

## **Protection Of Trademarks:**

*This article offers basic information on some aspects of trademarks. It is not a reference document and carries no authority. The Industrial Property Registrations Directorate does not undertake to give legal advice or opinion about trademarks, other than in the course of formal proceedings – but sets out to answer some of the more basic questions.*

### **Definition of Trademark**

Trademark means any sign capable of being represented graphically, and of distinguishing goods and services of one undertaking from those of another. A trademark may consist of words (including personal names), figurative elements, letters, numerals or the shape of goods or their packaging.

### **Implications of registration**

When a proprietor registers his trademark, he acquires a property right, benefiting from specific remedies.

### **Application for registration of a trademark**

An application for registration of a trademark must be made to the Comptroller, who examines the application asserting whether all requirements for registration of such application are met.

An application for the registration of a trademark must be filed on the appropriate form and should contain the following:

- a. a request for registration of a trademark;
- b. the name and address of the applicant;
- c. a statement of the goods or services in relation to which it is sought to register the trademark;
- d. a representation of the mark;
- e. the name and address of the representative or attorney, in cases where one has been appointed
- f. a declaration claiming priority in cases where the applicant wishes to take advantage of an earlier application;
- g. an indication that the trademark is being used by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be used;
- h. a statement containing the name or names of the colour or colours being claimed in cases where the applicant wishes to claim colour as a distinctive feature of the mark; and
- i. the prescribed fee.

### **Rights conferred by a registered trademark**

The proprietor of a registered trademark has exclusive rights in the trademark. Such rights are infringed by such use of the trademark in Malta when:

- the use in the course of trade is made of a sign which is identical with or similar to the trademark in relation to goods or services which are identical with or similar to those for which it is registered; and there is the likelihood of confusion on the part of the public, including the likelihood of association with the trademark;

- the use in the course of trade is made of a sign which is identical with or similar to a trademark in relation to goods or services which are not similar to those for which the trademark is registered, but the trademark has a reputation in Malta and such use takes unfair advantage of or is detrimental to the distinctive character or the repute of the trademark.

## **Classification**

If the applicant wishes to apply for a trademark in respect of different goods and services he must make a different application for each category. Goods and services are classified by the office according to the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement. Prior to the filing of an application, the applicant, if in doubt, should check with the office as to how his goods and services should be classified.

## **Claim to priority of Convention application**

A person who has filed an application for protection of a trademark in a country, which is a member of the World Trade Organisation or a member of the Paris Convention for the Protection of Industrial Property, he or his successor in title, has the right to claim priority in registering the same trademark for any or all of the same goods or services for which the application has been filed. Such claim to priority is applicable for a period of six months from the date of filing of the first application.

## **Absolute grounds for refusal of registration of a trademark**

Once the formalities are fulfilled the application is then checked for substantive requirements. A sign, which does not fall within the definition of trademarks, shall not be registered as a trademark.

Registration of trademark is refused if the trademark: -

- lacks distinctive character
- is made up entirely 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
- consists entirely of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.
- Notwithstanding these last three exceptions, the registration of a trademark is not to be refused, if it can be shown that before the date of application for registration, the trademark has acquired a distinctive character as a result of the use made of it in Malta.

## **In addition a trademark shall not be registered if it consists exclusively of:**

- the shape which results from the nature of the goods themselves;
- the shape of goods; and
- the shape which gives substantial value to the goods.

## **Finally a trademark shall not be registered if:**

- it is contrary to public policy or morality;
- it is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or services;
- its use is prohibited in Malta by any enactment or rule of law;
- it consists of/or contains of any signs, arms, armorial bearings on flags as listed in Article 5 of the law; and
- it is made in bad faith.

## **Relative grounds for refusal of registration of a trademark**

Registration of a trademark is also refused if:

- a. it is identical with or similar to an earlier trademark and the goods or services for which the trademark is applied for are identical with or similar to the goods or services for which the earlier trademark is protected;
- b. it is identical with or similar to an earlier trademark, and although the goods or services are not similar to those in the earlier trademark, yet the registration would take unfair advantage of the distinctive character or repute of the earlier mark;
- c. its use in Malta is liable to be prevented by virtue of any rule of law protecting an unregistered trademark or other sign used in the course of trade or by virtue of an earlier right

An application for a trademark shall not be refused where the proprietor of the earlier mark or right consents to the registration of the application.

## **Rights Conferred by a Registered Trademark**

The proprietor of a registered trademark has exclusive rights in the trademark. Such rights are infringed by such use of the trademark in Malta without the consent of the proprietor.

## **Appeal**

Any decision of the Comptroller may be appealed from, before the Court of Appeal. "Decision" means any act, other than those acts that may be prescribed by the regulations, done by the Comptroller in exercise of a discretion vested in him.

Amendment of an application

An application may be amended at a fee at the request of the applicant only by correcting: -

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

and only where the corrections do not substantially affect the identity of the trademark or extend the goods or services covered by the application.

## **Limitation of registration**

The applicant or the proprietor of a registered trademark may: -

- disclaim any right to the exclusive use of any specified element of the trademark, or
- agree that the rights conferred by the registration are subject to a specified territorial or other limitation.

Alternatively, the Comptroller may disclaim any right to the exclusive use of any specified element of the trademark.

## **Publication and Issuing of Certificates**

When a trademark is registered, the Comptroller publishes the registration and issues a certificate of registration to the applicant.

## **Duration and Renewal of registered trademark**

The duration of registration of a trademark is ten years, which start running from the date of registration.

The trademark may be renewed for further periods of ten years at the request of the proprietor, after the payment of the renewal fee within not more than six months before the date of expiry.

The renewal takes effect from the expiry of the previous registration. If the registration of a trademark is not renewed, then the Comptroller removes the trademark from the register.

## **Revocation and Surrender**

The proprietor may surrender a registered trademark in respect of some or all of the goods or services for which the trademark is registered.

The registration of a trademark may be revoked when: -

- within a period of five (5) years from the date of registration the proprietor has not put the trademark to genuine use in Malta;
- 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; or
- 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.

## **Licensing of a registered trademark**

A licence to use a registered trademark may be general or limited; and it may be exclusive or non-exclusive.

The licence is binding on a successor in title to the grantor's interest, unless the licence provides otherwise. Where the licence so provides, the licensee may grant a sub-licence.

## **Transmission of a registered trademark**

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

## **Collective marks and certification marks**

Besides trademarks the Industrial Property Office also receives applications for collective and certification marks.

A collective mark is a mark distinguishing the goods or services of members of an association from those of other undertakings.

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.

## **Criminal offences**

It is a criminal offence for any person to make unauthorised use of a trademark. A person guilty of such an offence shall be liable on conviction to imprisonment for a term not exceeding three years or to a fine of not more than LM10, 000 or to both such fine and imprisonment.

## **The transition from the Old Law to the New Law regulating Trademarks**

Proceedings under the Old Law, which are pending on the commencement of the New Law, are dealt with under the Old Law.

*N.B. Old Law refers to the Industrial Property (Protection) Ordinance, 1900*