trademark by writ of summons to be filed in the First Hall of the Civil Court.

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

Order for erasure, etc. of offending sign.

15. (1) Where a person is found to have infringed a registered trademark, the Court may make an order requiring him—

(a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control, or

(b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

(2) If an order under subsection (1) is not complied with, or it appears likely to the Court that such an order would not be complied with, the Court may order that the infringing goods, material or articles be delivered to such person as the Court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

Order for delivery up of infringing goods, material or articles.

16. (1) The proprietor of a registered trademark may apply to the Court for an order for the delivery up to him, or such other person as the Court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a business.

(2) An application shall not be made after the end of the period specified in section 18; and no order shall be made unless the Court also makes, or it appears to the Court that there are grounds for making, an order under section 19.

(3) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this section shall, retain them pending the decision of the Court under section 19.

(4) Nothing in this section affects any other power of the Court.

Meaning of “infringing goods, material or articles”.

17. (1) In this Act the expressions “infringing goods”, “infringing material” and “infringing articles” shall be construed in accordance with the following subsections of this section.

(2) Goods are “infringing goods”, in relation to a registered trademark, if they or their packaging bear a sign identical or similar to that mark and—

(a) the application of the sign to the goods or their packaging is an infringement of the registered trademark, or

(b) the goods are proposed to be imported into Malta and the application in Malta, of the sign, to them or their packaging would be an infringement of the registered trademark, or

(c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trademark.

(3) Material is “infringing material”, in relation to a registered trademark, if it bears a sign identical or similar to that mark and—

(a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trademark, or

(b) it is intended to be so used and such use would infringe the registered trademark.

(4) “Infringing articles”, in relation to a registered trademark, means articles—

(a) which are specifically designed or adapted for making copies of a sign identical or similar to that mark, and

(b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been used or are to be used to produce infringing goods or material.

Period after which remedy of delivery up not available.

18. (1) An application for an order under section 16 may not be made after the end of the period of six years from—

(a) in the case of infringing goods, the date on which the trademark was applied to the goods or their packaging,

(b) in the case of infringing material, the date on which the trademark was applied to the material, or

(c) in the case of infringing articles, the date on which they were made,

except as provided in the following subsection.

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

Order as to disposal of infringing goods, material or articles.

19. (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 16, an action by writ of summons may be brought before the Court by any party interested—

(a) for an order that they be destroyed or forfeited to such person as the Court may think fit, or

(b) for a decision that no such order should be made.

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

(3) The Court shall order the service of the writ on persons having an interest in the goods, material or articles, and any person having an interest shall be entitled—

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

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

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

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

Remedy for groundless threats of infringement proceedings.

20. (1) Where a person threatens another with proceedings for infringement of a registered trademark other than -

(a) use of the mark on goods or their packaging,

(b) the importation of goods to which, or to the packaging of which, the mark has been applied, or

(c) the supply of services under the mark,

any person aggrieved may bring proceedings for relief under this section by writ of summons before the Civil Court, First Hall.

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

(a) a declaration that the threats are unjustified,

(b) an injunction against the continuance of the threats,

(c) damages in respect of any loss he may have sustained by the threats,

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

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

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

Registered trademark as object of property

Nature of a registered trademark.

21. A registered trademark is the personal property of its owner.

Co-ownership of a registered trademark.

22. (1) Where a registered trademark is granted to two or more persons jointly, each of

them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trademark.

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

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

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

(a) grant a licence to use the registered trademark, or

(b) assign or cede control of his share in the registered trademark.

(5) Infringement proceedings may be brought by any co-proprietor, but a co-proprietor may not, without the leave of the Court, proceed with the action unless the other, or each of the other co-proprietors, is joined in the suit.

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

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

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

Transmission of a registered trademark.

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

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

(2) An assignment or other transmission of a registered trademark may be partial and limited so as to apply -

(a) in relation to some but not all of the goods or services for which the trademark is registered, or

(b) in relation to the use of the trademark in a particular manner or a particular locality.

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

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

Registration of transactions affecting a registered trademark.

24. (1) On application being made to the Comptroller by -

(a) a person claiming to be entitled to an interest in or under a registered trademark by virtue of a registrable transaction, or

(b) any other person claiming to be affected by such a transaction,

the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions —

(a) an assignment of a registered trademark or any right in it;

(b) the grant of a licence under a registered trademark;

(c) the transfer of a registered trademark by testamentary disposition;

(d) an order of a Court or other competent authority transferring a registered trademark or any right in or under it.

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

(a) the transaction is ineffective as against a person acquiring in good faith a conflicting interest in the registered trademark, and

(b) a person claiming to be a licensee by virtue of the transaction shall not have the protection of section 28 or 29.

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

(a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with the date of the transaction, or

(b) the Court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter.

(5) The Minister may make regulations prescribing rules as to -

(a) amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence, and

(b) the removal of such particulars from the register -

(i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired;

(ii) where no such period is indicated and, after such period as may be prescribed, and after the Comptroller has notified the parties of his intention to remove the particulars from the register and the parties have not indicated their agreement that such particulars should not be removed for such period as the parties shall have agreed and indicated to the Comptroller;

(c) the amendment or removal from the register of particulars relating to a security interest on the application of, or with the consent of, the person entitled to the benefit of that interest.

Application for registration of a trademark as an object of property.

25. The provisions of section 21 to 24 apply mutatis mutandis in relation to an application for the registration of a trademark in the same manner in relation to a registered trademark.

Licensing of a registered trademark.

26. (1) A licence to use a registered trademark may be general or limited. A limited licence may in particular, apply -

(a) in relation to some but not all the goods or services for which the trademark is registered, or

(b) in relation to use of the trademark in a particular manner or a particular locality.

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

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

Exclusive licences.

27. (1) In this Act an "exclusive licence" means a licence (whether general or limited) authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trademark in the manner authorised by the licence.

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

General provisions as to the rights of licensees in case of infringement.

28. (1) The provisions of this section shall apply with respect to the rights of a licensee in relation to infringement of a registered trademark:

Provided that they shall not apply where or to the extent that, in accordance with section 29(1) an exclusive licensee has a right to bring proceedings in his own name.

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

(3) If the proprietor -

(a) refuses to do so, or

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

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

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

Exclusive licensee having right and remedies of assignee.

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

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

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

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

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

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

(i) the Court shall in assessing damages take into account-

(1) the terms of the licence, and

(2) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

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

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

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

(6) The proprietor of a registered trademark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 16; and the Court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licensee.

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

Application for a registered trademark

Application for registration.

30. An application for registration of a trademark shall be made to the Comptroller in such manner as may be prescribed.

Date of filing.

31. (1) The date of filing of an application for registration of a trademark is the date on which the prescribed elements are furnished to the Comptroller by the applicant:

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

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

Classification of trademarks.

32. (1) Goods and services shall be classified for the purposes of the registration of trademarks according to such system of classification as may be prescribed.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Comptroller, whose decision shall be final.

Priority

Claim to priority of Convention application.

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

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

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and

(b) the registrability of the trademark shall not be affected by any use of the mark in Malta in the period between that date and the date of the application under this Act.

(3) (a) Any filing which in a country which is a member of the World Trade Organisation or is a party to the Paris Convention is under its legislation or any international agreement to which such country is a party, treated as if it were a regular national filing, shall be treated as giving rise to the right of priority.

(b) For the purposes of this subsection “regular national filing” means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent application.

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

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and

(b) it has not yet served as a basis for claiming a right of priority,

and the previous application may not thereafter serve as a basis for claiming a right of priority.

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

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

Claim to priority from other relevant overseas application.

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

(2) Such regulations may make provisions similar to those contained in section 33 in relation to Convention applications or such other provision as appears to the Minister to be appropriate.

Registration procedure

Examination of application.

35. (1) The Comptroller shall examine whether an application for registration of a trademark satisfies the requirements of this Act and for that purpose he shall carry out a search, to such extent as he considers necessary, of earlier trademarks.

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

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

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

Withdrawal, restriction or amendment of application.

36. (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

(2) Save as provided in subsection (1), an application may be amended, at the request of the applicant, only by correcting —

(a) the name or address of the applicant,

(b) errors of wording or of copying, or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trademark or extend the goods or services covered by the application.

Registration.

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

(2) A trademark shall not be registered and the application shall be deemed to be withdrawn unless any fee prescribed in respect of any action taken before the registration is paid within the prescribed period.

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

(4) On the registration of a trademark the Comptroller shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration.

Duration, renewal and alteration of registered trademark

Duration of registration.

38. (1) A trademark shall be registered for a period of ten years from the date of registration.

(2) Registration may be renewed in accordance with section 39 for further periods of ten years.

Renewal of registration.

39. (1) The registration of a trademark may be renewed at the request of the proprietor, subject to the payment of the prescribed renewal fee not more than 6 months before the date of expiry.

(2) The Minister may by regulation make rules providing that the Comptroller informs the proprietor of a registered trademark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) Without prejudice to subsection (1) a request for renewal must be made, before the expiry of the registration:

Provided that, the request may be made and the fee paid within such further period as may be prescribed, in which case a prescribed additional renewal fee must also be paid within that period.

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

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

(6) Provision may be made by rules for the restoration of the registration of a trademark which has been removed from the register, subject to such conditions (if any) as may be prescribed.

(7) The renewal or restoration of the registration of a trademark shall be published in the prescribed manner.

Alteration of a registered trademark.

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

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

(3) Provision shall be made by rules for the publication of any such alteration and the making of objections by any person claiming to be affected by it.

Surrender, revocation and invalidity

Surrender of a registered trademark.

41. (1) A registered trademark may be surrendered by the proprietor in respect of any or all of the goods or services for which it is registered.

(2) Provision may be made by rules —

(a) as to the manner and effect of a surrender, and

(b) for protecting the interests of other persons having a right in the registered trademark.

Revocation of registration.

42. (1) The registration of a trademark may be revoked on any of the following grounds —

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in Malta, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for such non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for such non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent, it is liable to mislead the public in relation to the goods or services for which it is registered, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trademark includes the use in a form differing in such elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in Malta includes affixing the trademark to goods or to the packaging of goods in Malta solely for export purposes.

(3) The registration of a trademark shall not be revoked on the ground mentioned in paragraphs (a) or (b) of subsection (1) if such use as is referred to in those paragraphs is commenced or resumed after the expiry of the five-year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five-year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application is likely to be made.

(4) An application for revocation may be made by writ of summons before the First Hall, Civil Court by any person.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trademark is registered, revocation shall be limited to those goods or services.

(6) Where the registration of a trademark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from —

- (a) the date of the application for revocation, or
- (b) if grounds for revocation existed at an earlier date, such earlier date.

Grounds for invalidity of registration.

43. (1) The registration of a trademark may be declared invalid on the ground that the trademark was registered in breach of section 4 or any of the provisions referred to in that section.

Where the trademark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trademark may, unless the proprietor of that earlier trademark or other earlier right has consented to the registration, be declared invalid on the ground —

(a) that there is an earlier trademark in relation to which the conditions set out in section 6 (1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 6 (4) is satisfied.

(3) An application for a declaration of invalidity may be made by any person, by writ of summons before the First Hall of the Civil Court.

(4) In the case of bad faith in the registration of a trademark, the Comptroller himself may apply to the Court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trademark is registered, the trademark shall be declared invalid with regard to those goods or services only.

(6) Where the registration of a trademark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

Effect of acquiescence.

44. (1) Where the proprietor of an earlier trademark or other earlier right being aware of the use of a registered trademark in Malta, has acquiesced to such use for a continuous period of five years, he shall cease to be entitled to any right on the basis of that earlier trademark or other right —

(a) to apply for a declaration that the registration of the later trademark is invalid, or

(b) to oppose the use of the later trademark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trademark was applied for in bad faith.

(2) In the cases referred to in subsection (1), the proprietor of the later trademark is not entitled to oppose the use of the earlier trademark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trademark or right may no longer be invoked against his later trademark.

Collective marks

Collective marks.

45. (1) A collective mark is a mark distinguishing the goods or services of members of an association which is the proprietor of the mark from those of other undertakings.

(2) The provisions of this Act apply to collective marks subject to the provisions of Schedule 1 to this Act.

Certification marks

Certification marks.

46. (1) A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

(2) the provisions of this Act apply to certification marks subject to the provisions of Schedule 2.

PART III. INTERNATIONAL MATTERS ➡

International registration

The Madrid Protocol.

47. In this Part —

“the Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on 27 June, 1989;

“the International Bureau” has the meaning given by Article 2(1) of that Protocol; and

“international trademark (Malta)” means a trademark which is entitled to protection in Malta under that Protocol.

Power to make provision giving effect to Madrid Protocol.

48. (1) The Minister may by Order make such provisions as may be necessary for giving effect in Malta to the provisions of the Madrid Protocol and without prejudice to the generality of the foregoing.

The Order may, in particular, be made with respect to —

(a) the making of applications for international registrations by way of the Industrial Property Office as office of origin;

(b) the procedures to be followed where the basic Malta application or registration fails or ceases to be in force;

(c) the procedures to be followed where the Industrial Property Office receives from the International Bureau a request for extension of protection to Malta;

(d) the effects of a successful request for extension of protection to Malta;

(e) the transformation of an application for an international registration, or an international registration, into a national application for registration;

(f) the communication of information to the International Bureau;

(g) the payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals.

(2) Without prejudice to the generality of subsection (1), provision may be made by regulations under this section applying in relation to “an international trademark (Malta)” the provisions of section 20 and of sections 72 to 86 of this Act.

The Paris Convention

The Paris Convention.

49. (1) In this Part —

(a) “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time, and

(b) “Convention country” means a country, other than Malta, which is a party to that Convention.

(2) The Minister may make regulations to make provision, as appear to him appropriate in consequence of any revision or amendment of the Paris Convention after the passing of this Act to enable Malta to comply with any provisions of such amendment, and such regulations may in particular provide that any of the provisions of Part II of this Act shall no longer apply or shall apply with such amendments as may be required.

Protection of well-known trademarks: Article 6 bis.

50. (1) References in this Act to a trademark which is entitled to protection under the Paris Convention as a well-known trademark are to a mark which is well-known in Malta as being the mark of a person who is a national of a Convention country, or is domiciled in, or has a real and effective industrial or commercial establishment in a Convention country, whether or not that person carries on business, or has any goodwill, in Malta, and reference to the proprietor of such a mark shall be construed accordingly.

(2) Subject to the provisions of section 44, the proprietor of a trademark which is entitled to protection under the Paris Convention as a well-known trademark is entitled to restrain by

injunction the use in Malta of a trademark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

(3) Nothing in subsection (2) shall affect the continuation of any bona fide use of a trademark begun before the coming into force of this section.

National emblems, etc., of Convention countries: Article 6ter.

51. (1) A trademark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Comptroller that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trademark which consists of or contains the armorial bearing or any other State emblem of a Convention country which is protected under the Paris Convention shall not be registered without the authorisation of the competent authorities of that country.

(3) A trademark which consists of or contains an official sign or hallmark indicating control and warranty adopted by a Convention country shall not, where the sign or hall mark is protected under the Paris Convention, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned.

(4) The provisions of this section relative to national flags and other State emblems, and official signs or hallmarks apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trademark on the application of a national of a country who is authorised to make use of a State emblem or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trademark, those authorities are entitled to restrain any use of the mark in Malta without their authorisation.

Emblems, etc, of certain international organisations: Article 6 ter.

52. (1) This section applies to the armorial bearing, flags or other emblems, and the names and their abbreviations, of international intergovernmental organisations of which one or more Convention countries are members.

(2) A trademark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention shall not be registered without the authorisation of the international organisation concerned, unless it appears to the Comptroller that the use of the emblem, abbreviation or name in the manner proposed —

(a) is not such as suggests to the public that a connection exists between the organisation and the trademark, or

(b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section relative to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where by virtue of this section the authorisation of an international organisation is or would be required for the registration of a trademark, that organisation is entitled to restrain any use of the mark in Malta without its authorisation.

(5) Nothing in this section affects the right of a person whose bona fide use of the trademark in question began before 1 January 2000.

Notification under Article 6ter of the Convention.

53. (1) For the purposes of section 51 State emblems of a Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that -

(a) the country in question has notified Malta in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, sign or hallmark,

(b) the notification remains in force, and

(c) Malta has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.

(2) For the purposes of section 52 the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that -

(a) the organisation in question has notified Malta in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, abbreviation or name,

(b) the notification remains in force, and

(c) Malta has not objected to it in accordance with Article 6ter (4) or any such objection has been withdrawn.

(3) Notification under Article 6ter (3) of the Paris Convention shall have effect only in relation to applications for registration made more than two months after the receipt of the notification.

(4) The Comptroller shall keep and make available for public inspection by any person, as prescribed in the regulations, a list of the state emblems and official signs or hallmarks, and the emblems, abbreviations and names of international organisations, which are for the time being protected under the Paris Convention by virtue of notification under Article 6ter (3).

Acts of agent or representative: Article 6septies.

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

(2) The proprietor may make an application by writ of summons before the First Hall of the Civil Court for a declaration of the invalidity of the registration, or may apply for the rectification of the register so as to substitute his name as the proprietor of the registered trademark.

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

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

(5) An application under subsection (2) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (3) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

PART IV. ADMINISTRATIVE AND OTHER SUPPLEMENTARY PROVISIONS ➡

The register

Maintenance and content of register.

55. (1) (a) The Comptroller shall maintain a register of trademarks.

(b) References in this Act to “the register” are to that register; and references to registration, in particular, in the expression “registered trademark”, are, unless the context otherwise requires, to registration in that register.

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

(a) registered trademarks,

(b) such particulars as may be prescribed of registrable transactions affecting a registered trademark, and

(c) such other matters relating to registered trademarks as may be prescribed.

(3) The register shall be kept in such manner as may be prescribed, and provision shall in particular be made for -

(a) public inspection of the register, and

(b) the supply of certified or uncertified copies, or extracts, of entries in the register.

Rectification or correction of the register.

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

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

(2) An application for rectification may be made either to the Comptroller or to the Court:

Provided that if proceedings concerning the trademarks in question are pending before the Court -

(a) the application must be made to the Court; and

(b) if the application is made to the Comptroller, he may at any stage of the proceedings refer the application to the Court.

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

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

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

Adaptation of entries to new classification.

57. (1) The Minister may by regulations make rules empowering the Comptroller to do such things as may be necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trademarks, and without prejudice to the generality of the aforesaid provision may in particular be made for the amendment of existing entries on the register so as to accord with the new classification.

(2) Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the Comptroller that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the right of any person.

(3) The rules may moreover empower the Comptroller -

(a) to require the proprietor of a registered trademark, within such time as may be prescribed, to file a proposal for amendment of the register, and

(b) to cancel or refuse to renew the registration of the trademark in the event of his failing to do so.

(4) Any such proposal shall be advertised, and may be opposed, in such manner as may be prescribed.

Powers and duties of the Comptroller

Power to require use forms.

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

Information about applications and registered trademarks.

59. (1) Subject to such restrictions as the Minister may by regulations impose after publication of the registration of a trademark, the Comptroller shall on request provide a person with such information and permit him to inspect such documents relating to the registered trademark, as may be specified in the request.

Any such request must be made in such manner and be accompanied by such fee as may be prescribed.

(2) Before publication of registration of a trademark, documents or information constituting or relating to the application shall not be published by the Comptroller or communicated by him to any person except -

(a) in such cases and to such extent as may be prescribed, or

(b) with the consent of the applicant.

Exclusion of liability in respect of official acts.

60. (1) The Comptroller shall not be taken to warrant the validity of the registration of a trademark under this Act or under any treaty, convention, arrangement or engagement to which Malta is a party.

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

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

Legal proceedings and appeals

Registration to be prima facie evidence of validity.

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

Certification of validity of contested registration.

62. (1) If in proceedings before the Court the validity of the registration of a trademark is contested and it is found by the Court that the trademark is validly registered, the Court shall give judgement accordingly.

(2) Where the Court has given such a judgement and in subsequent proceedings -

(a) the validity of the registration is again questioned, and

(b) the proprietor obtains a final order or judgement in his favour, he shall be entitled to his costs unless the Court directs otherwise.

Comptroller's appearance in proceedings involving the register.

63. (1) In proceedings before the Court involving an application for -

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

the Comptroller shall be notified with the proceedings and shall be entitled to appear and to be heard if so directed by the Court.

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

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

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

Appeals from the Comptroller's decision.

64. (1) Any decision of the Comptroller under this Act, may be appealed from, before the Court of Appeal composed in the manner provided in subsection (6) of section 41 of the Code of Organization and Civil Procedure by application within fifteen days of service of the Comptroller's decision.

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

(3) The Minister may make rules governing appeals to the Court of Appeal under this Act, and presenting a scale of costs and fees in relation to such appeals.

Rules, fees, hours of business, etc.

Power of Minister to make rules.

65. (1) The Minister responsible for the protection of industrial property may make regulations for the better administration of this Act, making such rules as are required by any provisions of this Act, prescribing anything authorised or required by any provision of this Act to be prescribed, and generally for regulating practice and procedure under this Act,

and in particular provision may be made —

- (a) with regard to the manner of filing of applications and other documents;
- (b) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (c) with regard to the service of documents;
- (d) authorising the rectification of irregularities of procedure;
- (e) prescribing time limits for anything required to be done in connection with any proceeding under this Act;
- (f) providing for the extension of any time limit so prescribed, or specified by the Comptroller whether or not such time limit has already expired.

Fees.

66. (1) There shall be paid in respect of applications and other matters under this Act such fees as may be prescribed.

(2) Provision may be made by rules as to -

- (a) the payment of a single fee in respect of two or more matters, and
- (b) the circumstances, if any, in which a fee may be repaid or remitted.

Hours of business and business days.

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

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

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

Trademark agents

Recognition of agents.

68. Except as may otherwise be prescribed, any act required or authorised by this Act to be done by or in respect of a person in connection with the registration of a trademark, or any procedure relating to a registered trademark, may be done by or in respect of an agent authorised by that person in writing.

The register of trademark agents attorneys.

69. (1) The Minister may make rules requiring the keeping of a register of persons who act as agent for the purpose of applying for or obtaining the registration of trademarks; and in this Act a “registered trademark agent” means a person whose name is entered in the register kept under this section.

(2) The Minister may make rules regulating the registration of persons as registered trademark agents, and may in particular -

(a) require the payment of such fees in connection with such registration as may be prescribed, and

(b) authorise in such cases as shall be specified the erasure from the register of the name of any person registered as a registered trademark agent or the suspension of such a registration.

(3) Only registered persons may -

(a) carry on a business under any name or other description which contains the words “registered trademark agent”; or

(b) in the course of a business otherwise describe or hold himself out, or permit themselves to be described or held out, as registered trademark agents.

Privilege for communication with registered trademark agents.

70. The provisions of section 588 of the Code of Organization and Civil Procedure shall apply with regard to registered trademark agents as it applies with respect to Advocates and legal procurators.

Power of Comptroller to refuse to deal with certain agents.

71. The Comptroller may, in accordance with such rules as may be prescribed refuse to recognize as agent in respect of any business under this Act -

(a) a person who not being a registered trademark agent shall have falsely posed as such;

(b) a person whose name has been erased from and not restored to, or who is suspended from, the register of trademark agent on the ground of misconduct;

(c) a person who is found to have been guilty of such conduct as would, in the case of an individual registered in the register of trademark agents, render him liable to have his name erased from the register on the ground of misconduct;

(d) a partnership or body corporate of which one of the partners or directors is a person whom the registrar could refuse to recognize under paragraph (a), (b) or (c) above.

PART V. CRIMINAL OFFENCES ➔

Offences

Unauthorised use of trademark, etc. in relation to goods.

72. (1) Any person who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor -

(a) applies to goods or their packaging a sign identical to, or likely to be mistaken for, a registered trademark, or

(b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign, or

(c) has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b), or

(d) applies a sign identical to, or likely to be mistaken for, a registered trademark to material intended to be used-

(i) for labelling or packaging goods,

(ii) as a business paper in relation to goods, or

(iii) for advertising goods, or

(e) uses, in the course of a business material bearing such a sign for labelling or packaging goods, or as a business paper in relation to goods, or for advertising goods, or

(f) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (e), or

(g) (i) makes an article specifically designed or adapted for making copies of a sign of or to make a sign likely to be mistaken for, a registered trademark, or

(ii) has such an article in his possession, custody or control in the course of a business,

knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods,

shall be guilty of an offence against this section.

(2) A person does not commit an offence against this section unless -

(a) the goods to which the offence refers are goods in respect of which the trademark is registered, or

(b) the trademark has a reputation in Malta and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trademark.

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

(4) A person guilty of an offence under this section shall be liable on conviction to imprisonment for a term not exceeding three years or to a fine (multa) of not more than LM10,000 or to both such fine and imprisonment.

Falsification of register, etc.

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

(a) makes, or causes to be made, a false entry in the register of trademarks; or

(b) makes, or causes to be made, anything falsely purporting to be a copy of an entry in the register, or

(c) produces or tenders or causes to be produced or tendered in evidence any such thing,

shall be guilty of an offence against this section.

(2) A person guilty of an offence against this section shall be liable on conviction to imprisonment for a term not exceeding two years or a fine (multa) of not more than Lm5,000 or to both such fine and imprisonment.

Falsely representing trademark as registered.

74. (1) It shall be an offence against this section for a person -

(a) falsely to represent that a mark is a registered trademark, or

(b) to make a false representation as to the goods or services for which a trademark is registered,

knowing or having reason to believe that the representation is false.

(2) For the purposes of this section, the use in Malta in relation to a trademark -

(a) of the word "registered", or

(b) of any other word or symbol importing a reference, express or implied, to registration,

shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in Malta and that the trademark is in fact so registered for the goods or services in question.

(3) A person guilty of an offence against this section shall be liable on conviction to a fine (multa) of not more than Lm5,000.

Unauthorised use of certain devices, emblems, etc.

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

(2) Any person who contravenes the provisions of subsection (1) of this section shall be guilty of an offence against this section and shall on conviction be liable to a fine (multa) of not more than Lm3,000.

Delivery up of infringing articles, etc.

76. The Court may, moreover, in the cases referred to in section 73, on the demand of the prosecution, order that the machinery or other industrial means or contrivances used in contravention of the rights of the proprietors of the trademarks, the infringing articles, and the apparatus destined for their production, be forfeited, wholly or in part, and delivered to the holder of the trademark, without prejudice to any other right to relief under this Act.

Powers of magistrates.

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

Where owner of goods is unknown.

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

Forfeiture of things seized.

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

Procedure where owner is unknown.

80. (1) In the case referred to in section 78, the Court shall order the issue of banns which shall be published twice, with an interval of at least eight days, in the Government Gazette, and posted up at the entrance of the building wherein the Court sits, and in any other place which the court may deem fit, stating that the goods or things seized shall be forfeited, unless at the time and place named in the banns the owner of such goods or things or other person interested in such goods or things attends before the Court at the time and place indicated in the banns and shows cause to the contrary.

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

Award of compensation to parties in good faith.

81. The Court may direct that the goods or things so forfeited be destroyed or disposed of,

after the trademarks or other trade descriptions have been obliterated from them, and may also direct that, out of the net proceeds which may be realized by the disposal of such goods or things and up to the amount thereof, any persons who, being in good faith, were injured by the forfeiture, be awarded compensation for any loss caused to them.

Limitation of criminal actions.

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

Use of forged marks.

83. The provisions relating to the use of forged marks shall not apply to the use of any mark of manufacture or description used in trade to indicate goods of a particular class, or the manufacture thereof by any particular method, where, at the time of the promulgation of this Act, such mark of manufacture or description was lawfully and generally applied for the above-mentioned purpose:

Provided that where such mark of manufacture or description includes the name of a place or country and the goods are not produced in the place or country indicated in the mark of manufacture or description so used, the provisions of this section shall not apply, unless there is added to the mark of manufacture or description, immediately before or after the name of the said place or country, in an equally conspicuous manner, the name of the place or country in which the goods were actually made or produced, and unless there is also stated that the goods were made or produced in that place or country.

Person falsely representing himself as a registered trademark agent.

84. Any person who falsely claims to be a registered trademark agent when he is not so registered in accordance with section 69 of this Act, shall be guilty of an offence against this section and shall in conviction be liable to a fine (multa) of not more than LM500.

Right to damages not affected.

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

Employer and Employee.

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

PART VI. GENERAL PROVISIONS ➡

Burden of proving use of trademark.

87. In any civil proceedings under this Act if a question arises as to the use to which a registered trademark has been put, the burden of proof that a particular use has been made

shall lie on the proprietor.

Limitations of civil action.

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

PART VII. TRANSITIONAL PROVISIONS ➡

Interpretation.

89. (1) In this Part —

Cap. 29.

“existing registered mark” means a trademark, registered under the Industrial Property (Protection) Ordinance immediately before the commencement of this Act;

“former register” means the register kept under the Old Law;

“new register” means the register kept under this Act;

“Old Law” means the Industrial Property (Protection) Ordinance and any other enactment or rule of law applying to existing registered marks immediately before the commencement of this Act.

(2) For the purposes of this Part —

(a) an application shall be treated as pending on the commencement of this Act if it was made but not finally determined before commencement, and

(b) the date on which it was made shall be taken to be the date of filing under the Old Law.

Existing registered marks.

90. (1) Existing registered marks shall, on the commencement of this Act, be transferred to the new register and subject to the provisions of this Part, shall have effect as if they were registered under this Act.

(2) Existing registered marks registered as a series under section 91(2) and 91(3) of the Ordinance shall be similarly registered in the new register.

(3) In any other case notes indicating that existing registered marks are associated with other marks shall cease to have effect on the commencement of this Act.

Proceedings under the Old Law.

91. (1) Proceedings under the Old Law which are pending on the commencement of this Act shall be dealt with under the Old Law and any necessary alteration pursuant to such proceedings shall be made to the new register.

(2) A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall be transferred to the new register and have effect as if entered on the register in pursuance of section 13 of this Act.

Effects of registration: infringement.

92. (1) Upon the coming into force of this Act sections 9 to 12 of this Act shall apply in relation to an existing registered mark and subject to subsection (2) hereof, section 14 of this Act shall apply in relation to any infringement of an existing registered mark committed after the commencement of this Act.

(2) After the coming into force of this Act, it shall not be an infringement of —

(a) an existing registered mark, or

(b) a registered trademark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,

to continue with any use which did not amount to infringement of the existing registered mark under the Old Law.

Infringing goods, material or articles.

93. Section 16 of this Act shall apply to infringing goods, material or articles whether made before or after the commencement of this Act.

Rights and remedies of licensee or authorised user.

94. (1) Section 28 of this Act shall apply to licences granted before the commencement of this Act, but only in relation to infringements committed after its commencement.

(2) Paragraph 14 of Schedule 2 of this Act shall apply only in relation to infringements committed after the commencement of this Act.

Co-ownership of a registered mark.

95. The provisions of section 22 of this Act shall apply as from the commencement of this Act to an existing registered mark of which two or more persons were immediately before the commencement of this Act registered as joint proprietors.

Assignment, etc. of a registered mark.

96. (1) Section 23 of this Act shall apply to transactions and events occurring after the commencement of this Act in relation to an existing registered mark; and the Old Law shall continue to apply in relation to transactions and events occurring before its commencement.

(2) Existing entries under sections 98 and 100 of the Industrial Property (Protection) Ordinance shall be transferred on the commencement of this Act to the new register and have effect as if made under section 24 of this Act.

(3) An application for registration under sections 98 and 100 of the Industrial Property (Protection) Ordinance which is pending before the Comptroller on the commencement of this Act shall be treated as an application for registration under section 24 of this Act and shall be acted upon accordingly:

Provided that the Comptroller may require the applicant to amend his application so as to conform with the requirements of this Act.

(4) An application for registration under sections 98 and 100 of the Industrial Property (Protection) Ordinance which has been determined by the Comptroller but not finalised before the commencement of this Act shall be dealt with under the Old Law; and sub-paragraph (2) above shall apply in relation to any resulting entry in the register.

(5) Where, before the commencement of this Act, a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration after its commencement shall be made under section 24 of this Act.

Licensing of a registered mark.

97. Sections 26 and 27(2) of this Act shall apply only in relation to licences granted after the commencement of this Act.

Pending applications for registration.

98. (1) An application for registration of a mark under the Old Law which is pending on the commencement of this Act shall be dealt with under the Old Law, subject to the other provisions of this section, and, when registered, the mark shall be treated for the purposes of this Part as an existing registered mark.

(2) The power of the Minister under section 65 of this Act to make rules regulating practice and procedure, and in relation to the matters mentioned in subsection (2) of that section, is exercisable in relation to such an application; and different provision may be made for such applications from that made for other applications.

Conversion of pending application.

99. (1) In the case of a pending application for registration which has not been advertised under section 87 of the Industrial Property (Protection) Ordinance before the commencement of this Act, the applicant may give notice to the Comptroller claiming to have the registrability of the mark determined in accordance with the provisions of this Act.

(2) The notice must be in the prescribed form, be accompanied by the appropriate fee and be given no later than six months after the commencement of this Act.

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

Trademarks registered according to old classification.

100. The Comptroller may exercise the powers conferred by rules under section 57 of this Act to ensure that any existing registered marks which do not conform to the system of classification prescribed under section 32 of this Act are brought in conformity with such

system.

Claim to priority from overseas application.

101. Section 33 of this Act shall apply to an application for registration under this Act made after the commencement of this Act notwithstanding that the Convention application was made before commencement.

Duration and renewal of registration.

102. (1) Section 38(1) of this Act applies in relation to the registration of a mark in pursuance of an application made after the commencement of this Act; and the Old Law shall continue to apply in any other case.

(2) Sections 38(2) and 39 of this Act shall apply where the renewal falls due on or after 1st January, 2001; and the Old Law shall continue to apply in any other case.(3) In either case the date of payment of the fee shall be immaterial.

Repeal of certain provisions of the Industrial Property (Protection) Ordinance.

103. Part III of the Industrial Property (Protection) Ordinance and every reference to trademarks in Part IV and Part V thereof, shall be deemed as if it were not made.

SCHEDULE 1. COLLECTIVE MARKS ➡

General

1. The provisions of this Act apply to collective marks subject to the following provisions which may, be regulations, be amended by the Minister.

Signs of which a collective mark may consist

2. In relation to a collective mark the reference in the definition of “trademark” in section 2 to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

Indication of geographical origin

3. Notwithstanding section 4(1)(c), a collective mark which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be registered:

Provided that the proprietor of such a mark shall not be entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters particularly by a person who is entitled to use a geographical name.

Mark not to be misleading as to character or significance

4. (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be construed as

something other than a collective mark.

(2) The Comptroller may accordingly require that a mark in respect of which application is made for registration includes some indication that it is a collective mark; and notwithstanding the provisions of section 36(2), an application may be amended so as to comply with any such requirement.

Regulations governing use of collective mark

5. An applicant for registration of a collective mark must file with the Comptroller regulations governing the use of the mark specifying the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions for the use of the mark, as well as any sanctions against misuse and any further requirements with which the regulations have to comply as may be established by any rule made by the Minister.

Approval of regulations by Comptroller

6. (1) A collective mark shall not be registered unless the regulations governing the use of the mark -

(a) comply with paragraph 5(2) and any further requirements imposed by rules, and

(b) are not contrary to public policy or to accepted principles of morality.

(2) The application shall be deemed to be withdrawn if before the end of any period as may be prescribed after the date of the application for registration of a collective mark, the applicant fails to file the regulations with the Comptroller and pay the prescribed fee.

7. (1) The Comptroller shall consider whether the requirements mentioned in paragraph 6(1) are met.

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

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

(4) If it appears to the Comptroller that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 37.

Regulations to be open to inspection

8. The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

Amendment of regulations

9. An amendment of the regulations governing the use of a registered collective mark is not

effective unless and until the amended regulations are filed with the Comptroller and accepted by him.

Infringement: rights of authorised users

10. The provisions of subsection (6) of section 10 and of subsection (2) of section 19 apply in relation to an authorised user of a registered collective mark as in relation to a licensee of a trademark.

11. (1) The following provisions have effect as regards the rights of an authorised user in relation to infringement of a registered collective mark.

(2) An authorised user is entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor to take infringement proceedings in respect of any matter which affects his interests.

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

(4) Where infringement proceedings are brought by virtue of this paragraph, the authorised user may not, without the leave of the Court, proceed with the action unless the proprietor is joined in the suit.

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

Grounds for revocation of registration

12. Apart from the grounds of revocation provided for in section 42, the registration of a collective mark may be revoked on the ground -

(a) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 4(1), or

(b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark, or

(c) that an amendment of the regulations has been made so that the regulations -

(i) no longer comply with paragraph 5, or

(ii) are contrary to public policy or to accepted principles of morality.

Grounds for invalidity of registration

13. Apart from the grounds of invalidity provided for in section 43, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4(1) or 6(1) of this Schedule.

SCHEDULE 2. CERTIFICATION MARKS ➡

General

1. The provisions of this Act apply to certification marks subject to the following provisions which may, by regulations, be amended by the Minister.

Signs of which a certification mark may consist

2. In relation to a certification mark the reference in the definition of “trademark” in section 2 to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Indication of geographical origin

3. Notwithstanding section 4(1)(c), a certification mark which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be registered:

Provided that the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

Nature of proprietor's business

4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

5. (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

(2) The Comptroller may accordingly require that a mark in respect of which application is made for registration includes some indication that it is a certification mark, and notwithstanding the provisions of section 36(2), an application may be amended so as to comply with any such requirement.

Regulations governing use of certification mark

6. An applicant for registration of a certification mark must file with the Comptroller regulations governing the use of the mark specifying the person authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes and any further requirements with which the regulations have to comply as may be established by any rule made by the Minister.

Approval of regulations, etc.

7. (1) A certification mark shall not be registered unless -

(a) the regulations governing the use of the mark -

(i) comply with paragraph 6(2) and any further requirements imposed by rules, and

(ii) are not contrary to public policy or to accepted principles of morality, and

(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) The application shall be deemed to be withdrawn if before the end of any period as may be prescribed after the date of the application for registration of a certification mark, the applicant fails to file the regulations with the Comptroller and pay the prescribed fee.

8. (1) The Comptroller shall consider whether the requirements mentioned in paragraph 7(1) are met.

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

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

(4) If it appears to the Comptroller that those requirements, and the requirements for registration are met, he shall accept the application and shall proceed in accordance with section 37.

Regulations to be open to inspection

9. The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

Amendment of regulations

10. An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations are filed with the Comptroller and accepted by him.

Consent to assignment of registered certification mark

11. The assignment or other transmission of a registered certification mark is not effective without the consent of the Comptroller.

Infringement: right of authorised users

12. The provisions of subsection (6) of section 10 and of subsection (2) of section 19 apply in relation to an authorized user of a registered certificate mark as in relation to a licensee of a trademark.

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

Grounds for revocation of registration

14. Apart from the grounds of revocation provided for in section 42, the registration of a certification mark may be revoked on the ground -

(a) that the proprietor has begun to carry on such a business in contravention of paragraph 4,

(b) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 5(1),

(c) that the proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark,

(d) that an amendment of the regulations has been made so that the regulations —

(i) no longer comply with paragraph 6, or

(ii) are contrary to public policy or to accepted principles of morality,

(e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

Grounds for invalidity of registration

15. Apart from the grounds of invalidity provided for in section 43, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4, 5(1) or 7(1) of this Schedule.

Objects and Reasons

The object of this Act is to make new provisions with respect to Trademarks and similar rights in substitution of the provisions of the Industrial Property (Protection) Ordinance, Cap.29.