

New Maltese Opposition Procedure

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In December 2018 the Maltese Industrial Property Registrations Directorate (IPRD) transitioned from a long-standing system of *ex officio* examinations of new trademark applications for potential conflict with pre-existing marks to an opposition system, as required by Directive (EU) 2015/2436 approximating the laws of EU Member States relating to trademarks.

Under the *ex officio* procedure, the IPRD would run its own searches in the Maltese and EU trademark registers and raise objections to new applications whenever potential conflict with existing marks was identified. Applicants would then be given the opportunity to make their case before the IPRD if and when an objection was raised.

This system was scrapped shortly after the issuing of Legal Notice 343 of 2018 (“The Trademark Search and Opposition Rules”), whereby the new opposition procedure was introduced. The said law was issued by the Ministry for the Economy, Investment and Small Businesses in the run-up to the promulgation of Malta’s new Trademarks Act (Chapter 597 of the Laws of Malta, transposing the provisions of Directive (EU) 2015/2436), which entered into force on 14 May 2019.

The said rules – since re-designated as Subsidiary Legislation 597.03 – specify the details of the procedure governing relative grounds examinations carried out by the Office and the details of the procedure for filing and examining an opposition to the registration of a trademark.

Article 50(1) of Chapter 597 affords the right to oppose a trademark application to any proprietor of an earlier trademark, and to any person authorised under the relevant law to exercise the rights arising from a protected designation of origin or geographical indication on the basis of conflict with those pre-existing rights.

Article 6 of The Trademark Search and Opposition Rules sets out all the essential requirements of the notice of opposition. The deadline for filing an opposition notice terminates sixty (60) working days following the publication of the trademark application. The applicant will then be given a further period of sixty (60) working days to either a) withdraw their application and thus bring proceedings to a close; or; b) restrict the goods and services covered by the application, after which the opponent will be given a further ten (10) working days to decide whether it wishes to maintain or forego its opposition; or c) to submit a counterstatement against the opposition.

If jointly requested, the parties shall be granted up to ninety (90) working days from the date of the notification by the Office of the opposition to the applicant in order to allow for the possibility of a friendly settlement between the opposing party and the applicant.

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