

Malta

Administrative procedure

Opposition

No pre- or post-grant opposition procedure is available.
A pre-grant opposition procedure is planned.

Appeal

Decisions refusing the grant of a patent are appealable.
Any appeal has suspensive effect (Art. 58 PA).

The notice of appeal is to be filed with the Office of the Comptroller of Industrial Property (hereafter the “Patent Office”) within two months from notification of the decision concerned. Grounds/reasons for the appeal must be indicated.

Within three months the Patent Office may consider the appeal to be admissible and well-founded and rectify its previous decision. The applicant should be informed of the rectified decision within a further three-month period; otherwise the applicant may lodge an appeal with the Court of Appeal within two months from expiry of the two-month period from notification of the decision to be appealed against, or within two months from notification from the Patent Office that he has not rectified his decision, whichever period expires earlier.

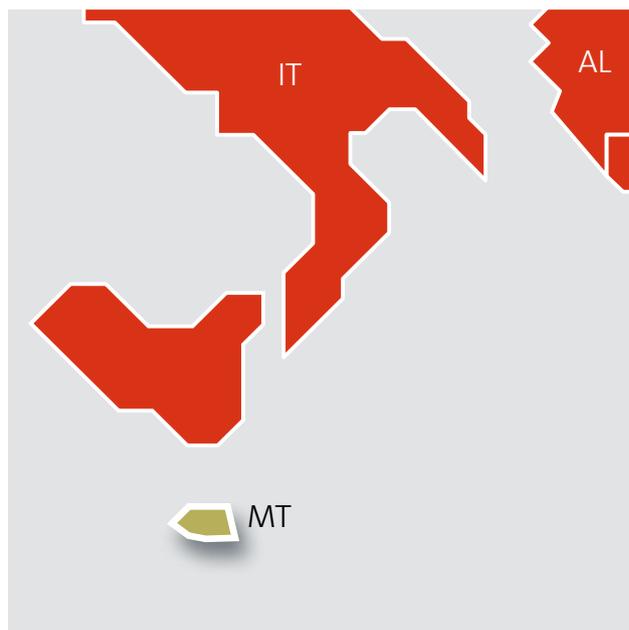
If the Patent Office rectifies his decision in full, no further appeal is available. In the case of partial rectification, the part that is not rectified is still appealable.

Civil procedure

Infringement

Infringement actions are to be brought before the Patents Tribunal (Art. 48 PA).

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



Infringement actions become statute-barred after five years from the date on which the aggrieved party became aware of the infringement.

Patent infringement is also a criminal offence; proceedings may be initiated on complaint (Art. 50 PA).

Nullity/counterclaim for revocation

In December 2015 the PA was amended in order to allow revocation before the Patent Office or before the Patents Tribunal depending on the grounds cited for revocation. In this context reference is made to Arts. 44A, 44B, 44C and 44D PA.

Actions for revocation may be taken during the lifetime of a patent and after the patent has lapsed.

Revocation has retroactive effect (subject to some exceptions – final and enforced decisions prior to revocation; contract concluded prior to the revocation decision, in so far as it has been performed before that decision).

Partial revocation is available.

A defendant in infringement proceedings may in the same proceedings request nullification of the patent concerned on any of the grounds for nullification. In such a case the Patent Office will be made a party to the proceedings (Art. 48(4) PA).

It is possible for the patent proprietor to limit the patent claims as per Art. 41(1) PA by submitting a request for the Patent Office to make changes in the patent in order to limit the extent of the protection it confers. No such change in the patent may go beyond what has been disclosed in the application as filed. The Court may also issue a court judgment in a case involving a patent which requires the limitation of the patent claims. Requests for the limitation of a patent claim whether filed directly before the Patent Office or via a Court judgment are not frequent.

Remedies

Injunctions, damages, confiscation of the machinery and other means used to infringe the patent, as well as of the infringing articles and the apparatus destined for their manufacture, and their delivery up to the owner of the patent.

A claim for damages arising from patent infringement will continue to be determined by the First Hall, Civil Court (Art. 8A PA), the Court responsible for patent actions before the patent law was reformed.

Other actions

Any interested party may institute proceedings before the Patents Tribunal against the owner of a patent for a declaration that the performance of a specific act does not constitute infringement of the patent. Licensees have to be informed of the proceedings by the patentee and have the right to join them (Art. 49 PA).

Appeal

An ordinary appeal may be brought to the Court of Appeal.

Parallel proceedings

In this regard it is stated that the Patents Tribunal will stay any proceedings for infringement in respect of:

- (a) a patent application filed with the Patent Office until after a final decision has been made by the Patent Office to grant or refuse a patent on the application;
- (b) a patent application filed at the EPO until after a final decision has been made by the EPO to grant or refuse a patent on the application.

Arbitration/mediation

Arbitration in Malta is regulated by the Arbitration Act (Cap 387 of the Laws of Malta). The Malta Arbitration Centre has been set up with the function of providing for the conduct of domestic and international arbitration in Malta and providing the necessary facilities for arbitration to be conducted within Malta.

Enforcement

Either the Court or the Patents Tribunal, as appropriate, is responsible for enforcement.

Compulsory licence

A compulsory licence may be requested at the Civil Court, First Hall, by any person who proves his ability to work the patented invention in Malta if the patented invention is non-working or is insufficiently worked in Malta (Art. 39 PA). The Court will direct the Patent Office to grant a compulsory licence.

Furthermore, the Minister responsible for IP may authorise the licence in cases of national security or public safety (Art. 40 PA).

Relevant national law

Patents and Designs Act, making provision for the registration and regulation of patents and designs. 1 June 2002, ACT XVII of 2000, as amended by Acts IX of 2003 and XVIII of 2005; Legal Notices 181 and 186 of 2006, and 426 of 2007; and Act XXX of 2014 [cited as: PA]

Competent authorities or courts

