

PATENTS ACT (2000)

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A BILL entitled

An Act to make provision for the registration and regulation of Patents.

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. DESIGNATION ➔

Short title and commencement.

1. This Act may be cited as the Patents 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.

PART II. DEFINITIONS ➔

Interpretation.

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

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

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“the register” means the register of patents kept under this Act and includes the register of patents kept under the Industrial Property (Protection) Ordinance parts of which have been repealed by this Act;

“the 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;

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

“patent” means the exclusive right granted by the Comptroller in terms of the provisions of this Act.

PART III. THE OFFICE OF THE COMPTROLLER ➔

Appointment and duties of the Comptroller.

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

(2) The Comptroller shall be appointed by the Minister responsible for the Industrial Property Office.

PART IV. PATENTABILITY ➔

Patentable inventions.

4. (1) An invention shall be patentable if it is novel, involves an inventive step and is industrially applicable.

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

(a) discoveries, scientific theories and mathematical methods;

(b) aesthetic creations;

(c) schemes, rules and methods for performing mental acts, playing games or doing business and programs for computers;

(d) presentations of information.

(3) The provisions of subsection (2) shall exclude the patentability of the subject matter or

activities referred to in that subsection only to the extent to which a patent application or patent relates to such subject matter or activities as such.

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

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

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

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

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

(b) an animal variety or an essentially biological process for the production of plants or animals other than a microbiological process or the products thereof.

(6) The Minister may make regulations to modify any of the provisions of this section other than paragraph (a) of subsection (5) for the purpose of maintaining them in conformity with developments in science and technology.

Novelty.

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

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

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

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

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

Inventive step.

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

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

Industrial applicability.

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

Grace period.

8. (1) Disclosure, during the 12 months preceding the filing date or, where priority is claimed, the priority date of a given application, of information which otherwise would affect the patentability of an invention claimed in that application shall not affect the patentability of that invention where the information was disclosed:

(a) by the inventor;

(b) by an intellectual property office and

(i) the information was contained in another application filed by the inventor and should not have been disclosed by that office, or

(ii) the information was contained in an application filed without the knowledge or consent of the inventor by a third party who obtained the information directly or indirectly from the inventor;

(c) by a third party who obtained the information directly or indirectly from the inventor.

(2) For the purposes of subsection (1), "inventor" also means any natural person who or any legal entity which, at the filing date, was entitled to obtain a patent on the given application, irrespective of whether that person or entity is the applicant of the given application.

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

Entitlement to file an application.

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

Right to a patent.

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

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

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

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

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

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

Mention of inventor.

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

PART VI. APPLICATIONS ➔

Requirements of application.

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

- (a) a request for the grant of a patent;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract of the invention.

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

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

(4) The application shall be drafted in the prescribed language and shall satisfy any conditions that may be prescribed.

Date of filing.

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

(a) an express or implicit indication that the granting of a patent is sought;

(b) indications allowing the identity of the applicant to be established;

(c) a description of the invention for which a patent is applied for;

(2) (a) If the Comptroller finds that, at the time of receipt of an application, the requirements referred to in subsection (1) have not been fulfilled, he shall invite the applicant to comply with any requirement that has not been satisfied within such time as may be prescribed.

(b) If the applicant complies with the invitation referred to in paragraph (a), the filing date of the application shall be the date of receipt of all missing requirements. If the applicant fails to comply with such an invitation, the application shall be treated as if it had not been filed.

(c) Where the description refers to drawings which are not included in the application, the Comptroller shall invite the applicant to furnish the missing drawings within such period as may be prescribed. If the applicant complies with the said invitation, the filing date of the application shall be the date of receipt of the missing drawings. If the applicant fails to comply with the invitation, the filing date shall be the date of receipt of the application and any reference to the drawings shall be deemed as not having been made.

(3) (a) The indications referred to in paragraph (1) (a) and (b) must be submitted in such language or languages as may be prescribed, hereinafter referred to as the official languages of the Office.

(b) If any of the description and the claims referred to in paragraphs (1) (c) and (d) or any text contained in any drawings is in a language other than the official languages of the Office, a translation thereof in one of the official languages of the Office shall be deposited at the Industrial Property Office within such time limit as may be prescribed.

Disclosure of the invention.

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

(2) Where the application refers to biologically reproducible material which cannot be disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art, and such material is not available to the public, the application shall be supplemented by a deposit of such material with a depositary institution as may be prescribed.

Claims.

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

(2) The claims shall be clear and concise.

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

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

Abstract.

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

Unity of invention.

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

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

Division of application.

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

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

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

Amendment or correction and withdrawal of applications.

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

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

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

Inspection of files.

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

Right of priority.

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

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

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

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

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

PART VII. EXAMINATION AND GRANT OR REFUSAL ➔

Examination as to formalities.

23. (1) Where an application for a patent has been filed and is not withdrawn, the Comptroller shall refer the application to an officer in his department hereinafter referred to as "the examiner" to determine whether the application complies with such requirements of this Act and of any regulations made thereunder and which are designated by any regulations as may be prescribed as formal requirements. The examiner shall make a report thereon to the Comptroller.

(2) If the examiner reports to the Comptroller that not all the formal requirements are complied with, the applicant shall be given an opportunity to make observations on the report and to amend the application within such period as may be prescribed so as to comply with those requirements, and if the applicant fails to make such amendments the Comptroller may refuse the application.

(3) If the examiner reports to the Comptroller that the application, whether as originally filed or as amended pursuant to subsection (2) complies with all the formal requirements at any time before the end of such prescribed period as is referred to in subsection (2), the Comptroller shall notify the applicant accordingly.

Grant.

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

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

Publication of applications or patents.

25. (1) (a) Subject to paragraphs (b) and (c) hereof, the Comptroller shall, within the time limit provided for in subsection (2) and in the prescribed manner, publish all applications filed with it.

(b) No application shall be published if it is withdrawn or is rejected before the expiration of 17 months from the filing date or, where priority is claimed, from the priority date of the application.

(c) If by the time an application is published according to paragraph (2), a patent has been granted pursuant to that application, the Comptroller shall not publish the application but shall publish the patent in the prescribed manner.

(2) The Comptroller shall publish each application filed with it promptly after the expiration of 18 months from the filing date or, where priority is claimed, from the priority date of the application. However, where, before the expiration of the said period of 18 months, the applicant presents a written request to the Office of the Comptroller that his application be published, the Office of the Comptroller shall publish the application promptly after the receipt of the request.

PART VIII. EFFECTS OF A PATENT APPLICATION AND A PATENT ➔

Term of patents and maintenance fees.

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

(2) The maintenance of a patent shall be subject to the payment of the prescribed fees hereinafter referred to as "the maintenance fee". The maintenance fee shall be due in respect of the third year and each subsequent year thereafter calculated from the filing date of the application and shall be paid on or before the prescribed due date.

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

Rights conferred by a patent.

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

(a) the making of a product incorporating the subject-matter of the patent;

(b) the offering or the putting on the market of a product incorporating the subject-matter of the patent, the use of such product, or the importation or stocking of such product for such offering or putting on the market or for such use;

(c) the inducing of third parties to perform any of the above acts.

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

(a) the use of a process which is the subject matter of the patent;

(b) in respect of any product directly obtained by the use of the process, any of the acts referred to in subsection (1) (b), even where a patent cannot be obtained for the said product;

(c) the inducing of third parties to perform any of the above acts.

(3) Notwithstanding subsections (1) and (2), the proprietor of a patent shall have no right to prevent third parties from performing, without his authorisation, the acts referred to in subsections (1) and (2) in the following circumstances:

(a) where the act concerns a product which has been put on the market by the proprietor of the patent, or with his express consent, insofar as such an act is performed after that product has been so put on the market in Malta or in any territory as may be specified in the regulations;

(b) where the act is done privately and for non-commercial purposes, provided that it does not significantly prejudice the economic interests of the proprietor of the patent;

(c) where the act consists of making or using such product for purely experimental purposes or for scientific research;

(d) where the act consists of the extemporaneous preparation for individual cases, in a pharmacy or by a medical or veterinary doctor, of a medicine in accordance with a medical prescription or of acts concerning the medicine so prepared.

(4) (a) Subject to paragraph (b) hereof, a patent shall also confer on its proprietor the right to prevent third parties from supplying or offering to supply a person, other than a party entitled to exploit the patented invention, with means, relating to an element of that invention, essential for carrying out the invention, when the third party knows, or ought to know in the circumstances, that those means are suitable and intended for carrying out that invention. The provision of this paragraph shall not apply where such means are staple commercial products and the circumstances of the supply of such products do not constitute inducement to infringe the patent.

(b) Persons performing any acts referred to in subsection (3) (b), (c) and (d) shall not be considered to be parties entitled to exploit the invention within the meaning of paragraph (a).

Rights conferred by a patent application after publication.

28. (1) A patent application shall, where published under section 25, provisionally confer upon the applicant from the date of such publication the same rights in respect of the subject matter of the application as are conferred by section 27 in respect of the subject-matter of a patent.

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

Prior user.

29. (1) A patent shall have no effect against any person who in good faith, for the purposes

of his enterprise or business, before the filing date, or, where priority is claimed, before the priority date of the application on which the patent is granted, and within Malta was using the invention or was making effective and serious preparations for such use. Any such person shall have the right, for the purposes of his enterprise or business, to continue such use or to use the invention as envisaged in such preparations.

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

Extent of protection.

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

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

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

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

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

PART IX. ASSIGNMENT OF PATENTS ➔

Change in ownership of patent applications or patents.

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

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

(3) The transfer or assignment of a patent application or patent shall not affect rights acquired by third parties before the date of such transfer or assignment and shall have effect vis-à-vis third parties only after entry thereof is made in the patent register, unless such third parties having acquired rights after the date of the transfer or assignment but before its entry into the register knew of the transfer or assignment at the date on which

such rights were acquired.

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

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

Judicial assignment of patent application or patent.

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

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

Joint ownership of patent application or patent.

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

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

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

Patent register.

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

(2) The patent register shall include such matters constituting or relating to the patent application or patent as may be prescribed and entries of all corrections, amendments, change in ownership or other matters that he is empowered or required by or under this Act to record. No entry shall be made in the register prior to the publication of the application.

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

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

PART X. CONTRACTUAL LICENCES AND LICENCES OF RIGHT ➡

Licence contract.

35. (1) A patent application or patent may be licensed in whole or in part for the whole or part of Malta. A licence may be exclusive or non-exclusive. For the purposes of this law, "licence contract" means any contract by which a party ("the licensor") allows the other party ("the licensee") to perform any of the acts referred to in section 27 in respect of an invention claimed in a patent or a patent application.

(2) A licence contract shall in pain of nullity be made in writing and shall be signed by the parties to the contract.

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

Rights of licensee.

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

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

Rights of licensor.

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

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

Licences of right.

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

(2) Provided that if no one has informed the proprietor of the patent of his intention to use the invention, the statement may be withdrawn at any time upon written notification to this effect to the Office of the Comptroller:

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

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

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

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

PART XI. NON-VOLUNTARY LICENCES AND GOVERNMENT EXPLOITATION →

Non-voluntary licences.

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

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

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

(4) In deciding whether to grant a non-voluntary licence, the Court shall give both the proprietor of the patent and the person requesting the non-voluntary licence an adequate opportunity to present arguments.

(5) Any non-voluntary licence shall be revoked when the circumstances which led to its granting cease to exist, taking into account the legitimate interests of the proprietor of the patent and of the licensee. The continued existence of these circumstances shall be reviewed upon the request of the proprietor of the patent by writ of summons before the Civil Court, First Hall.

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

Exploitation by government or by third parties authorised by government.

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

(2) The scope and duration of such authorisation shall be limited to the purpose for which it was given and shall be:

(a) non-exclusive,

(b) non-assignable, except with that part of the enterprise or goodwill which enjoys such authorisation,

(c) terminated if and when the circumstances which led to it cease to exist and are unlikely to recur.

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

PART XII. AMENDMENTS, SURRENDER AND INVALIDATION ➔

Changes in patents.

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

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

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

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

Surrender.

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

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

Lapse.

43. (1) A patent shall lapse:

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

Invalidation of patents.

44. (1) The Comptroller may, at the request of a third party, or save in the case referred to in paragraph (c) hereof of his own accord, invalidate a patent, in whole or in part, on any of the following and may not do so on any other ground—

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

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

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

Provided that this shall not affect:

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

Proceedings.

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

(2) When a decision to invalidate a patent, in whole or in part, becomes final, the Comptroller shall record the decision in the patent register and shall publish any amendments to the patent in accordance with such regulations as may be prescribed.

PART XIII. RE-ESTABLISHMENT OF RIGHTS ➔

Restitutio in integrum.

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

(2) The request shall be filed in writing within two months from the removal of the cause of non-compliance with the time limit or within the year immediately following the expiry of the unobserved time limit, whichever is the earlier, after the omitted Act has been completed. In the case of non-payment of a maintenance fee, the period specified in subsection (3) of section 26 shall be deducted from the period of one year.

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

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

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

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

PART XIV. INFRINGEMENT—CIVIL ACTIONS ➔

Act of infringement-sanctions.

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

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(2) The right to sue for damages under subsection (1) hereof shall be without prejudice to the right of such person to apply for the issue of any precautionary warrant as provided in the Code of Organization and Civil Procedure to protect his rights.

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

Infringement proceedings.

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

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

(3) The Court may stay proceedings for infringement in respect of a patent application until after a final decision has been made by the Comptroller to grant or refuse a patent on that application.

(4) The defendant in any proceedings referred to in this section may request in the same proceedings the invalidation of any of the grounds referred to in section 44. In any such case the Comptroller shall be made a party to the proceedings.

Declaration of non-infringement.

49. (1) Subject to subsection (4), any interested person shall have the right to request, by instituting proceedings against the proprietor of the patent, that the Civil Court, First Hall, declare that the performance of a specific act does not constitute an infringement of the patent.

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

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

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

(5) Save where invalidation is requested under subsection (5) of section 48, proceedings for a declaration of non-infringement may be instituted together with proceedings to invalidate the patent.

PART XV. INFRINGEMENTS—CRIMINAL ACTIONS ➔

Offences.

50. (1) Whoever puts into circulation, or sells any article, falsely representing that it is a patented article shall, on conviction, be liable to a fine (multa) of not less than one hundred liri and not more than five thousand liri.

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

Where owner of goods is unknown.

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

Forfeiture of things seized.

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

Procedure where owner is unknown.

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

(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.

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

Limitation of criminal actions.

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

Right to damages not effected.

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

Employer and employee.

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

PART XVI. RIGHT OF APPEAL ➔

Right of appeal.

58. (1) An appeal shall lie from any decision of the Comptroller refusing the grant of a patent, an application for re-establishment of rights or any other request of the applicant for, or proprietor of, a patent. Such appeal shall have suspensive effect.

(2) Notice of appeal and a statement setting out the grounds of appeal shall be filed in writing at the Office of the Comptroller by applicant or proprietor of a patent, within two months of being informed of the decision and if the Comptroller considers the appeal to be admissible and well founded, he shall rectify his decision within three months from receiving the appeal.

(3) If within the said period of three months the Comptroller has not informed the applicant or the proprietor that he has rectified his decision an appeal may be entered by the applicant or the proprietor by application before the Court of Appeal within two months from the receipt from the Comptroller of notification that he has not rectified his decision, or from the lapse of the two-month period referred to in subsection (2), whichever is the earlier.

(4) Any appeal as is mentioned in subsection (2) and (3) of this section shall be brought 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 after the expiry of the said period of three months from when the Comptroller would have rectified his decision or not informed the applicant that he has rectified his decision, whichever is the earlier.

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

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

PART XVII. MISCELLANEOUS ➔

Regulations.

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

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

Costs.

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60. In any proceedings under this Act the costs shall be taxed and levied according to the tariffs in Schedule A annexed to the Code of Organization and Civil Procedure.

Agents.

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

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

Repeal and transitional provisions.

62. (1) Part I of the Industrial Property (Protection) Ordinance (hereinafter in this section called "the repealed law") and every reference to patents in Part IV, Part V and Part VI thereof are hereby repealed. Provided section 17 shall remain in force in respect of designs and trademarks until such time that the provisions contained in Part II and Part III are repealed.

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

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

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

Industrial Property (Protection) Ordinance as in force before the coming into force of the Act.

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

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

Objects and Reasons

The object of the Bill is to make new provision with respect to patents in lieu of the provisions of the Industrial Property (Protection) Ordinance, Cap.29.

May 15, 2000.