

MEMORANDUM BY THE MINISTER OF JUSTICELegislation amending the Industrial Property (Protection)
Ordinance (Cap. 48)

The Law Officers have been giving consideration in collaboration with the Director of the Public Registry and officials from the office of the Comptroller of Industrial Property to legislation amending this Industrial Property (Protection) Ordinance.

These amendments are intended to remedy the most urgent defects of present legislation without however substituting the need for more modern laws on the matter and which are being studied at the Crown Advocate-General's Chambers.

The most important clause in the attached Bill is clause 12 amending section 83 of the principal law. This amendment has broadened the law so as to allow the registration of words as trade marks which are not registrable under the present law enacted in 1899 and this in keeping with progress and modern legislation in most countries.

According to this amendment "word or words having no direct reference to the character or quality of the goods and not being according to the ordinary signification a surname or a geographical name" may be registered as trade marks.

The Bill also provides for a simplified method of appeal from orders of the Comptroller of Industrial Property and extends to two months the period within which an appeal may be entered against the decision of the Comptroller of Industrial Property (Clause 3).

This is being done because the present formalities and procedures provide too short a time for an attorney of the firm seeking registration to consult his principals abroad as to the advisability or otherwise of filing an appeal.

/The Bill

The Bill also fills a lacuna in the present law in that it stipulates a definite time limit within which the opposition to the registration of a trade mark may be filed and completed (Clause 14).

Another important aspect of this Bill is that abolishing the functions of the Director of the Public Registry in connection with the law being amended.

At present there exists the anomaly of having matters relative to Patents, Trade Marks and Designs dealt with by two different departments the office of the Comptroller of Industrial Property and the Public Registry with the inevitable consequence of much useless duplication of work.

The said amendment was also suggested by the Notarial College in their Memorandum on the Curtis Report.

Hon. Ministers are invited to recommend.

28th December, 1965.

A BILL
entitled

AN ACT further to amend the Industrial Property
(Protection) Ordinance, Cap.48.

BE IT ENACTED by the Queen's most Excellent
Majesty, by and with the advice and consent of the House
of Representatives ^{of Malta,} in this present Parliament assembled,
and by the authority of the same, as follows:-

Citation.

1. This Act may be cited as the Industrial
Property (Protection) (Amendment) Act, 1966 and shall be
read and construed as one with the Industrial Property
(Protection) Ordinance hereinafter referred to as "the
principal law".

Amendment of
section 7 of
the principal
law.

2. Section 7 of the principal law shall be
amended by the deletion of the figure (1) and by the
repeal of subsection (2).

Amendment of
section 17 of
the principal
law.

3. Section 17 of the principal law shall be
amended by the substitution for subsection (2) of the
following:-

"(2) Such appeal shall be by application to
be filed within two months from the receipt by the
applicant of the order of the Comptroller."

Amendment of
section 18 of
the principal
law.

4. Section 18 of the principal law shall be
amended by the deletion of the words "and another copy
shall be kept in the Public Registry Office in Valletta".

Amendment of
section 38 of
the principal
law.

5. Section 38 of the principal law shall be
amended as follows:-

- (a) in subsection (1), for the words "in the
Public Registry" there shall be
substituted the words "in the office of
the Comptroller of Industrial Property";
- (b) subsection (3) shall be deleted.

Amendment of
section 39 of
the principal
law.

6. Section 39 of the principal law shall be
amended by the substitution, in the proviso to paragraph
(a) of subsection (1), of the words "Comptroller of
Industrial Property" and "Comptroller" for the words
"Director of Public Registry" and "Director", respectively.

Amendment of section 40 of the principal law.

7. Section 40 of the principal law shall be amended by the substitution of the words "by the Comptroller of Industrial Property" for the words "by the Director of the Public Registry".

Amendment of section 54 of the principal law.

8. Section 54 of the principal law shall be amended by the deletion in subsection (1) of the words "and to the Director of the Public Registry".

Amendment of section 55 of the principal law.

9. Section 55 of the principal law shall be amended by the deletion of the words "and the Director of the Public Registry".

Substitution of section 75 of the principal law.

10. For section 75 of the principal law there shall be substituted the following:-

"Registration of design or model.

75. If the application is allowed by the Comptroller, the new design or model of manufacture shall be registered in the "Register of Designs and Models of Manufacture and such registration shall be advertised in the Government Gazette by means of a notice signed by the Comptroller."

Amendment of section 76 of the principal law.

11. Section 76 of the principal law shall be amended by the deletion of the words "or of the Director of the Public Registry".

Amendment of section 83 of the principal law.

12. Section 83 of the principal law shall be amended as follows:-

(a) for the fullstop at the end of paragraph (c) there shall be substituted a semicolon followed by the word "or"; and

(b) immediately after paragraph (c), there shall be inserted the following new paragraph:-

"(d) a word or words having no direct reference to the character or quality of the goods and not being according to the ordinary signification a surname or a geographical name".

Amendment of section 86 of the principal law.

13. Section 86 of the principal law shall be amended by the deletion of the word "duplicate" wherever it occurs in paragraphs (b) and (c).

Amendment of section 91 of the principal law.

14. Section 91 of the principal law shall be amended as follows:-

- (a) in subsection (2) immediately after the words "fails to ~~and~~ such counterstatement" there shall be inserted the words "within two months from the receipt by him of the said copy of the notice and intimation"; and
- (b) in subsection (3) immediately after the word "if" there shall be inserted the words "within two months from the receipt by him of such counterstatement".

Amendment of section 132 of the principal law.

15. Section 132 of the principal law shall be amended by the substitution of the words "at the office of the Comptroller of Industrial Property" for the words "at the Public Registry".

Amendment of section 134 of the principal law.

16. Section 134 of the principal law shall be amended by the substitution of the words "at the office of the Comptroller of Industrial Property" for the words "at the Public Registry".

Substitution of section 135 of the principal law.

17. For section 135 of the principal law there shall be substituted the following:-

"Applications to be entered in Registers.

135. (1) There shall be entered in each of the registers mentioned in section 132, under a progressive number, all applications and documents filed therewith, the name, surname, country, father's name and place of domicile of the applicant and his attorney, if any, the subject matter of the application and the date of presentation.

(2) To the said entries there shall be added:-

- (a) in the Register of industrial patents, the title of the invention for which a patent is claimed;
- (b) in the register of inventions of new designs and models of manufacture, an indication of the design or model of manufacture for which copyright is claimed;

/(c).....

(c) in the Register of trade marks, an indication of the object for which the marks are intended."

Substitution of section 136 of the principal law.

18. For section 136 of the principal law, there shall be substituted the following:-

"Other entries in Register of industrial patents. 136. In the register of industrial patents, a reference to the specifications which may have been filed shall also be entered."

Amendment of section 138 of the principal law.

19. For subsection (2) of section 138 of the principal law, there shall be substituted the following:-

"(2) In the index of the Register for assignments, reference shall be made to the progressive number of the general register."

Amendment of section 139 of the principal law.

20. Section 139 of the principal law shall be amended by the substitution of the words "at the office of the Comptroller" for the words "at the Public Registry" wherever they occur and by the substitution of the words "by the Comptroller of Industrial Property" for the words "by the Director of the Public Registry".

Amendment of section 140 of the principal law.

21. Section 140 of the principal law shall be amended by the substitution, in subsection (1), of the words "at the office of the Comptroller" and "by the Comptroller of Industrial Property" for the words "at the Public Registry" and "by the Director of the Registry", respectively.

Amendment of section 141 of the principal law.

22. Section 141 of the principal law shall be amended by the deletion in subsection (2) of the words "the Director of the Public Registry".

Amendment of section 144 of the principal law.

23. Section 144 of the principal law shall be amended as follows:-

(a) by the deletion in subsection (1) of the words "and the Director of the Public Registry"; and

/(b).....

- (b) by the substitution in subsection (3) of the words "on his own authority" for the words "under the mere authority of the Director of the Public Registry who shall countersign the correction so made."

Transitory
Provision and
transfer of
registers to
the Office of
the Comptroller.

24. (1) As from the date of commencement of this Act, the registers hitherto kept at the Public Registry shall be transferred and kept at the office of the Comptroller of Industrial Property.

(2) With respect to cases pending for the purpose of a counterstatement or of an action in terms of subsections (2) and (3) respectively of section 91 of the principal law, the said counterstatement shall be sent or the said action shall be brought, as the case may be, within two months from the coming into force of this Act.

Saving.

25. Nothing in this Act shall affect the validity of anything heretofore lawfully done or omitted to be done or any right, obligation or liability heretofore acquired, accrued or incurred under any of the provisions of the principal law hereby amended or repealed.

Objects and Reasons

The object of this Bill is to remove certain restrictions relating to applications for the registration of trade marks, as well as to eliminate the anomaly of having matters relating to patents, trademarks and designs dealt with by two different departments namely the Office of the Comptroller of Industrial Property and the Public Registry, with the inevitable consequence of duplication of work.

The Bill permits the registration of a number of trade marks which so far could not be registered in Malta, and this in accordance with the prevailing practice in most countries.

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The Bill extends to two months the period within which an appeal may be entered into against the decision of the Comptroller of Industrial Property, simplifies the formalities for such appeal and it also establishes a definite time limit within which the opposition to the registration of a trade mark may be filed and concluded.