

PROTECTION OF DESIGNS

Introduction

The Law that regulates the protection of designs and which grants them their status as a property right is the Patents and Designs Act.

The term 'Designs' is defined by the said Act as meaning the appearance of the whole or a part of a product with special characteristics in its lines, contours, colours, shape, texture and/or materials of the product itself, and/or of its ornamentation.

Requirements for Protection

The Act provides that designs are protected by their registration by means of which exclusive rights are conferred upon their holders.

Novelty and individuality

The 2 requirements for a design to be eligible for protection and, consequently, registration are:

- novelty; and
- individuality.

A design is considered to be new if no identical design has been made available to the public before the date of filing of the application for registration or, if priority is claimed, before the date of priority.

A design is considered to have individual character if the overall impression it has on the informed user differs from the overall impression produced by any other design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, before the priority date.

Complex Product

The Law provides that a design applied to or incorporated in a product that constitutes a component part of a complex product shall only be considered to be new and to have individual character:

- (a) if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
- (b) to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

Disclosure

A design is considered as having been made available to the public if it has been published, exhibited, used in trade or otherwise disclosed, unless it can be shown that the design could have reasonably become known, before the filing date or where priority is claimed, before the priority date, in the normal course of business to the circles specialised in the sector concerned.

Non-Registrable Designs

A design right cannot be obtained with regards to:

- features of appearance of a product which are solely dictated by its technical function;
- features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to allow the product, in which the design is incorporated or to which the design is applied, to function;
- a design serving the purpose of allowing multiple assembly or connection of multiple interchangeable products within a modular system;
- a design which is contrary to public policy or accepted principles of morality;
- a design which consists principally of the national flag of Malta, or contains the Presidential or Episcopal arms or the principal armorial bearings or representation of flags; and
- the abbreviations and names of international intergovernmental organisations of which one or more Paris Convention countries are members.

Scope of Protection

The protection of a design right extends to any design that does not give a different overall impression on the informed user.

Term of Protection

A design right is protected for a period of 5 years from the date of filing of the application and is renewable for one or more periods of 5 years each up to a maximum term of 25 years.

Renewal of registration

The registration of a design may be renewed at the request of the proprietor, accompanied by the prescribed fee. A late renewal can be effected up to 6 months after the date of expiry upon payment of the prescribed late renewal fee. If the registration is not renewed, the design shall be removed from the register.

Exclusive rights conferred by the design right

The registration of a design shall confer on its holder:-

- the exclusive right to use such design including, in particular, the making, offering, putting on the market, importation, export or use of a product in which the design is incorporated or to which it is applied, or the stocking of such a product for such purposes; and
- to prevent any third party not having his consent from using it.

The rights of the proprietor have effect from the date of registration and, accordingly, no infringement proceedings may be instituted before the date on which the design is, effectively, registered.

It should be noted that the rights conferred by the design right upon registration cannot be exercised in respect of:

- (a) acts done privately and for non-commercial purposes; or
- (b) acts done for experimental purposes; or
- (c) acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source; or
- (d) the equipment on ships and aircraft registered in another country when these temporarily or accidentally enter the territory of Malta; or
- (e) the importation into Malta of spare parts and accessories for the purpose of repairing such craft; or
- (f) the execution of repairs on such craft.

Exhaustion of rights

The proprietor of a registered design is not entitled to prohibit the use of a product in which the design is incorporated or to which the design is applied when the product in question has been put on the market by the proprietor or, otherwise, with his consent.

Transmission of a registered design

A registered design is transmissible by assignment, testamentary disposition or operation of Law in the same way as other personal or movable property. A transmission may be partial and limited so that the use of the design applies in a

particular manner or to a particular locality. Such transmissions are to be recorded in Malta.

The Registration Process

Upon filing of the applicable application, the official date of filing would be the date of submission of the completed application form to the Office.

Designs are classified according to the Locarno Classification.

In order to claim priority of another application in a Convention Country, the Law requires the applicant to file the Maltese application within 6 months from the date of first filing.

Examination of Application

The Comptroller shall examine the application in order to ascertain that it complies with the requirements of the Law. If any of these requirements are missing the Comptroller will inform the applicant and invite him to make the necessary amendments. If the necessary amendments are not made within the prescribed time, the Comptroller shall refuse the application.

Withdrawal or amendment of application

The applicant may withdraw his application at any time. An application may be amended only in so far as the amendment relates to corrections of the name and address of the applicant, errors of wording and obvious mistakes. Consequently, no corrections that substantially affect the identity of the design will be accepted.

Registration

On the registration of a design, the registration certificate shall be issued and a notice shall be published in the Government Gazette stating that the design has been registered and that it is available to be viewed by the public at the Office.

Grounds for invalidity of registration

The registration of a design may be declared invalid on the grounds that it is not novel, it does not have individual character or that it has been disclosed or in any way made available to the public.

Effect of acquiescence

An action for invalidity may not be initiated when the person bringing action is aware of the use of the registered design in Malta and has acquiesced for a continuous period of 5 years to such use.



Action for Infringement

Infringement proceedings are to be instituted before the Civil Court, First Hall, before the lapse of 5 years from the date when the injured party has obtained knowledge of the infringement and of the identity of the alleged infringer.